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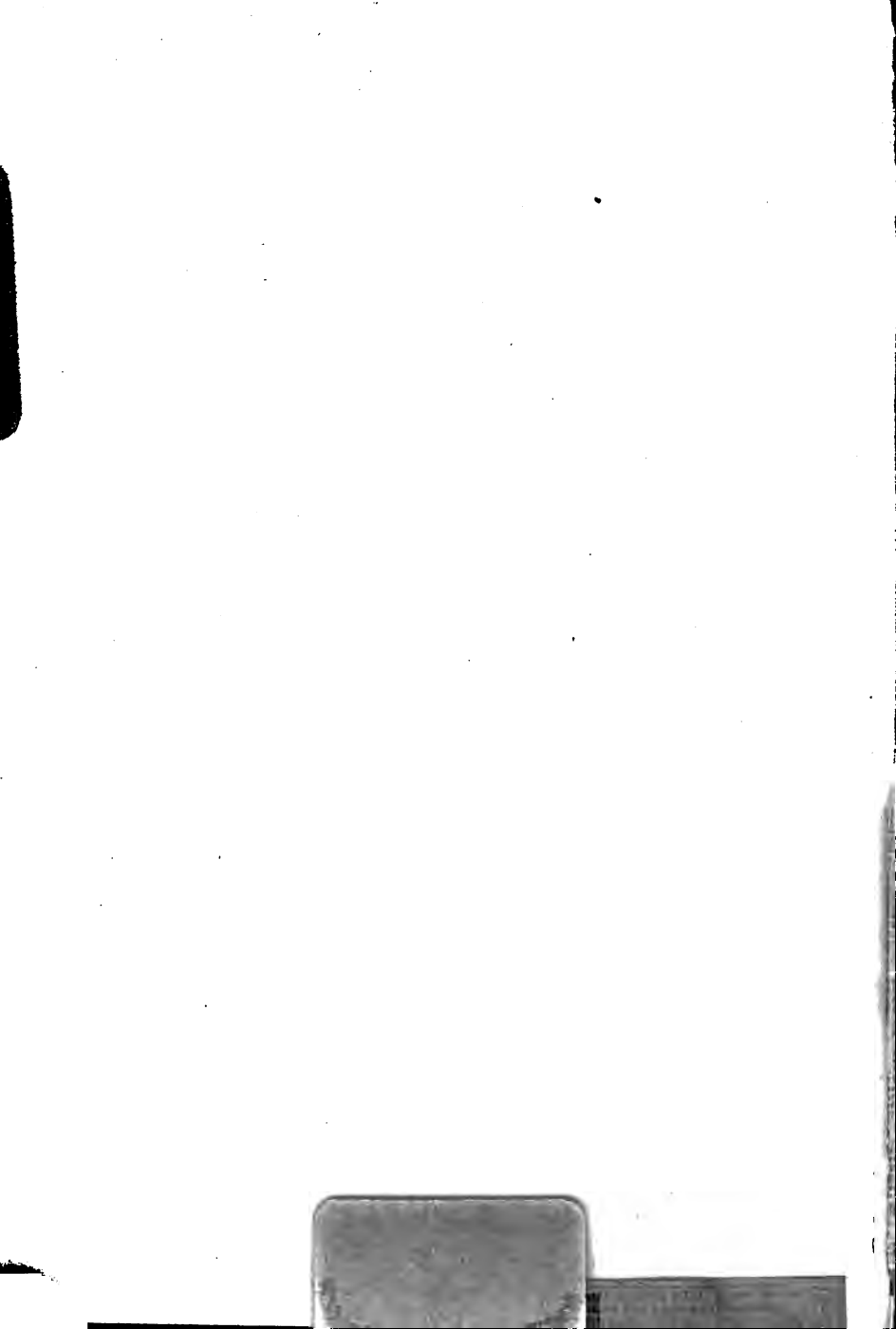

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THE LAW

RELATING TO

TRADE MARKS

BY

R. S. MUSHET,
OF LINCOLN'S INN, BARRISTER-AT-LAW.

LONDON:
SMITH, ELDER, & CO., 15 WATERLOO PLACE.
1885.

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Ballantyne Press
BALLANTYNE, HANSON AND CO.
EDINBURGH AND LONDON

PREFACE.

In this little book an attempt is made to collect in as small a compass as possible, the principles of the law of this country relating to Trade Marks.

Since a large proportion of those principles are now embodied in comparatively recent statutory enactments, it was thought that the object of the book would be more conveniently and satisfactorily attained by appending explanatory notes to each section of the Acts of Parliament relating to the subject than by adopting the form of a treatise.

The rules relating to trade marks issued by the Board of Trade in pursuance of the Patents, Designs, and Trade Marks Act, 1883, have been added at the end of the volume, as well as the Instructions compiled by the authorities at the Patent Office for the guidance of those who desire to register trade marks.

Reference is made in the *Addenda* to the short notes, contained in the legal newspapers, of some few cases which have been decided whilst the book was passing through the press but which have not yet been reported at length.

R. S. M.

8 Stone Buildings, Lincoln's Inn,
July 1885.

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ABBREVIATIONS.

Act of 1875.	38 & 39 Vict., c. 91 (Trade Marks Registration).
Act of 1883.	46 & 47 Vict., c. 57 (Patents, Designs, and Trade Marks).
App. Cas.	Law Reports, Appeal Cases, 1875-85.
Atk.	Atkyn's Reports, 1736-55.
B. & Ad.	Barnewall and Adolphus' Reports, 1830-34.
B. & Cr.	Barnewall and Cresswall's Reports, 1822-30.
B. & S.	Best and Smith's Reports, 1861-69.
Beav.	Beavan's Reports, 1838-56.
C. A.	Court of Appeal.
C. B.	Common Bench Reports, or Manning, Granger, and Scott's Reports, 1845-56.
C. B. N. S.	Common Bench Reports, New Series, 1856-65.
C. C. R.	Crown Cases Reserved.
C. P.	Common Pleas.
C. & M.	Crompton and Meeson's Reports, 1832-34.
Ch.	Chancery.
Ch. D.	Law Reports, Chancery Division, 1875-85.
Coop.	Cooper's Cases of the Time of Lord Cottenham, 1837-38.
Cox.	Cox's Criminal Cases, 1843-84.
D. P. R.	Dowling's Practice Cases, 1830-40.
D. & B.	Dearsley and Ball's Crown Cases, 1856-58.
D. & M.	Davison and Merivale's Reports, 1843-44.
D. & R.	Dowling and Ryland's Reports, 1821-27.
De G. F. & J.	De Gex, Fisher, and Jones' Reports, 1860-62.
De G. J. & S.	De Gex, Jones, and Smith's Reports, 1862-66.
De G. M. & G.	De Gex, Macnaghten, and Gordon's Reports, 1851-57.
Doug.	Douglas' Reports, 1778-84.
Ell. & Ell.	Ellis and Ellis' Reports, 1858-61.
Eq.	Equity.
Eq. Rep.	Equity Reports.
Ex.	Exchequer.
Ex. Ch.	Exchequer Chamber.
Giff.	Giffard's Reports, 1857-65.
H. L.	House of Lords.
H. L. C.	Clark and Finelly's House of Lords Reports, 1831-46.
H. & M.	Hemming and Miller's Reports, 1862-65.
H. & N.	Hurlstone and Norman's Reports, 1856-61.

Hare.	Hare's Reports, 1841-53.
Instructions.	Instructions to those who wish to Register Trade Marks, issued at the Patent Office.
J.	Mr. Justice.
J. & H.	Johnson and Hemming's Reports, 1860-62.
Jur.	Jurist Reports, 1837-54.
Jur. N. S.	Jurist Reports, New Series, 1855-66.
K. B.	King's Bench.
K. & J.	Kay and Johnson's Reports, 1854-58.
L. C.	Lord Chancellor.
L. J.	Lord Justice.
L. J. Ch.	Law Journal Reports, Chancery, 1823-85.
L. J. Ex.	" " " Exchequer, "
L. J. C. P.	" " " Common Pleas, "
L. J. K. B.	" " " King's Bench, "
L. J. Q. B.	" " " Queen's Bench, "
L. J. M. C.	" " " Magistrate's Cases, 1823-85.
L. J. N. of C.	Law Journal Reports, Notes of Cases.
L. R.	Law Reports, 1865-85.
L. R. Ch.	" " Chancery Appeal Cases, 1865-75.
L. R. Eq.	" " Equity Cases, 1865-75.
L. R. Ex.	" " Exchequer Cases, 1865-75.
L. R. H. L.	" " English and Irish Appeal Cases, 1865-75.
L. R. Q. B.	Law Reports, Queen's Bench Cases, 1865-75.
L. T.	Law Times Reports, 1845-59.
L. T. N. S.	Law Times Reports, New Series, 1859-85.
M. R.	Master of the Rolls.
M. & W.	Meeson & Welsby's Reports, 1836-47.
Man. & G.	Manning and Granger's Reports, 1840-44.
Man. & R.	Manning and Ryland's Reports, 1827-30.
My. & Cr.	Mylne and Craig's Reports, 1836-40.
Ph.	Phillip's Reports, 1841-49.
Q. B.	Adolphus and Ellis' Queen's Bench Reports, 1834-40.
Q. B. D.	Law Reports, Queen's Bench Division, 1875-85.
Scott.	Scott's Reports, 1834-40.
Scott. N. R.	Scott's New Reports, 1840-45.
Seb. Dig.	Sebastian's Digest of Trade Mark Cases.
Smith's L. C.	Smith's Leading Cases.
Swans.	Swanston's Reports, 1818-19.
T. R.	Durnford and East's Term Reports, 1785-1800.
V. C.	Vice-Chancellor.
V. & B.	Vesey and Beame's Reports, 1812-14.
W. N.	Law Reports, Weekly Notes.
W. R.	Weekly Reporter, 1854-85.

ADDENDA.

P. 27—Last line; add, "*In re Riviere's Trade Mark* (2), C. A. 1885, Solicitor's Journal, vol. 29, p. 500; Law Times, vol. 79, p. 60."

P. 33—Nine lines from bottom; add, "See also *Snelling* v. *Pulling*, C. A. 1885, 29 Ch. D. 85."

P. 48—Nineteen lines from top; add, "Where an order has been made for an appellant to give security for the costs of an appeal, it has been held that if he does not give it within a reasonable time the court will dismiss the appeal without giving further time, unless there are extenuating circumstances, and that as a general rule a period of three months is more than a reasonable time; *Washburn Manufacturing Co.* v. *Moen*, C. A. 1885, 29 Ch. D. 48."

P. 55—Twelve lines from bottom; add, "*In re Friedlander's Trade Mark*, Chitty, J., 1885, W. N. 85; L. J. N. of C. 80; Solicitor's Journal, vol. 29, p. 397; Law Times, vol. 79, p. 95; *In re Wood's Trade Mark*, Pearson, J., 1885, W. N. 99; L. J. N. of C. 95; Solicitor's Journal, vol. 29, p. 455; *In re Riviere's Trade Mark* (2), C. A. 1885, Solicitor's Journal, vol. 29, p. 500."

P. 57—Sixteen lines from bottom; add, "For an instance of a case in which, on the Board referring an appeal to the court, the applicant appears to have proceeded by motion under sect. 90, see *In re Trade Mark 'Alpine,'* Chitty, J., 1885, W. N. 120; L. J. N. of C. 106; Solicitor's Journal, vol. 29, p. 500. *In re Trade Mark 'White Rose,'* Kay, J., 1885, W. N. 127; L. J. N. of C. 111, the application to the court was by summons, and it does not appear that it was preceded by an appeal to the Board of Trade."

P. 58—Eight lines from top; add, "For an instance of a motion under sect. 90 of the Act to rectify the register, see *In re Mitchell's and Houghton and Hallmark's Trade Mark*, Chitty, J., 1885, 28 Ch. D. 666; 33 W. R. 148 and 408."

P. 58—Ten lines from bottom; add, "And the same rule as to costs will hold when the applicant is successful on the Board referring an appeal to the court: *In re Trade Mark 'Alpine,'* Chitty, J., 1885, W. N. 120; L. J. N. of C. 106; Solicitor's Journal, vol. 29, p. 500."

P. 63—Three lines from top; add, "The entry on the registration of two similar trade marks in the same class of a note that the use of the marks so registered is restricted by an agreement between the respective owners (the effect of which is not stated) is irregular and contrary to sect. 85 of the Act; the entry should properly consist of a note of mutual undertakings not to use the marks except in a certain manner or within specified districts: *In re Mitchell's and Houghton and Hallmark's Trade Marks,* Chitty, J., 1885, 28 Ch. D. 666; 33 W. R. 408."

P. 69—Twenty-two lines from top; add, "L. J. N. of C. 80; Solicitor's Journal, vol. 29, p. 397; Law Times, vol. 79, p. 95. On the ground, however, that it is immaterial for the purposes of this section whether the word is newly invented or fancifully applied so long as such application creates a distinction, it has been held that the word 'Alpine,' as applied to woollen and cotton goods (*In re Trade Mark 'Alpine,'* Chitty, J., 1885, W. N. 120; L. J. N. of C. 106; Solicitor's Journal, vol. 29, p. 500) and the word 'Lawford,' the name of a celebrated lawn-tennis player, as applied to tennis bats (*Slazenger* v. *Malings,* Pearson, J., 1885, W. N. 124; Solicitor's Journal, vol. 29, p. 517) are 'fancy words not in common use,' and are consequently capable of registration as new trade marks."

P. 71—Thirteen lines from bottom; add, "*In re Riviere's Trade Mark* (2), C. A. 1885, Solicitor's Journal, vol. 29, p. 500; Law Times, vol. 79, p. 60."

P. 75—Six lines from bottom; add, "'Eton Cigarettes' in *Wood* v. *Lambert,* Pearson, J., 1885, W. N. 99; L. J. N. of C. 95; Solicitor's Journal, vol. 29, p. 455."

P. 83—Fifteen lines from bottom; add, "Without saying that it is impossible to substitute the name of one person for another on the register, as a general rule the provisions made by the Act and Rules for an application for the registration of a trade mark ought to be followed. In particular it is important that the prescribed advertisements should be given. It may well be that as against the person who is on the register the applicant to strike him off may have a very good right, while as against other persons who are not present he may not be entitled to be on the register: *per* Cotton, L.J., in *In re Riviere's Trade Mark* (2), C. A. 1885, Solicitor's Journal, vol. 29, p. 500; Law Times, vol. 79. p. 60.

P. 88—Four lines from bottom; add, "*In re Trade Mark 'Alpine,'* Chitty, J. 1885, W. N. 120; L. J. N. of C. 106; Solicitor's Journal, vol. 29, p. 500."

P. 97—Twelve lines from top; add, "(v.) Where a trade mark consisted of a picture of a hunting field with the words 'Grant's Morella Cherry Brandy, Sportsman's Special Quality,' and evidence was adduced that the brandy was generally known and sold as the Sportsman's Cherry Brandy, another trade mark composed of a hunting field (although somewhat dissimilar to the first), and the words 'Huntsman's Cherry Brandy,' was held to be calculated to deceive: *In re Barker's Trade Mark*, Kay, J., 1885, L. J. N. of C. 102."

P. 115—Nine lines from bottom; add, "*In re Riviere's Trade Mark* (2), C. A. 1885, Solicitor's Journal, vol. 29, p. 500; Law Times, vol. 79, p. 60."

P. 130—Seventeen lines from bottom; add, "See, however, *In re Riviere's Trade Mark* (2), C. A. 1885, Solicitor's Journal, vol. 29, p. 500; Law Times, vol. 79, p. 60."

P. 131—Fifteen lines from bottom; add, "When, however, the case was heard on its merits, some doubt was expressed whether a person trading only in India could be aggrieved by the registration of a trade mark in England: *In re Riviere's Trade Mark* (2), C. A. 1885, Solicitor's Journal, vol. 29, p. 500; Law Times, vol. 79, p. 60."

P. 132—Six lines from bottom; add, "In a case where an appeal was apparently referred by the Board to the court, the procedure adopted was a motion under sect. 90 by the applicant: *In re Trade Mark 'Alpine,'* Chitty, J., 1885, W. N. 120; L. J. N. of C. 106; Solicitor's Journal, vol. 29, p. 500. In another case the application to compel the Comptroller to register, seems to have been by summons without any preliminary appeal to the Board: *In re Trade Mark 'White Rose,'* Kay, J., 1885, W. N. 127; L. J. N. of C. 111; Solicitor's Journal, vol. 29, p. 540; Law Times, vol. 79, p. 95."

P. 138—Nine lines from bottom; add, "See, however, observations of Cotton, L.J., in *In re Riviere's Trade Mark* (2), C. A. 1885, Solicitor's Journal, vol. 29, p. 500: Law Times, vol. 79, p. 60."

P. 140—Two lines from top; add, "*In re Trade Mark 'Alpine,'* Chitty, J., 1885, W. N. 120; L. J. N. of C. 106; Solicitor's Journal, vol. 29, p. 500."

N.B.—*In re Wragg's Trade Mark*, Pearson, J., 1885, is now reported in 29 Ch. D. 551.

THE

MERCHANDISE MARKS ACT, 1862.

25 & 26 VICT., c. 88.

An Act to Amend the Law relating to the Fraudulent Marking of Merchandise. [*7th August* 1862.]

WHEREAS it is expedient to amend the laws relating to the fraudulent marking of merchandise, and to the sale of merchandise falsely marked for the purpose of fraud: Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

SECT. 1. Construction of words.

1. In the construction of this Act the word "person" shall include any person, whether a subject of her Majesty or not, and any body corporate or body of the like nature, whether constituted according to the law of this country or of any of her Majesty's colonies or

SECT. 1. dominions, or according to the law of any foreign country, and also any company, association, or society of persons, whether the members thereof be subjects of her Majesty or not, or some of such persons subjects of her Majesty and some of them not, and whether such body corporate, body of the like nature, company, association, or society be established or carry on business within her Majesty's dominions or elsewhere, or partly within her Majesty's dominions and partly elsewhere; the word "mark" shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark of any other description; and the expression "trade mark" shall include any and every such name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark as aforesaid lawfully used by any person to denote any chattel, or (in *Scotland*) any article of trade, manufacture, or merchandise, to be an article or thing of the manufacture, workmanship, production, or merchandise of such person, or to be an article or thing of any peculiar or particular description made or sold by such person, and shall also include any name, signature, word, letter, number, figure, mark, or sign which in pursuance of any statute or statutes for the time being in force relating to registered designs is to be put or placed upon or attached to any chattel or article during the existence or continuance of any copyright or other sole right acquired under the provisions of such statutes or any of them; the word

"misdemeanor" shall include crime and offence in *Scotland;* and the word "court" shall include any sheriff or sheriff substitute in *Scotland.* SECT. 1.

Person.—Prior to the passing of this Act, the court would give protection to an alien using a trade mark in his business in this country in the event of infringement. "I apprehend that every subject of every country, not being an alien enemy—and even to an alien enemy the court has extended relief in cases of fraud—has a right to apply to this court to have a fraudulent injury to his property arrested. And here the plaintiffs have the right, a right recognised, I imagine, everywhere in the world, or at least in every civilised community, of saying, 'We being the manufacturers of certain goods, claim that another man shall not manufacture goods and put upon them our trade mark, and then pass them off as manufactured by us:'" *per* Wood, V.-C., in *Collins Co.* v. *Cowen*, 1857, 3 K. & J. 428; 3 Jur. N. S. 929; 29 L. T. 245; 30 L. T. 62; 5 W. R. 676.

Illustrative Cases.—(i.) An injunction was granted to an American company of edge-tool makers, restraining English manufacturers from imitating their stamp upon steel goods not made by them: *Collins Co.* v. *Cowen*, supra; *Collins Co.* v. *Brown*, Wood, V.-C., 1857, 3 K. & J. 423; 3 Jur. N. S. 929; 30 L. T. 62; *Collins Co.* v. *Reeves*, Stuart, V.-C., 1858, 28 L. J. Ch. 56; 4 Jur. N. S. 865; 33 L. T. 101; 6 W. R. 717; *Collins Co.* v. *Walker*, Kindersley, V.-C., 1859, 7 W. R. 222.

(ii.) An injunction was granted to a French manufacturer, who sold his cotton in packets labelled with a cross and the letters "C. B.," restraining an English maker from selling cotton, not the plaintiff's, as "French cross embroidery cotton," or "cross embroidery cotton," or "cross cotton," and from using a label consisting of an anchor and the letters "W. T.:" *Cartier* v. *Westhead*, Wood, V.-C., 1861, Seb. Dig. No. 199.

(iii.) A similar injunction to restrain the sale of cotton, labelled with a cross and the letters "C. S." instead of "C. B.:" *Cartier* v. *Carlile*, Romilly, M.R., 1862, 31 Beav. 292; 8 Jur. N. S. 183; see also *Howe* v. *M'Kernan*, Romilly, M.R., 1861, 30

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Beav. 547; and *Farina* v. *Cathery*, Wood, V.-C., 1867, Seb. Dig. No. 275.

Although in some of these cases actual fraud was either established or presumed, the *ratio decidendi* seems to have been in them all the mere fact that the plaintiff's right to the exclusive use of a trade mark had been infringed: see, as to this, notes under heading "Trade Mark," *infra*.

It will be noticed that the definition, contained in this section, of the "persons" who can take advantage of the Act, is very wide, and obviously includes aliens, whether carrying on business in Great Britain or not.

It is questionable, however, whether an alien owner of a trade mark who has not obtained a reputation for it by user in this country can claim any rights of property in it here: see *In re Münch's Application*, Chitty, J., 1883, 50 L. T. N. S. 12; W. N. p. 170; *In re Riviere's Trade Mark*, C. A. 1884, 26 Ch. D. 48; 53 L. J. Ch. 578; 50 L. T. N. S. 763; 32 W. R. 390; *In re Leonard and Ellis' Trade Mark*, C. A. 1884, 26 Ch. D. 288; 53 L. J. Ch. 603; 51 L. T. N. S. 35; and see note on "Acquisition of Trade Marks," *infra*.

By the Act of 1883, sect. 75, *post*, registration of a trade mark is made equivalent to public user. As to whether an alien not using his trade mark in Great Britain can register under the Act, and so secure the advantages attending registration, see Act of 1883, sections 62 and 103; and *In re Münch's Application*, *In re Riviere's Trade Mark*, and *In re Leonard and Ellis' Trade Mark*, ubi supra.

Trade Mark.—Prior to the definition in this section no authoritative definition of a trade mark existed, but the principle of law in pursuance of which trade marks were protected was well established.

"Originally the right to bring an action in respect of the improper use of a trade mark arose out of the common law right to bring an action for a false representation, which, of course, must be a false representation made fraudulently. It differed from an ordinary action for false representation in this respect, that the action for false representation is generally brought by the person to whom the false representation is made; but in the case of the improper use of a trade mark the common law

courts noticed that the false representation which is made by putting another man's trade mark, or the trade name of another manufacturer, on the goods which the wrongdoer sells, is calculated to do an injury not only to the person to whom the false or fraudulent representation is made, but to the manufacturer whose trade mark is imitated. Then the common law courts extended that doctrine one step further; first, if I recollect rightly, in the case of *Sykes* v. *Sykes* (K. B. 1824, 3 B. & Cr. 541; 5 D. & R. 292; 3 L. J. K. B. 46). There it was held that although the representation was perfectly true as between the original vendor and the original purchaser, in this sense, that the original purchaser knew perfectly well who was the real manufacturer of the goods, and so was not deceived into believing that he had bought goods manufactured by another person; yet if the trade mark was put on the goods for the purpose of enabling that purchaser, when he came to sell the goods, to deceive any one of the public into thinking that he was purchasing the goods of the manufacturer to whom the trade mark properly belonged, then that was equally a deception, a selling of goods with a false representation, which would give the original user of the trade mark a right of action: " *per* Mellish, L.J., in *Singer Manufacturing Co.* v. *Wilson*, C. A. 1876, 2 Ch. D. 453; 45 L. J. Ch. 490; 34 L. T. N. S. 863; 24 W. R. 1026.

It will be noticed that under the old practice at common law "proof of fraud on the part of the defendant is of the essence of the action:" *per* Westbury, L.C., in *Edelsten* v. *Edelsten*, 1863, 1 De G. J. & S. 185; 9 Jur. N. S. 479; 7 L. T. N. S. 768; 11 W. R. 328; see also *Singleton* v. *Bolton*, K. B. 1783, 3 Doug. 293; *Crawshay* v. *Thompson*, C. P. 1842, 4 Man. & G. 357; 11 L. J. C. P. 301; *Rodgers* v. *Nowill*, C. P. 1847, 5 C. B. 109; 17 L. J. C. P. 52. See, as to the later practice, sects. 21 and 22.

The courts of equity, however, extended the right to protection further, and held that "it was quite immaterial that the maker of the goods to which the mark was affixed did not know that it was a trade mark, and had not the slightest intention of defrauding anybody. He must not put as a mark on goods, even though he intends to establish it as his own trade mark, that which is the known trade mark of other people, and he would be restrained by injunction though he thought he himself had invented the

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trade mark, and *bonâ fide* intended it to designate goods of his own manufacture. And the reason is obvious; because the goods pass from hand to hand, and though he may act with the utmost *bona fides*, yet the ultimate purchasers might believe that they were the real goods, that is to say, that they were manufactured by the person entitled to the original trade mark:" *per* Jessel, M.R., in *Singer Manufacturing Co.* v. *Wilson*, 1875, 2 Ch. D. 434; 45 L. J. Ch. 490; 34 L. T. N. S. 858; 24 W. R. 1023.

In short, a trade mark came to be regarded in equity as a kind of property, and it was held "that the jurisdiction of the court in the protection of trade marks rests upon property, and that the court interferes by injunction because that is the only mode by which such property can be effectually protected:" *per* Westbury, L.C., in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1863, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 10 Jur. N. S. 81; 9 L. T. N. S. 558; 12 W. R. 289; see also *Millington* v. *Fox*, Cottenham, L.C., 1838, 3 My. & Cr. 338; *Clement* v. *Maddick*, Stuart, V.-C., 1859, 1 Giff. 98; 5 Jur. N. S. 592; *Edelsten* v. *Edelsten*, Westbury, L.C., 1863, 1 De G. J. & S. 185; 9 Jur. N. S. 479; 7 L. T. N. S. 768; 11 W. R. 328; *Hall* v. *Barrows*, Westbury, L.C., 1863, 4 De G. J. & S. 150; 33 L. J. Ch. 204; 9 L. T. N. S. 561; 12 W. R. 322; *Singer Manufacturing Co.* v. *Wilson*, ubi supra.

As to protection by injunction, see sect. 21.

From the above observations regarding the growth of the jurisdiction of the courts of equity, it will be gathered there is a well-established principle, "that a manufacturer is not entitled to sell his goods under the false representation that they are made by a rival manufacturer," and that of the numerous cases which come within this rule there is a distinct class consisting of those "cases where the goods manufactured are distinguished by some description or device in some way or other affixed to the article sold. It may be, as I said before, description—that is, it may consist of a name or names, or a lengthy description consisting of names with superadded words, and that description may be either affixed to or impressed upon the goods themselves by means of a stamp or an adhesive label, or it may be made to accompany the goods by being impressed or made to adhere to an

envelope or case containing the goods;" *per* Jessel, M.R., in *Singer Manufacturing Co.* v. *Wilson*, ubi supra.

These are cases of trade mark properly so called, and they are distinguishable inasmuch as all that a plaintiff seeking an injunction has to do is to show that

(i.) He has a good title to the trade mark.

(ii.) The trade mark has been imitated. He has not to show any fraudulent intention on the part of the defendant; it is enough to show that the trade mark has been taken, and "a trade mark to be taken need not be exactly copied; it need not be copied even with slight variations; but it must be a substantial portion of the trade mark; it has sometimes been called the material portion, but that means the same thing:" *per* Jessel, M.R., in *Singer Manufacturing Co.* v. *Wilson*, ubi supra; and as to the "essential particular" of a trade mark, see Act of 1883, sect. 64. As to what will constitute imitation, see sect. 5, p. 15.

Although no authoritative definition was extant of the kind of mark which would be such a trade mark as to secure to its proprietor the advantages of the jurisdiction above described, yet it was essential that it should be (i.) distinctive: see Act of 1883, sect. 64, *post;* and (ii.) attached to an article actually in the market. See *M'Andrew* v. *Bassett*, Westbury, L.C., 1864, 4 De G. J. & S. 380; 33 L. J. Ch. 566; 10 Jur. N. S. 550; 10 L. T. N. S. 442; 12 W. R. 777; and *per* Cairns, L.J., in *Maxwell* v. *Hogg*, 1867, L. R. 2 Ch. 307; 36 L. J. Ch. 433; 16 L. T. N. S. 130; 15 W. R. 467; and *per* Jessel, M.R., in *Singer Manufacturing Co.* v. *Wilson*, ubi supra.

The above definition in the Merchandise Marks Act contains a description of such trade marks as entitle their proprietors to the benefit of the Act, but beyond this it does not affect the law as stated above. See *per* Bacon, V.-C., in *Ford* v. *Foster*, 1872, L. R. 7 Ch. 616; 27 L. T. N. S. 222; 20 W. R. 311.

The Act of 1883, sect. 64, contains another definition of such marks as are registrable thereunder, and sect. 77 makes registration under that Act in the case of trade marks so registrable, and a refusal by the Comptroller to register in the case of any other trade mark in use prior to 1875, a condition precedent to any proceeding to prevent, or to recover damages for infringement.

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It may be mentioned here that the protection given by the courts of equity in trade mark cases, although there is no proof of fraud, has been extended also to some cases of trade name. "A name may be so appropriated by user as to come to mean the goods of the plaintiffs, though it is not, and never was, impressed on the goods or on the packages in which they are contained, so as to be a trade mark properly so called, or within the recent statutes. Where it is established that such a trade name bears that meaning, I think the use of that name, or one so nearly resembling it as to be likely to deceive, as applicable to goods not the plaintiff's, may be the means of passing off those goods as and for the plaintiff's just as much as the use of a trade mark; and I think the law (so far as not altered by legislation) is the same:" *per* Blackburn in *Singer Manufacturing Co.* v. *Loog*, H. L. 1882, 8 App. Cas. 32; 52 L. J. Ch. 481; 48 L. T. N. S. 3; 31 W. R. 325; and *per* Cairns, L.C., in *Singer Manufacturing Co.* v. *Wilson*, H. L. 1877, 3 App. Cas. 389; 47 L. J. Ch. 481; 38 L. T. N. S. 305; 26 W. R. 664; and see sect. 64 of the Act of 1883.

Acquisition of Trade Marks.—It has been stated above that a trade mark, properly so called, must be attached in some way to an article which is actually for sale in the market. In other words, a mark, prior to the passing of the Registration Acts, did not become a trade mark, properly so called, unless it was used publicly, so that property in it might be acquired by common repute: see *M'Andrew* v. *Bassett*, Westbury, L.C., 1864; 4 De G. J. & S. 380; 33 L. J. Ch. 566; 10 Jur. N. S. 550; 10 L. T. N. S. 442; 12 W. R. 777; and *per* Lord Blackburn in *Orr-Ewing* v. *Registrar of Trade Marks*, 1878, 4 App. Cas. 479.

It would appear essential that the user should be in this country: *In re Münch's Application*, Chitty, J., 1883, 50 L. T. N. S. 12; *In re Riviere's Trade Mark*, C. A. 1884, 26 Ch. D. 48; 53 L. J. Ch. 578; 50 L. T. N. S. 763; 32 W. R. 390; *In re Leonard and Ellis' Trade Mark*, C. A. 1884, 26 Ch. 288; 53 L. J. Ch. 603; 51 L. T. N. S. 35.

But it is not material, provided the user be in Great Britain, that the person claiming property in the mark should be a British subject: *Collins* v. *Cowen*, Wood, V.-C., 1857, 3 K. & J. 428; 3 Jur. N. S. 929; 29 L. T. 245; 30 L. T. 62; 5 W. R. 676; *Collins*

Co. v. *Reeves*, Stuart, V.-C., 1858, 28 L. J. Ch. 56; 4 Jur. N. S. 865; 33 L. T. 101; 6 W. R. 717; *Cartier* v. *Westhead*, Wood, V.-C., 1861, Seb. Dig. No. 199; *Cartier* v. *Carlile*, Romilly, M.R., 1862, 31 Beav. 292; 8 Jur. N. S. 183; and see *Mouson* v. *Boehm*, Chitty, J., 1884, 26 Ch. D. 398; 53 L. J. Ch. 932; 50 L. T. N. S. 784; 32 W. R. 612; *In re Heaton's Trade Mark*, Kay, J., 1884, 27 Ch. D. 570; 53 L. J. Ch. 959; 51 L. T. N. S. 220; 32 W. R. 951.

Nor was the length of the user material; for property in a mark affixed or applied by way of stamp to a particular vendible article, exists the moment the article goes into the market so distinguished, and there obtains acceptance and reputation whereby the mark gets currency as an indication of superior quality or of some other circumstance which renders the article so marked acceptable to the public: *per* Westbury, L.C., in *M'Andrew* v. *Bassett*, 1864, 4 De G. J. & S. 380; 33 L. J. Ch. 566; 10 Jur. N. S. 550; 10 L. T. N. S. 442; 12 W. R. 777; see also *per* Romilly, M.R., in *Hall* v. *Barrows*, 1863, 32 L. J. Ch. 548; 9 Jur. N. S. 483; 8 L. T. N. S. 227; 11 W. R. 525; *per* Malins, V.-C., in *Lee* v. *Haley*, 1869, 21 L. T. N. S. 546; 18 W. R. 181; and *per* Hall, V.-C., in *Cope* v. *Evans*, 1874, L. R. 18 Eq. 138; 30 L. T. N. S. 292; 22 W. R. 453.

Briefly, then, the sole mode in which property in a trade mark could be acquired prior to the passing of the Registration Acts was user in connection with an article actually on sale in Great Britain. Now, in addition to this mode of acquisition, registration by sect. 75 of the Act of 1883 is rendered equivalent to such user: see *per* Lord Blackburn in *Orr-Ewing* v. *Registrar of Trade Marks*, 1878, 4 App. Cas. 479; 48 L. J. Ch. 707; 41 L. T. N. S. 239; 28 W. R. 17.

Designs.—The only Act now in force relating to the registration of designs is the Patents, Designs, and Trade Marks Act, 1883 (46 & 47 Vict., c. 57). It is enacted by sect. 51 of that Act as follows:—

"Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark or with the prescribed word or words or figures denoting that the design is registered; and if he fails to do so the copyright in the design

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shall cease unless the proprietor shows that he took all proper steps to insure the marking of the article."

The mark is prescribed by rule 32 of the Designs Rules made under the Act, and is to consist of an abbreviation of the word "Registered," with the number appearing on the certificate of registration.

Forging a trade mark or falsely applying any trade mark with intent to defraud, a misdemeanor.

2. Every person who, with intent to defraud, or to enable another to defraud, any person, shall forge or counterfeit, or cause or procure to be forged or counterfeited, any trade mark, or shall apply, or cause or procure to be applied, any trade mark or any forged or counterfeited trade mark to any chattel or article not being the manufacture, workmanship, production, or merchandise of any person denoted or intended to be denoted by such trade mark, or denoted or intended to be denoted by such forged or counterfeited trade mark, or not being the manufacture, workmanship, production, or merchandise of any person whose trade mark shall be so forged or counterfeited, or shall apply, or cause or procure to be applied, any trade mark or any forged or counterfeited trade mark to any chattel or article, not being the particular or peculiar description of manufacture, workmanship, production, or merchandise denoted or intended to be denoted by such trade mark or by such forged or counterfeited trade mark, shall be guilty of a misdemeanor, and every person so committing a misdemeanor shall also forfeit to her Majesty every chattel and article belonging to such person to which he shall have so unlawfully applied, or caused or procured to be applied, any such trade mark

or forged or counterfeited trade mark as aforesaid, and every instrument in the possession or power of such person, and by means of which any such trade mark or forged or counterfeited trade mark as aforesaid shall have been so applied, and every instrument in the possession or power of such person for applying any such trade mark or forged or counterfeit trade mark as aforesaid, shall be forfeited to her Majesty; and the court before which any such misdemeanor shall be tried may order such forfeited articles as aforesaid to be destroyed or otherwise disposed of as such court shall think fit. SECT. 2.

As to what is a trade mark within the meaning of the Act, see sect. 1. It is to be noticed that intent to defraud, or to enable another to defraud, must be shown in order to secure the benefit of the Act; but see sect. 12. As to the protection in equity of trade marks in the absence of evidence of such intent, see sect. 1, and sects. 21 and 22. As to the meaning of "person" see also sect. 1.

Forgery.—Prior to this Act the imitation of a trade mark was not forgery. At common law "forgery supposes the possibility of a genuine document, and that the false document is not as good as the genuine document, and that the one is not as efficacious for all purposes as the other. In the present case one of these documents is as good as the other; the one asserts what the other does; the one is as true as the other; but the one is improperly used:" *per* Bramwell, B., in *R.* v. *Smith*, C. C. R. 1858, D. & B. 566; 8 Cox 32; 27 L. J. M. C. 225; 4 Jur. N. S. 1003; 31 L. T. 135; 6 W. R. 495. "The issuing of this wrapper without the stuff within it would be no offence. In the printing of these wrappers there is no forgery; the real offence is in issuing them with fraudulent matter in them:" *per* Pollock, C.B., *ibid.* See also *R.* v. *Closs*, C. C. R. 1857, D. & B. 460; 7 Cox 494; 27 L. J. M. C. 54; 3 Jur. N, S. 309.

Consequently the indictment in such cases should formerly

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have been for obtaining money under false pretences, and not for forgery.

The punishment for a misdemeanor under this Act is imprisonment for not more than two years, with or without hard labour or a fine: sect. 14.

A conviction does not affect any right or civil remedy of the person aggrieved: sects. 11, 21, and 22.

As to limitation of actions, see sect. 18.

There is nothing illegal or improper in a compromise of criminal proceedings taken under this Act, for it is not against the policy of the law to allow of a compromise in cases where an offender may be proceeded against either civilly or criminally at the option of the person injured: *Fisher* v. *Apollinaris Company*, C. A. 1875, L. R. 10 Ch. 297; 44 L. J. Ch. 500; 32 L. T. N. S. 628; 23 W. R. 460.

As to what amount of imitation constitutes forgery within the meaning of the Act, see sect. 5.

There is a prohibition against the importation of articles of foreign manufacture which bear the name and address, or the name and trade mark, of a manufacturer of such articles in the United Kingdom, contained in the Revenue Act, 1883: see notes to sect. 7.

Applying a forged trade mark to any vessel, case, wrapper, &c., in or with which any article is sold or intended to be sold, a misdemeanor.

3. Every person who, with intent to defraud, or to enable another to defraud, any person, shall apply or cause or procure to be applied any trade mark or any forged or counterfeited trade mark to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing in, on, or with which any chattel or article shall be intended to be sold or shall be sold or uttered or exposed for sale, or intended for any purpose of trade or manufacture, or shall enclose or place any chattel or article, or cause or procure any chattel or article to be enclosed or placed, in, upon, under, or with any cask, bottle, stopper, vessel, case,

cover, wrapper, band, reel, ticket, label, or other thing to which any trade mark shall have been falsely applied, or to which any forged or counterfeited trade mark shall have been applied, or shall apply or attach or cause or procure to be applied or attached to any chattel or article any case, cover, reel, ticket, label, or other thing to which any trade mark shall have been falsely applied, or to which any forged or counterfeited trade mark shall have been applied, or shall enclose, place, or attach any chattel or article, or cause or procure any chattel or article to be enclosed, placed, or attached, in, upon, under, with, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing having thereon any trade mark of any other person, shall be guilty of a misdemeanor, and every person so committing a misdemeanor shall also forfeit to her Majesty every such chattel and article, and also every such cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing as aforesaid in the possession or power of such person; and every other similar cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing made to be used in like manner as aforesaid, and every instrument in the possession or power of such person, and by means of which any such trade mark or forged or counterfeited trade mark as aforesaid shall have been applied, and also every instrument in the possession or power of such person for applying any such trade mark or forged or counterfeit trade mark as aforesaid, shall be forfeited to

SECT. 4. her Majesty; and the court before which any such misdemeanor shall be tried may order such forfeited articles as aforesaid to be destroyed or otherwise disposed of as such court shall think fit.

As to the punishment of a misdemeanor, see sect. 14.

As to limitation of actions, see sect. 18.

A conviction under the Act does not affect any right or civil remedy of any person aggrieved: see sects. 11, 21, and 22.

Where an offence is of such a nature, as is the case in regard to offences under this Act, that the offender may be proceeded against either civilly or criminally, there is nothing improper or illegal in a compromise of the criminal proceedings taken against him: *Fisher & Co.* v. *Apollinaris Company*, C. A. 1875, L. R. 10 Ch. 297; 44 L. J. Ch. 500; 32 L. T. N. S. 628; 23 W. R. 460.

As to the meaning of "person" and "trade mark," see sect. 1.

It is not necessary to allege in the indictment or to prove intent to defraud any particular person: see sect. 12.

As to what amount of imitation will constitute forgery, see sect. 5.

As to the importation of articles of foreign maker bearing the trade mark of a manufacturer of such articles in England, see notes to sect. 7, and the Revenue Act, 1883, sect. 2.

Selling articles with forged or false trade marks after 31st December 1863, penalty equal to value of article sold and a sum not exceeding £5, nor less than 10s.

4. Every person who, after the thirty-first day of *December* one thousand eight hundred and sixty-three, shall sell, utter, or expose either for sale or for any purpose of trade or manufacture, or cause or procure to be sold, uttered, or exposed for sale or other purpose as aforesaid, any chattel or article, together with any forged or counterfeited trade mark, which he shall know to be forged or counterfeited, or together with the trade mark of any other person applied or used falsely or wrongfully or without lawful authority or excuse, know-

ing such trade mark of another person to have been so applied or used as aforesaid, and that whether any such trade mark or forged or counterfeited trade mark as aforesaid, together with which any such chattel or article shall be sold, uttered, or exposed for sale or other purpose as aforesaid, shall be in, upon, about, or with such chattel or article, or in, upon, about, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing in, upon, about, or with which such chattel or article shall be so sold or uttered or exposed for sale or other purpose as aforesaid, shall for every such offence forfeit and pay to her Majesty a sum of money equal to the value of the chattel or article so sold, uttered, offered, or exposed for sale or other purpose as aforesaid, and a further sum not exceeding five pounds, and not less than ten shillings. SECT. 4.

As to meaning of "person" and "trade mark," see sect. 1.

As to recovery of penalties, see sects. 15 and 16.

As to limitation of actions, see sect. 18.

A vendor of an article with a trade mark is to be deemed to contract that the mark is genuine: sect. 19.

A plaintiff suing for a penalty may be compelled to give security for costs: sect. 24. But if he obtain judgment he will be entitled to an indemnity for all costs and charges incurred, unless the court order that costs of the ordinary amount only shall be allowed: sect. 17, but see also sect. 23.

The rights or civil remedies of a person aggrieved will not be affected by the fact that judgment has been obtained for the offence described in this section: sect. 11.

It is unnecessary in a proceeding under this section to prove an intention to defraud any particular person; sect. 12.

SECT. 5. As to what amount of imitation constitutes forgery, see sect. 5.

Additions to and alterations of trade marks made with intent to defraud to be deemed forgeries.

5. Every addition to and every alteration of and also every imitation of any trade mark which shall be made, applied, or used with intent to defraud or to enable any other person to defraud, or which shall cause a trade mark with such alteration or addition, or shall cause such imitation of a trade mark to resemble any genuine trade mark so or in such manner as to be calculated or likely to deceive, shall be and be deemed to be a false, forged, and counterfeited trade mark within the meaning of this Act; and every act of making, applying, or otherwise using any such addition to or alteration of a trade mark or any such imitation of a trade mark as aforesaid done by any person with intent to defraud or to enable any other person to defraud, shall be and be deemed to be forging and counterfeiting a trade mark within the meaning of this Act.

Prior to this Act, the imitation of a trade mark might support an indictment for obtaining money under false pretences, but not for forgery: see notes to sect. 1, and *R.* v. *Closs*, C. C. R. 1857, D. & B. 460; 7 Cox 494; 27 L. J. M. C. 54; 3 Jur. N. S. 309; and *R.* v. *Smith*, C. C. R. 1858, D. & B. 566; 8 Cox 32; 27 L. J. M. C. 225; 4 Jur. N. S. 1003; 31 L. T. 135; 6 W. R. 495.

It is unnecessary in a proceeding under this Act to prove that the accused intended to defraud any particular person; it is sufficient to prove that he did the act charged with intent to defraud, or to enable some other person to defraud, or that any other person might be enabled to defraud: sect. 12.

A comparison may be made between the definition of forgery contained in this section and the rule in regard to imitation

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adopted in the courts of equity. To secure protection it is enough to show that a trade mark has been taken; and "a trade mark to be taken need not be exactly copied; it need not be copied even with slight variations; but it must be a substantial portion of the trade mark; it has sometimes been called the material portion, but that means the same thing:" *per* Jessel, M.R., in *Singer Manufacturing Co.* v. *Wilson*, 1875, 2 Ch. D. 434; 45 L. J. Ch. 490; 34 L. T. N. S. 858; 24 W. R. 1023. As to what is an essential particular, see Act of 1883, sect. 64.

In short, the test of the degree of imitation which will amount to forgery, or to infringement, as the case may be, is the probability of deception. As to what has been held "calculated to deceive," see *Ransome* v. *Benthall*, Shadwell, V.-C., 1833, 3 L. J. Ch. 161; *Crawshay* v. *Thompson*, C. P. 1842, 4 Man. & G. 357; 5 Scott N. R. 562; 11 L. J. C. P. 301; *Spottiswoode* v. *Clarke*, Cottenham, L.C., 1846, 2 Ph. 154; 1 Coop. 254; 10 Jur. 1043; *Welch* v. *Knott*, Wood, V.-C., 1857, 4 K. & J. 747; 4 Jur. N. S. 330; *Woollam* v. *Ratcliff*, Wood, V.-C., 1863, 1 H. & M. 259; *Browne* v. *Freeman*, Wood, V.-C., 1864, 12 W. R. 305; *Blackwell* v. *Crabb*, Wood, V.-C., 1867, 36 L. J. Ch. 504; *Cope* v. *Evans*, Hall, V.-C., 1874, L. R. 18 Eq. 138; 30 L. T. N. S. 292; 22 W. R. 453.

A similar test is adopted in deciding as to the similarity of trade marks, sought to be registered under the Act of 1883, to trade marks already on the register: see Act of 1883, sect. 72, and notes thereto, *post*.

Any person who, after 31st December 1863, shall have sold an article having a false trade mark, to be bound to give information where he procured it.

6. Where any person who, at any time after the thirty-first day of *December* one thousand eight hundred and sixty-three, shall have sold, uttered, or exposed for sale or other purpose as aforesaid, or shall have caused or procured to be sold, uttered, or exposed for sale or other purpose as aforesaid, any chattel or article, together with any forged or counterfeited trade mark, or together with the trade mark of any other person used without lawful authority or excuse as aforesaid, and that

SECT. 6. whether any such trade mark, or such forged or counterfeited trade mark as aforesaid, be in, upon, about, or with such chattel or article, or in, upon, about, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing in, upon, about, or with which such chattel or article shall have been sold or exposed for sale, such person shall be bound, upon demand in writing delivered to him or left for him at his last known dwelling-house or at the place of sale or exposure for sale by or on the behalf of any person whose trade mark shall have been so forged or counterfeited or used without lawful authority or excuse as aforesaid, to give to the person requiring the same, or his attorney or agent, within forty-eight hours after such demand, full information in writing of the name and address of the person from whom he shall have purchased or obtained such chattel or article, and of the time when he obtained the same; and it shall be lawful for any justice of the peace, on information on oath of such demand and refusal, to summon before him the party refusing, and on being satisfied that such demand ought to be complied with, to order such information to be given within a certain time to be appointed by him; and any such party who shall refuse or neglect to comply with such order shall for every such offence forfeit and pay to her Majesty the sum of five pounds, and such refusal or neglect shall be *primâ facie* evidence that the person so refusing or neglecting had full knowledge that the trade mark,

Power to justices to summon parties refusing to give information.

Penalty for refusal, £5.

together with which such chattel or article was sold, uttered, or exposed for sale or other purpose as aforesaid, at the time of such selling, uttering, or exposing, was a forged, counterfeited, and false trade mark, or was the trade mark of a person which had been used without lawful authority or excuse, as the case may be.

As to meaning of "person" and "trade mark," see sect. 1; and as to what constitutes a forged or counterfeited trade mark, see sect. 5.

As to recovery of penalties, see sects. 15 and 16. The vendor of an article with a forged trade mark himself commits an offence: sect. 4. And even where there is no intent to defraud, he is deemed to give a warranty that the trade mark is genuine: sect. 19.

A person suing for a penalty may be compelled to give security for costs: sect. 24. But if he succeed, he will be, as a rule, entitled to a full indemnity for all costs and charges incurred for the purposes of the action: sect. 17.

Marking any false indication of quantity, &c., upon an article with intent to defraud, penalty a sum equal to the value of the article and the further sum not exceeding £5, and not less than 10s.

7. Every person who, with intent to defraud or to enable another to defraud, shall put or cause or procure to be put upon any chattel or article, or upon any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing, together with which any chattel or article shall be intended to be or shall be sold or uttered or exposed for sale, or for any purpose of trade or manufacture, or upon any case, frame, or other thing in or by means of which any chattel or article shall be intended to be or shall be exposed for sale, any false description, statement, or other indication of or respecting the number, quantity, measure, or weight of

SECT. 7. such chattel or article, or any part thereof, or of the place or country in which such chattel or article shall have been made, manufactured, or produced, or shall put or cause or procure to be put upon any such chattel or article, cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or thing as aforesaid, any word, letter, figure, signature, or mark for the purpose of falsely indicating such chattel or article, or the mode of manufacturing or producing the same, or the ornamentation, shape, or configuration thereof, to be the subject of any existing patent, privilege, or copyright, shall for every such offence forfeit and pay to her Majesty a sum of money equal to the value of the chattel or article so sold or uttered or exposed for sale, and a further sum not exceeding five pounds and not less than ten shillings.

As to the meaning of "person" see sect. 1, and as to the recovery of penalties, see sects. 15 and 16.

A person suing for a penalty may be compelled to give security for costs: sect. 24. If, however, he obtain judgment he will, as a rule, be entitled to a full indemnity in respect of such costs: sect. 17; see, however, sect. 23.

It is unnecessary in a proceeding under this section to prove an intent to defraud any particular person: sect. 12.

The recovery of the penalty for the offence here defined, will not affect the rights or civil remedies of the person injured: sect. 11.

A person selling an article, with a false description upon it, is liable in a penalty; sect. 8. And even if he does so in ignorance he is deemed to give a warranty that the description is true: sect. 20.

As to geographical names which may indicate a source of origin

or may be merely fancy names, by the use of which no deception is conceivable, see notes to sect. 64 (3) of the Act of 1883.

It is provided by the Customs Consolidation Act, 1876 (39 & 40 Vict., c. 36), sect. 153, that "if any articles of foreign manufacture, and any packages of such articles, bearing any names, brands, or marks, being or purporting to be the names, brands, or marks of manufacturers resident in the United Kingdom, shall be imported into any of the British possessions abroad, the same shall be forfeited."

And by sect. 42 it is enacted that clocks and watches, or any other article of metal, impressed with any mark or stamp, representing, or in imitation of any legal British assay, mark, or stamp, or purporting, by any mark or appearance, to be of the manufacture of the United Kingdom, if imported into the United Kingdom, shall be forfeited, destroyed, or otherwise disposed of. By an amending Act—the Revenue Act, 1883 (46 & 47 Vict., c. 55), sect. 2—it is provided that the following enactments shall have effect as if they were contained in the above sect. 42 :—

"1. (*a.*) Articles of foreign manufacture not imported by or for, but bearing the name and address, or name and trade mark, of a manufacturer of such articles resident or having a place of business in the United Kingdom.

"(*b.*) Articles of foreign manufacture bearing, either alone or in conjunction with other names or words, the name of a part of, or place in the United Kingdom, which name has, in the opinion of the Commissioners of Customs, been placed upon such articles to impart to them a special character of British manufacture.

"2. The proprietary right of a manufacturer in any name or mark on any articles of foreign manufacture shall be proved or evidenced in such manner and upon such conditions as the Commissioners of Customs shall prescribe.

"3. Articles bearing the name of a place which would render them subject to prohibition under this section shall not be admissible by reason of there being another place of the same name out of the United Kingdom.

"4. Names, addresses, and marks on boxes, cases, cards, or other things in which, or attached to which, articles of foreign manufacture are imported, shall be deemed to be borne by the articles themselves.

SECT. 7.

"5. The Commissioners of Customs in administering this section, whether in the exercise of any discretion or opinion or otherwise, shall act under the control of the Commissioners of Her Majesty's Treasury.

"6. In this section the word 'name,' as applied to a manufacturer, shall include any abbreviation or imitation of a name, and the word 'manufacturer' shall include a dealer, and a manufacturing or trading company, having a place of business in the United Kingdom."

Misrepresentation.—Prior to the passing of this Act misrepresentations, such as are indicated in this section, were sufficient to disentitle the owner of a mark to the protection of the court: *Pidding* v. *How*, Shadwell, V.-C., 1837, 8 Sim. 477; 6 L. J. Ch. 345; *Perry* v. *Truefitt*, Langdale, M.R., 1842, 6 Beav. 66; 1 L. T. 384; *Leather Cloth Co.* v. *American Leather Cloth Co.*, H. L. 1865, 11 H. L. C. 525; 35 L. J. Ch. 53; 11 Jur. N. S. 513; 12 L. T. N. S. 742; 13 W. R. 873; and see notes to sect. 73 of the Act of 1883.

The question has most frequently arisen in regard to the use of the word "patent" or "patented." The general rule is that (1.) if the article has never been the subject of a patent the use of the word will disentitle to protection: *Flavel* v. *Harrison*, Wood, V.-C., 1853, 10 Hare 467; 22 L. J. Ch. 866; 17 Jur. 368; 1 W. R. 213; *Morgan* v. *M'Adam*, Wood, V.-C., 1866, 36 L. J. Ch. 228; 15 L. T. N. S. 348; *Leather Cloth Co.* v. *Lorsent*, James, V.-C., 1869, 9 Eq. 345; 39 L. J. Ch. 86; 21 L. T. N. S. 661; 18 W. R. 572; *Lamplough* v. *Balmer*, Wood, V.-C., 1867, W. N., p. 293; *Nixey* v. *Roffey*, Malins, V.-C., 1870, W. N., p. 227; but that (2.) if the article has been the subject of a patent which has expired, the use of the word will disentitle to protection only when the user is of such a nature as to imply that the patent is still subsisting: *Leather Cloth Co.* v. *American Leather Cloth Co.*, ubi supra; *Cheavin* v. *Walker*, C. A. 1877, 5 Ch. D. 850; 46 L. J. Ch. 686; 36 L. T. N. S. 938.

There will naturally be no false representation of the existence of a patent, when by the usage of many years the word "patent" has become a mere designation of the goods: *Edelsten* v. *Vick*, Wood, V.-C., 1853, 11 Hare 78; 18 Jur. 7; *Marshall* v. *Ross*, James, V.-C., 1869, L. R. 8 Eq. 651; 39 L. J. Ch. 225;

21 L. T. N. S. 260; 17 W. R. 1086; and see *Sykes* v. *Sykes*, K. B. 1824, 3 B. & C. 541; 5 D. & R. 292; 3 L. J. K. B. 46; and *Cheavin* v. *Walker*, ubi supra. It will be observed that similar principles to those enunciated above are followed in this Act; *i.e.*, by the insertion of the word "existing" and the proviso in sect. 9, *post*. SECT. 8.

It is provided by the Act of 1883, sect. 105, that any person who represents that any article sold by him is a patented article when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable to a fine not exceeding five pounds.

The words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery," will not in any case be registered under the last-named Act: see Instructions, 30, *post*.

Sect. 73 of the Act of 1883 contains also an absolute prohibition against the registration as part of or in combination with a trade mark of any words the exclusive use of which would by reason of their being calculated to deceive be deemed disentitled to protection in a court of justice.

As to false representations that medals or certificates have been awarded in respect of any articles by the Exhibition Commissioners of 1851 or 1862, see the Exhibition Medals Act, 1863, (26 & 27 Vict., c. 119).

As to registered designs and the mark thereon indicating that they are the subject of copyright, see notes under heading "Designs" to sect. 1.

A trade mark owner who is himself guilty of misrepresentation cannot take advantage of the facilities conferred by this Act: *Morgan* v. *M'Adam*, Wood, V.-C., 1866, 36 L. J. Ch. 228; 15 L. T. N. S. 348.

8. Every person who, after the thirty-first of *December* one thousand eight hundred and sixty-three, shall sell, utter, or expose for sale or for any purpose of trade or manufacture, or shall cause or procure to be sold, uttered, Selling or exposing for sale after the 31st December 1863 articles with false state-

SECT. 8. ment of quantities, &c., penalty not more than £5 or less than 5s.

or exposed for sale or other purpose as aforesaid, any chattel or article upon which shall have been, to his knowledge, put, or upon any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing, together with which such chattel or article shall be sold or uttered or exposed for sale or other purpose as aforesaid, shall have been so put, or upon any case, frame, or other thing used or employed to expose or exhibit such chattel or article for sale shall have been so put, any false description, statement, or other indication of or respecting the number, quantity, measure, or weight of such chattel or article or any part thereof, or the place or country in which such chattel or article shall have been made, manufactured, or produced, shall for every such offence forfeit and pay to her Majesty a sum not exceeding five pounds and not less than five shillings.

As to the meaning of "person," see sect. 1; and as to the recovery of penalties, see sects. 15 and 16.

A person suing for a penalty may be compelled to give security for costs: sect. 24. But if he succeed in obtaining judgment he will ordinarily be entitled to a full indemnity in respect of all costs incurred: sect. 17, and compare sect. 23.

In a proceeding under this section, intent to defraud any particular person need not be proved, but fraudulent knowledge must be shown: sect. 12.

A vendor selling, even in ignorance, an article with such a description upon it as is defined in this section, impliedly contracts that the description is true: sect. 20.

The civil remedies of any person injured will not be affected by the recovery of penalties under this section: sect. 11.

This section is subject to the proviso in sect. 9.

As to geographical names which are merely fancy designations and do not indicate a source of supply, see notes to sect. 64 (3) of the Act of 1883.

As to the importation of goods of foreign manufacture bearing the name and address, or name and trade mark, of a manufacturer of such goods in the United Kingdom, see notes to sect. 7, *ante*.

Proviso that it shall not be an offence to apply names or words known to be used for indicating particular classes of manufactures.

9. Provided always, that the provisions of this Act shall not be construed so as to make it any offence for any person to apply to any chattel or article, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing with which such chattel or article shall be sold or intended to be sold, any name, word, or expression generally used for indicating such chattel or article to be of some particular class or description of manufacture only, or so as to make it any offence for any person to sell, utter, or offer or expose for sale any chattel or article to which, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing sold therewith, any such generally used name, word, or expression as aforesaid shall have been applied.

This section qualifies the two preceding sections. As to names, words, and expressions, which have ceased to be distinctive (*i.e.* "distinguishing the manufacture of one person from the manufacture of all others:" *per* Fry, L.J., in *In re Leonard and Ellis' Trade Mark*, C. A. 1884, 26 Ch. D. 288; 53 L. J. Ch. 603; 51 L. T. N. S. 35), and merely indicate that the article to which they are applied is of some particular class or description of manufacture, see notes to sect. 64 (3) of the Act of 1883.

By sect. 73 of the Act of 1883, the registration is absolutely prohibited of any words as part of, or in combination with a trade

SECTS. 10, 11.

mark, the exclusive use of which would, by reason of their being calculated to deceive, be disentitled to protection in a court of justice.

As to the use of the word "patent" as part of the description in a label or trade mark of goods which are not protected by a patent, but which from the usage of many years have acquired the designation, in the trade generally, of patent, see *Marshall* v. *Ross*, James, V.-C., 1869, L. R. 8 Eq. 651; 39 L. J. Ch. 225; 21 L. T. N. S. 260; 17 W. R. 1086, and notes to sect. 7, *ante*.

Description of trade marks and forged trade marks in indictments, &c.

10. In every indictment, pleading, proceeding, and document whatsoever in which any trade mark shall be intended to be mentioned, it shall be sufficient to mention or state the same to be a trade mark, without further or otherwise describing such trade mark, or setting forth any copy or facsimile thereof; and in every indictment, pleading, proceeding, and document whatsoever in which it shall be intended to mention any forged or counterfeit trade mark it shall be sufficient to mention or state the same to be a forged or counterfeit trade mark without further or otherwise describing such forged or counterfeit trade mark, or setting forth any copy or facsimile thereof.

As to what is a trade mark within the scope of the Act, see sect. 1, and as to what degree of imitation constitutes forgery, see sect. 5.

It is unnecessary also to allege an intent to defraud any particular person: sect. 12.

Conviction not to affect any right or civil remedy.

11. The provisions in this Act contained of or concerning any act or any proceeding, judgment, or conviction for any act hereby declared to be a misde-

meanor or offence, shall not, nor shall any of them, take away, diminish, or prejudicially affect any suit, process, proceeding, right, or remedy which any person aggrieved by such act may be entitled to at law, in equity, or otherwise, and shall not nor shall any of them exempt or excuse any person from answering or making discovery upon examination as a witness or upon interrogatories or otherwise in any suit or other civil proceeding: provided always, that no evidence, statement, or discovery which any person shall be compelled to give or make shall be admissible in evidence against such person in support of any indictment for a misdemeanor at common law or otherwise, or of any proceeding under the provisions of this Act. SECT. 11.

By sect. 77 of the Act of 1883, it is enacted that a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark, unless, in the case of a trade mark capable of being registered under that Act, it has been registered in pursuance thereof, or in the case of any other trade mark in use before the 13th August 1875, registration thereof has been refused.

As to what marks are registrable, see sect. 64 of the Act of 1883.

It will be noticed that registration or refusal to register is made a condition precedent to the institution of civil proceedings in the case of all trade marks, with the sole exception of such marks brought into use since 1875 as are not within the definition contained in sect. 64.

As to the wide interpretation placed on the word "person," see sect. 1, *ante*.

And as to the meaning of "aggrieved," compare Act of 1883, sect. 90; and *In re Riviere's Trade Mark*, C. A. 1884, 26 Ch. D. 48; 53 L. J. Ch. 578; 32 W. R. 390.

SECT. 12. As to civil remedies for the infringement of trade marks, see sects. 21 and 22.

Intent to defraud, &c., any particular person need not be alleged in an indictment, &c., or proved.

12. In every indictment, information, conviction, pleading, and proceeding against any person for any misdemeanor or other offence against the provisions of this Act in which it shall be necessary to allege or mention an intent to defraud, or to enable another to defraud, it shall be sufficient to allege or mention that the person accused of having done any Act which is hereby made a misdemeanor or other offence did such Act with intent to defraud, or with intent to enable some other person to defraud, without alleging or mentioning an intent to defraud any particular person; and on the trial of any such indictment or information for any such misdemeanor, and on the hearing of any information or charge of or for any such other offence as aforesaid, and on the trial of any action against any person to recover a penalty for any such other offence as aforesaid, it shall not be necessary to prove an intent to defraud any particular person, or an intent to enable any particular person to defraud any particular person, but it shall be sufficient to prove with respect to every such misdemeanor and offence that the person accused did the act charged with intent to defraud, or with intent to enable some other person to defraud, or with the intent that any other person might be enabled to defraud.

It is also not necessary to describe the trade mark in the indictment or to set out a copy of it: sect. 10.

As to the protection of trade marks in the absence of fraudulent intention, see notes to sect. 1, and sect. 21.

Persons who aid in the commission of a misdemeanor to be also guilty.

13. Every person who shall aid, abet, counsel, or procure the commission of any offence which is by this Act made a misdemeanor, shall also be guilty of a misdemeanor.

As to meaning of "person" here, see sect. 1.

The offences made misdemeanors by the Act are described in sects. 2 and 3.

As to the punishment of a misdemeanor, see the next section below.

The word "misdemeanor" includes crime and offence in Scotland: sect. 1.

There is nothing illegal or improper in the compromise of proceedings under this Act, for it is not against the policy of the land to allow of a compromise in cases where a person may be proceeded against either civilly or criminally at the option of the person injured: *Fisher* v. *Apollinaris Company*, C. A. 1875, L. R. 10 Ch. 297; 44 L. J. Ch. 500; 22 L. T. N. S. 628; 23 W. R. 460.

Compare with this section the Summary Jurisdiction Act, 1848, (11 & 12 Vict., c. 43), sect. 5, and see sect. 16, *post*.

Punishment for misdemeanor under this Act.

14. Every person who shall be convicted or found guilty of any offence which is by this Act made a misdemeanor shall be liable, at the discretion of the court and as the court shall award, to suffer such punishment by imprisonment for not more than two years, with or without hard labour, or by fine, or both by imprisonment with or without hard labour and fine, and also by imprisonment until the fine (if any) shall have been paid and satisfied.

SECT. 15. The word "misdemeanor" includes crime and offence in Scotland, and the word "court" includes any sheriff or sheriff substitute: sect. 1.

The offences made misdemeanors by the Act are defined in sects. 2, 3, and 13.

As to the meaning of "person," see sect. 1.

Recovery of penalties.

15. In every case in which any person shall have committed or done any offence or act whereby he shall have forfeited or become liable to pay to her Majesty any of the penalties or sums of money mentioned in the provisions of this Act, every such penalty or sum of money shall or may be recovered in *England*, *Wales*, or *Ireland* in an action of debt, which any person may as plaintiff for and on behalf of her Majesty commence and prosecute to judgment in any court of record, and the amount of every such penalty or sum of money to be recovered in any such action shall or may be determined by the jury (if any) sworn to try any issue in such action, and if there shall be no such jury then by the court or some other jury, as the court shall think fit, or instead of any such action being commenced such penalty or sum of money shall or may in *England* or *Wales* be recovered by a summary proceeding before two justices of the peace having jurisdiction in the county or place where the party offending shall reside or have any place of business, or in the county or place in which the offence shall have been committed; and shall or may in *Ireland* be recovered in like manner by civil bill in the civil bill court of the county or place in which the offence was committed, or in which the

offender shall reside or have any place of business; and shall or may in *Scotland* be recovered by action before the Court of Session in ordinary form or by summary action before the sheriff of the county where the offence shall have been committed or the offender may reside or have any place of business, which sheriff, upon proof of the offence, either by the confession of the person offending or by the oath or affirmation of one or more credible witnesses, shall convict the offender, and find him liable in the penalty or penalties aforesaid, as also in expenses; and it shall be lawful for the sheriff in pronouncing such judgment for the penalty or penalties and costs to insert in such judgment a warrant in the event of such penalty or penalties and costs not being paid to levy and recover the amount of the same by poinding: provided always, that it shall be lawful to the sheriff, in the event of his dismissing the action and assoilzing the defender, to find the complainer liable in expenses; and any judgment so to be pronounced by the sheriff in such summary action shall be final and conclusive, and not subject to review by advocation, suspension, reduction, or otherwise. SECT. 15.

Penalties may be recovered, it will be noticed, either by a *qui tam* action or summarily before justices at petty sessions under the Summary Jurisdiction Acts (11 & 12 Vict., c. 43, as amended by 42 & 43 Vict., c. 49): see next section.

The plaintiff obtaining judgment in an action will, as a rule, be entitled to a full indemnity for all costs and charges: sect. 17. But he may be compelled to find security: sect. 24.

As to the costs in a summary proceeding, see 11 & 12 Vict., c. 43, sect. 18.

SECTS. 16, 17. And as to the costs of a defendant in an action if he obtain judgment, see sect. 23.

Summary proceedings before justices to be within 11 & 12 Vict., c. 43.

16. In every case in which any such penalty or sum of money forfeited to her Majesty as hereinbefore mentioned shall be sought to be recovered by a summary proceeding before two justices of the peace, the offence or act by the committing or doing of which such penalty or sum of money shall have been so forfeited shall be and be deemed to be an offence and act within the meaning of a statute passed in the twelfth year of the reign of her present Majesty, intituled *An Act to facilitate the performance of the duties of justices of the peace out of sessions within* England *and* Wales *with respect to summary convictions and orders;* and the information, conviction of the offender, and other proceedings for the recovery of the penalty or sum so forfeited shall be had according to the provisions of the said Act.

The Act 11 & 12 Vict., c. 43, has been amended by the Summary Jurisdiction Act, 1879 (42 & 43 Vict., c. 49).

As to costs, see 11 & 12 Vict., c. 43, sect. 18.

In actions, penalties to be accounted for in like manner as other monies payable to the crown, and plaintiffs to recover full costs of suit.

17. In every case in which judgment shall be obtained in any such action as aforesaid for the amount of any such penalty or sum of money forfeited to her Majesty, the amount thereof shall be paid by the defendant to the sheriff or the officer of the court, who shall account for the same in like manner as other monies payable to her Majesty, and, if it be not paid, may be recovered, or the amount thereof levied, or the payment thereof

enforced, by execution or other proper proceeding, as money due to her Majesty; and the plaintiff suing on behalf of her Majesty, upon obtaining judgment, shall be entitled to recover and have execution for all his costs of suit, which shall include a full indemnity for all costs and charges which he shall or may have expended or incurred in, about, or for the purposes of the action, unless the court, or a judge thereof, shall direct that costs of the ordinary amount only shall be allowed. SECT. 18.

As to the costs of the defendant if he obtain judgment, see sect. 23. The plaintiff may be compelled to give security: sect. 24.

It is questionable whether this section and sect. 23, relating to the costs of actions, have not been impliedly repealed by Order lxv. of the Rules of the Supreme Court, 1883, which leaves the costs of all proceedings to the discretion of the court or judge; for although, as a general rule, an Act directed to a special object or a special class of objects will not be repealed by a subsequent general Act embracing in its generality those particular objects, unless some reference be made directly or by necessary inference to the preceding special Act, yet if under the circumstances it can be shown that the Legislature intended to repeal the special Act, such repeal must be taken to have been effected by implication: *Garnett* v. *Bradley*, H. L. 1878, 3 App. Cas. 944; 48 L. J. Ex. 186; 39 L. T. N. S. 261; 26 W. R. 698.

The term "court" includes any sheriff or sheriff substitute in Scotland: sect. 1.

18. No person shall commence any action or proceeding for the recovery of any penalty, or procuring the conviction of any offender in manner hereinbefore provided, after the expiration of three years next after the committing of the offence, or one year next after the first discovery thereof by the person proceeding. Limitations of actions, &c.

SECT. 19. See Summary Jurisdiction Act, 1848 (11 & 12 Vict., c. 43): sect. 11.

After 31st December 1863 vendor of an article with a trade mark to be deemed to contract that the mark is genuine.

19. In every case in which at any time after the thirty-first day of *December* one thousand eight hundred and sixty-three any person shall sell or contract to sell (whether by writing or not) to any other person any chattel or article with any trade mark thereon, or upon any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing together with which such chattel or article shall be sold or contracted to be sold, the sale or contract to sell shall in every such case be deemed to have been made with a warranty or contract by the vendor to or with the vendee that every trade mark upon such chattel or article, or upon any such cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing as aforesaid, was genuine and true, and not forged or counterfeit, and not wrongfully used, unless the contrary shall be expressed in some writing signed by or on behalf of the vendor, and delivered to and accepted by the vendee.

As to what is a trade mark, see sect. 1.

Prior to this enactment, a vendor who sold an article with a trade mark to his knowledge improperly affixed thereto was undoubtedly liable to a common law action for deceit on the part of a purchaser induced by the misrepresentation to purchase: *Pasley* v. *Freeman*, K. B. 1789, 3 T. R. 51; see 2 Smith's, L. C. 64; *Behn* v. *Kemble*, C. P. 1859, 7 C. B. N. S. 260.

And possibly also an action would lie if the vendor, knowing that the purchaser relied upon the trade mark, sold the article recklessly, in ignorance whether the trade mark were or were not

properly affixed thereto: *Taylor* v. *Ashton*, Ex. 1843, 11 M. & W. 401; 12 L. J. Ex. 363; 7 Jur. 978; *Reese Silver Mining Co.* v. *Smith*, H. L. 1869, L. R. 4 H. L. 64; 39 L. J. Ch. 849; *Behn* v. *Burness*, Ex. Ch. 1863, 3 B. & S. 751; 32 L. J. Q. B. 204; 9 Jur. N. S. 620; 8 L. T. 207.

But of course this would not be the case if the vendor had reasonable grounds, when selling, for believing that the trade mark was properly affixed: *Collins* v. *Evans*, Ex. Ch. 1844, D. & M. 669; 5 Q. B. 805; 13 L. J. Q. B. 180; 8 Jur. 345; *Shrewsbury* v. *Blunt*, C. P. 1841, 2 Man. & G. 475; 2 Scott N. R. 588.

If fraud is relied upon, it must be distinctly alleged and proved: *per* Thesiger, L.J., in *Davy* v. *Garrett*, C. A. 1878, 7 Ch. D. 489; 47 L. J. Ch. 218; 38 L. T. N. S. 77; 26 W. R. 225. See also *Barley* v. *Walford*, Q. B. 1846, 9 Q. B. 197; 15 L. J. Q. B. 369, and *Taylor* v. *Ashton*, supra.

And it must also be shown that the misrepresentation actually induced the purchaser to purchase and so act to his prejudice: *Smith* v. *Chadwick*, C. A. 1881, 20 Ch. D. 27; 51 L. J. Ch. 597; 46 L. T. N. S. 702; 30 W. R. 661.

It is possible also that, irrespective of the above enactment, some cases of the sale of goods with trade marks might be brought within the rule that where the contract is to supply goods of a specified description which the buyer has no opportunity of inspecting, the goods must not only, in fact, answer the specific description, but must also be saleable under that description: *Jones* v. *Just*, Q. B. 1868, L. R. 3 Q. B. 196; 37 L. J. Q. B. 89; 18 L. T. N. S. 208; 16 W. R. 643; *Bigge* v. *Parkinson*, Ex. Ch. 1862, 7 H. & N. 995; 31 L. J. Ex. 301; 8 Jur. N. S. 1014; 7 L. T. N. S. 92; 10 W. R. 349.

Now, in addition to the above remedies, a warranty that the trade mark is genuine is to be deemed to be implied in the contract for sale of the goods to which it is affixed. This renders proof of fraud unnecessary.

Action on the Warranty.—When fraud is proved, the contract of sale is voidable, and the purchaser has a right to disaffirm it, and by returning the goods, to reinstate as far as possible the vendor, and if the goods have been paid for to recover back the price in an action for money had and received: *Dawes* v. *Harness*, C. P. 1874, L. R. 10 C. P. 166; 44 L. J. C. P. 194; 32 L. T.

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N. S. 159; 23 W. R. 398; *Morrison* v. *Universal Marine Ins. Co.*, Ex. Ch. 1873, L. R. 8 Ex. 197; 42 L. J. Ex. 115; 21 W. R. 774; *Clough* v. *L. & N. W. R. Co.*, Ex. Ch. 1871, L. R. 7 Ex. 26; 41 L. J. Ex. 17; 25 L. T. N. S. 708; 20 W. R. 187.

If, however, the action be upon the implied warranty, the purchaser cannot force the vendor to take back specific goods: *Street* v. *Blay*, K. B., 1831, 2 B. & Ad. 456; *Gompertz* v. *Denton*, Ex. Ch. 1832, 1 C. & M. 207; 1 D. P. C. 623; *Dawson* v. *Collis*, C. P. 1851, 10 C. B. 523; 20 L. J. C. P. 116; *Heyworth* v. *Hutchinson*, Q. B. 1867, L. R. 2 Q. B. 447; 36 L. J. Q. B. 270; *Poulton* v. *Lattimore*, K. B. 1829, 4 Man. & R. 208; 9 B. & C. 295.

But if, at the time of purchase, the goods were not ascertained, he can, on discovering the breach of warranty, refuse to receive them, or even send them back within a reasonable time: *Street* v. *Blay*, supra; *Heilbutt* v. *Hickson*, C. P. 1872, L. R. 7 C. P. 438; 41 L. J. C. P. 228; 27 L. T. N. S. 336; 20 W. R. 1035; *Azemar* v. *Casella*, Ex. Ch. 1867, L. R. 2 C. P. 677; 36 L. J. C. P. 263; 16 L. T. N. S. 571; 15 W. R. 998.

Measure of Damages. — "When the thing sold has been returned, and no special loss has accrued, the damages consist of the price paid. If, however, no price has been paid the damages could, it is apprehended, be merely nominal. As the contract is rescinded, no claim for the price could ever be made, and the hypothesis assumes that no other injury has taken place:" Mayne on Damages, p. 180, and see *Heilbutt* v. *Hickson*, supra. "Where the article has not been returned, the measure of damage will be the difference between its value with the defect warranted against, and the value which it would have borne without the defect:" Mayne, ibid.; Sedgwicke on Damages, p. 325; *Jones* v. *Just*, supra.

In other words, the damages will be the difference between the actual value of the goods sold, and what would have been their value if the trade mark had been genuine.

After 31st December 1863 vendor of an article with de-

20. In every case in which at any time after the thirty-first day of *December* one thousand eight hundred and sixty-three any person shall sell or contract to sell

(whether by writing or not) to any other person any chattel or article upon which, or upon any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing together with which such chattel or article shall be sold or contracted to be sold, any description, statement, or other indication of or respecting the number, quantity, measure, or weight of such chattel or article, or the place or country in which such chattel or article shall have been made, manufactured, or produced, the sale or contract to sell shall in every such case be deemed to have been made with a warranty or contract by the vendor to or with the vendee that no such description, statement, or other indication was in any material respect false or untrue, unless the contrary shall be expressed in some writing signed by or on behalf of the vendor, and delivered to and accepted by the vendee.

scription upon it of its quantity to be deemed to contract that the description was true.

Compare with this section, sects. 7 and 8. As to the general effect of this implied warranty, see notes to preceding section.

21. In every case in any suit at law or in equity against any person for forging or counterfeiting any trade mark, or for fraudulently applying any trade mark to any chattel or article, or for selling, exposing for sale, or uttering any chattel or article with any trade mark falsely or wrongfully applied thereto, or with any forged or counterfeit trade mark applied thereto, or for preventing the repetition or continuance of any such wrongful act, or the committal of any similar act, in

In suits at law or in equity against persons for using forged trade marks, court may order article to be destroyed, and may award injunction, &c.

SECT. 21. which the plaintiff shall obtain a judgment or decree against the defendant, the court shall have power to direct every such chattel and article to be destroyed or otherwise disposed of; and in every such suit in a court of law the court shall or may, upon giving judgment for the plaintiff, award a writ of injunction or injunctions to the defendant, commanding him to forbear from committing and not by himself or otherwise to repeat or commit any offence or wrongful act of the like nature as that of which he shall or may have been convicted by such judgment, and any disobedience of any such writ of injunction or injunctions shall be punished as a contempt of court; and in every such suit at law or in equity it shall be lawful for the court or a judge thereof to make such order as such court or judge shall think fit for the inspection of every or any manufacture or process carried on by the defendant in which any such forged or counterfeit trade mark, or any such trade mark as aforesaid, shall be alleged to be used or applied as aforesaid, and of every or any chattel, article, and thing in the possession or power of the defendant alleged to have thereon or in any way attached thereto any forged or counterfeit trade mark, or any trade mark falsely or wrongfully applied, and every or any instrument in the possession or power of the defendant used or intended to be or capable of being used for producing or making any forged or counterfeit trade mark, or trade mark alleged to be forged or counterfeit, or for falsely or wrongfully applying any trade mark;

and any person who shall refuse or neglect to obey any such order shall be guilty of a contempt of court. SECT. 21.

As to what is a "forged or counterfeit" trade mark, see sects. 1 and 5.

Injunction.—The remedy by injunction was in its origin an equitable remedy, peculiar to the Court of Chancery. The jurisdiction rests upon the ground of injury to property, actual or prospective: *per* Turner, L.J., in *Att.-Gen.* v. *Sheffield Gas Consumers' Co.*, C. A. 1853, 4 De G. M. and G. 320; 22 L. J. Ch. 811; 17 Jur. N. S. 677; *Emperor of Austria* v. *Day*, C. A. 1861, 3 De G. F. and J. 253; 30 L. J. Ch. 690; 7 Jur. N. S. 639; 4 L. T. N. S. 494; 9 W. R. 712; and see Kerr on Injunctions, p. 1.

There is no jurisdiction to prevent by injunction the commission of illegal or criminal acts, unless they affect rights of property: *Gee* v. *Pritchard*, Eldon, L.C., 1818, 2 Swans. 413; *Emperor of Austria* v. *Day*, supra; *Springhead Spinning Co.* v. *Riley*, Malins, V.-C., 1868, L. R. 6 Eq. 551.

But, under certain circumstances, the courts of equity have been accustomed to interfere by injunction to enforce a right which the law acknowledges in principle to be a legal right, but which, owing to infirmity of legal process, the law cannot enforce: *Emperor of Austria* v. *Day*, supra; and see Kerr on Injunctions, p. 3. It was upon this ground that originally the Court of Chancery interfered to protect trade marks. Its interference was only ancillary to the legal right, and, as we have seen (see notes to sect. 1), the jurisdiction of the common law courts was founded upon the fraud of the defendant, which had to be pleaded and proved: *Crawshay* v. *Thompson*, C. P. 1842, 4 Man. & G. 357; 11 L. J. C. P. 301; *Rodgers* v. *Nowill*, C. P. 1847, 5 C. B. 109; 17 L. J. C. P. 52; 11 Jur. 1039; 10 L. T. 88; *Edelsten* v. *Edelsten*, Westbury, C., 1863, 1 De G. J. & S. 185; 9 Jur. N. S. 479; 7 L. T. N. S. 768; and see judgment of Mellish, L.J., in *Singer Manufacturing Co.* v. *Wilson*, C. A. 1876, 2 Ch. D. 453; 55 L. J. Ch. 490; 34 L. T. N. S. 863; 24 W. R. 1026.

Consequently, as a rule, before interfering by injunction, the courts of equity required the plaintiff first to prove his right in an action at law: *Motley* v. *Downman*, Cottenham, L.C., 1837, 3 My. & C. 1; 6 L. J. Ch. N. S. 308; *Hine* v. *Lart*, Shadwell, V.-C.,

SECT. 21. 1846, 10 Jur. 106; 7 L. T. 41; *Rodgers* v. *Nowill*, Wigram, V.-C., 1846, 6 Hare 325; *Perry* v. *Truefitt*, Langdale, M.R., 1842, 6 Beav. 66. And this rule seems only to have been disregarded when the fraud was so obvious as to render an action unnecessary: *Croft* v. *Day*, Langdale, M.R., 1843, 7 Beav. 84; *Franks* v. *Weaver*, Langdale, M.R., 1847, 10 Beav. 297; 8 L. T. 510; *Edelsten* v. *Vick*, Wood, V.-C., 1853, 11 Hare 78; 18 Jur. 7; and the cases above cited.

Consequently it was laid down that there was no exclusive right to a trade mark, but that the plaintiff's right was merely a personal right to be protected against fraud: *Blanchard* v. *Hill*, Hardwicke, L.C., 1742, 2 Atk. 484; *Canham* v. *Jones*, Plumer, V.-C., 1813, 2 V. & B. 218.

The practice of referring to the courts of common law for the trial of the legal right before the remedy by injunction would be granted, was abolished by Rolt's Act (25 & 26 Vict., c. 27); and it came at length to be considered that the jurisdiction of the Court of Chancery to interfere by injunction was based upon a right of property in the trade mark itself: *Millington* v. *Fox*, Cottenham, L.C., 1838, 3 My. & C. 338; *Farina* v. *Silverlock*, Cranworth, L.C., 1858, 6 De G. M. & G. 214; 26 L. J. Ch. 11; 2 Jur. N. S. 1008; 27 L. T. 277; 4 W. R. 731; *Burgess* v. *Hills*, Romilly, M.R., 1858, 26 Beav. 244; 28 L. J. Ch. 356; 5 Jur. N. S. 233; 32 L. T. 328; 7 W. R. 158; *Clement* v. *Maddick*, Stuart, V.-C., 1859, 1 Giff. 98; 5 Jur. N. S. 592; *Edelsten* v. *Edelsten*, Westbury, L.C., 1863, 1 De G. J. & S. 185; 9 Jur. N. S. 479; 7 L. T. N. S. 768; 11 W. R. 328; *Hall* v. *Barrows*, Westbury, L.C., 1863, 4 De G. J. & S. 150; 33 L. J. Ch. 204; 9 L. T. N. S. 561; 12 W. R. 322; *Leather Cloth Co.* v. *American Leather Cloth Co.*, Westbury, L.C., 1863, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 10 Jur. N. S. 81; 9 L. T. N. S. 558; 12 W. R. 289; *Singer Manufacturing Co.* v. *Wilson*, C. A. 1876, 2 Ch. D. 453; 45 L. J. Ch. 490; 34 L. T. N. S. 863; 24 W. R. 1026.

It is, therefore, necessary in a claim for an injunction to restrain the infringement of a trade mark to prove only that the trade mark has been taken: see *per* Jessel, M.R., in *Singer Manufacturing Co.* v. *Wilson*, supra.

"Imposition on the public is indeed necessary for the plaintiff's title; but in this way only, that it is the test of the

invasion by the defendant of the plaintiff's property; for there is no injury done to the plaintiff if the mark used by the defendant be not such as may be mistaken by the public for the mark of the plaintiff:" *per* Westbury, L.C., in *Hall* v. *Barrows*, supra.

In other words, the court has to consider before granting an injunction, first, whether the defendant's mark is a colourable imitation of the plaintiff's mark, and secondly, whether the defendants have been selling goods so marked as to lead purchasers to believe they are the plaintiff's goods: *per* Thesiger, L.J., in *Mitchell* v. *Henry*, C. A. 1880, 15 Ch. D. 181; 43 L. T. N. S. 186.

As to what degree of imitation will constitute infringement, see sect. 5, *ante*, and sect. 72 of the Act of 1883, *post*.

It is not necessary, in order to obtain an injunction, to prove any instance of actual deception or any actual damage, for the very life of a trade mark depends upon the promptitude with which it is vindicated: *Orr-Ewing* v. *Johnston*, H. L. 1882, 7 App. Cas. 219; 51 L. J. Ch. 797; 46 L. T. N. S. 216; *Dent* v. *Turpin*, Wood, V.-C., 1861, 2 J. & H. 139; 30 L. J. Ch. 495; 4 L. T. N. S. 637; *Braham* v. *Beachim*, Fry, J., 1878, 7 Ch. D. 848; 47 L. J. Ch. 348; 38 L. T. N. S. 640; 26 W. R. 654; and see *Blofield* v. *Payne*, K. B. 1833, 4 B. & Ad. 410; 2 L. J. K. B. 68; *Rodgers* v. *Nowill*, C. P. 1847, 5 C. B. 109; 17 L. J. C. P. 52; 11 Jur. 1039; 10 L. T. 38.

An injunction will be granted against an innocent consignee of goods to which a spurious trade mark is affixed: *Upmann* v. *Elkan*, Hatherley, L.C., 1871, L. R. 7 Ch. 130; 41 L. J. Ch. 246; 25 L. T. N. S. 813; 20 W. R. 131; *Moet* v. *Pickering*, C. A. 1878, 8 Ch. D. 372; 47 L. J. Ch. 527; 38 L. T. N. S. 799; 26 W. R. 637; *Upmann* v. *Forester*, Chitty, J., 1883, 24 Ch. D. 231; 52 L. J. Ch. 946; 49 L. T. N. S. 122; 32 W. R. 28.

And, it would seem, the innocent infringer must pay the costs of obtaining the injunction although the plaintiff gives him no notice of the infringement before serving him with the writ in the action: *Upmann* v. *Forester*, supra; and see *Wittman* v. *Oppenheim*, Pearson, J., 1884, 27 Ch. D. 260.

For where an action is brought to enforce a legal right and there is no misconduct on the part of the plaintiff, the court has

SECT. 21. no discretion to refuse him costs: *Cooper* v. *Whittingham*, Jessel, M.R., 1880, 15 Ch. D. 501; 43 L. T. N. S. 16; 28 W. R. 720.

The power to grant injunctions was given to the common law courts in certain cases by the Common Law Procedure Act, 1854, sects. 79–82, as amended by the Common Law Procedure Act, 1860, sects. 32 and 33; and in the Patent Law Amendment Act, 1852, sect. 42, there is an analogous provision to that contained in this section.

Now, by the Judicature Act, 1873, all the jurisdiction of the Court of Chancery has been transferred to the High Court of Justice, and by sect. 25 (8) it is provided that an injunction may be granted by an interlocutory order in all cases where it shall appear to the court just and convenient to make the order.

The jurisdiction of granting injunctions thus vested in the High Court is practically unlimited, and can be exercised by any judge of the High Court in any case in which it is just and right to do so, having regard to settled legal reasons or principles: *Beddow* v. *Beddow*, Jessel, M.R., 1878, 9 Ch. D. 89; 47 L. J. Ch. 588; 26 W. R. 570; *Hedley* v. *Bates*, Jessel, M.R., 1880, 13 Ch. D. 498; 49 L. J. Ch. 170; 42 L. T. N. S. 41; 28 W. R. 365; *Anglo-Italian Bank* v. *Davies*, C. A. 1878, 9 Ch. D. 275; *Thomas* v. *Williams*, Fry, J., 1880, 14 Ch. D. 864; 49 L. J. Ch. 605; 43 L. T. N. S. 91; 28 W. R. 983.

The principles, however, upon which injunctions were formerly granted have not been altered; *Day* v. *Brownrigg*, C. A. 1878, 10 Ch. D. 294; 48 L. J. Ch. 173; 39 L. T. N. S. 533; 27 W. R. 217; *Gaskin* v. *Balls*, C. A. 1879, 13 Ch. D. 324; 28 W. R. 552. And an injunction will only be granted when it is "just" as well as "convenient" to grant it: *Beddow* v. *Beddow*, and *Day* v. *Brownrigg*, supra; *Read* v. *Richardson*, C. A. 1881, 45 L. T. N. S. 54.

The provision in the Judicature Act may be regarded as a supplement to all Acts of Parliament, and therefore where a statute prohibits an act under a penalty the remedy by injunction still remains: *Cooper* v. *Whittingham*, Jessel, M.R., 1880, 15 Ch. D. 501; 43 L. T. N. S. 16; 28 W. R. 720.

It must be borne in mind that in the case of trade marks registrable under the Act of 1883, registration thereunder, and in the case of any other mark in use before 1875, refusal of regis-

tration, is made a condition precedent to a proceeding to prevent infringement. See Act of 1883, sect. 77. SECT. 22.

Costs.—Under the old practice a successful plaintiff in an action for a special injunction to restrain infringement, when to procure the injunction was the principal relief sought, was entitled to costs on the higher scale; but now, under Order lxv., R. 9, of the Rules of the Supreme Court, 1883, it is left to the discretion of the court to direct a taxation on the higher scale when special grounds are shown. The fact that the defendant submits unconditionally to a perpetual injunction with costs is not a special ground; for, if it were, the court would be inflicting a punishment on him for submitting at once: *Hudson* v. *Osgerby*, Pearson, J., 1884, W. N. p. 83.

Persons aggrieved by forgeries may recover damages against the guilty parties.

22. In every case in which any person shall do or cause to be done any of the wrongful acts following; (that is to say) shall forge or counterfeit any trade mark; or for the purpose of sale, or for the purpose of any manufacture or trade, shall apply any forged or counterfeit trade mark to any chattel or article, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or thing in or with which any chattel or article shall be intended to be sold or shall be sold or uttered or exposed for sale, or for any purpose of trade or manufacture; or shall enclose or place any chattel or article in, upon, under, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing to which any trade mark shall have been fasely applied, or to which any forged or counterfeit trade mark shall have been applied; or shall apply or attach to any chattel or article any case, cover, reel, wrapper, band, ticket, label, or other thing to which any trade mark shall have been falsely

SECT. 22. applied, or to which any forged or counterfeit trade mark shall have been applied; or shall enclose, place, or attach any chattel or article in, upon, under, with or to any cask, bottle, stopper, vessel, case, cover, reel, wrapper, band, ticket, label, or other thing having thereon any trade mark of any other person; every person aggrieved by any such wrongful act shall be entitled to maintain an action or suit for damages in respect thereof against the person who shall be guilty of having done such act or causing or procuring the same to be done, and for preventing the repetition or continuance of the wrongful act, and the committal of any similar act.

As to the meaning of "trade mark" and "person," see sect. 1. And as to what amount of imitation constitutes forgery, see sect. 5.

The "wrongful acts" are fully defined in sects. 2 and 3; and persons aiding and abetting their commission are as guilty as the principals: see sect. 13.

Action for Damages.—The oldest remedy for the infringement of a trade mark was, as has been previously noticed (see notes to sects. 1 and 21), by an action on the case in the nature of a writ of deceit: *per* Westbury, L.C., in *Edelsten* v. *Edelsten*, 1863, 1 De G. J. & S. 185; 9 Jur. N. S. 479; 7 L. T. N. S. 768; 11 W. R. 328; and in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1863, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 10 Jur. N. S. 81; 9 L. T. N. S. 558; 12 W. R. 289; and *per* Mellish, L.J., in *Singer Manufacturing Co.* v. *Wilson*, C. A. 1876, 2 Ch. D. 448; 45 L. J. Ch. 490; 34 L. T. N. S. 863; 24 W. R. 1026.

To support such an action it was necessary to prove an intention to deceive, and consequently the questions for the jury were: (1.) Whether the defendant's mark bore such a close resemblance to the plaintiff's mark as to be calculated to deceive ordinary persons and to induce them to believe that the defendant's goods were of the plaintiff's manufacture; and (2.) Whether the defendant used

the mark with intent to deceive purchasers and to supplant the plaintiff: *Crawshay* v. *Thompson*, C. P. 1842, 4 Man. & G. 357; 5 Scott N. R. 562; 11 L. J. C. P. 301; *Rodgers* v. *Nowill*, C. P. 1847, 5 C. B. 109; 17 L. J. C. P. 52; 11 Jur. 1039; 10 L. T. 88; *Sykes* v. *Sykes*, K. B. 1824; 3 B. & Cr., 541; 5 D. & R. 292; 3 L. J. K. B. 46.

In equity, however, proof of knowledge and fraudulent intention on the part of the defendant was not in later times required; see notes to sects. 1 and 21. And by virtue of the Judicature Act, 1873, sect. 25 (11) the same rule will now prevail in an action at common law.

In any proceeding, therefore, for the recovery of damages for the infringement of a trade mark, the only questions to be considered are (1.) Whether the defendant's mark is a colourable imitation of the plaintiff's mark, and (2.) Whether the defendants have been selling goods so marked as to lead purchasers to believe they are the plaintiff's goods: *per* Thesiger, L.J., in *Mitchell* v. *Henry*, C. A. 1880, 15 Ch. D. 181; 43 L. T. N. S. 186; see also *per* Jessel, M.R., in *Singer Manufacturing Co.* v. *Wilson*, 1875, 2 Ch. D. 434; 45 L. J. Ch. 490; 34 L. T. N. S. 858; 24 W. R. 1023.

As to what amounts to colourable imitation, see notes to sect. 5 of this Act, and sect. 72 of Act of 1883.

By sect. 77 of the Act of 1883 registration under that Act in the case of trade marks so registrable, and a refusal to register in the case of any other trade marks used before 1875, is made a condition precedent to any proceeding to recover damages for infringement.

Measure of Damages.—Even where no special damage can be shown, nominal damages for the invasion of the exclusive right will be given: *Rodgers* v. *Nowill*, C. P. 1847, 5 C. B. 109; 17 L. J. C. P. 52; 11 Jur. 1039; 10 L. T. 88; *Blofield* v. *Payne*, K. B. 1833, 4 B. & Ad. 410; 2 L. J. K. B. 68; see *Orr-Ewing* v. *Johnston*, H. L. 1882, 7 App. Cas. 219; 51 L. J. Ch. 797; 46 L. T. N. S. 216; and *Braham* v. *Beachim*, Fry, J., 1878, 7 Ch. D. 848; 47 L. J. Ch. 348; 38 L. T. N. S. 640; 26 W. R. 654.

And this is the case when the goods sold under the deceptive trade mark are not inferior to the goods to which the genuine mark is affixed; *Blofield* v. *Payne*, supra.

SECT. 23.

Special damage will include loss of custom or profit, by reason of the unlawful use by the defendant of the plaintiff's trade mark; but on an inquiry as to damages the onus lies on the plaintiff to prove such special damage, and it will not be assumed in the absence of evidence that the amount of goods sold by the defendant under the fraudulent mark would have been sold by the plaintiff but for the defendant's invasion of his right; *Leather Cloth Co.* v. *Hirschfeld*, Wood, V.-C., 1865, L. R. 1 Eq. 299; 13 L. T. N. S. 427; 14 W. R. 78.

Where the plaintiff on the defendant's order manufactured goods and marked them with the trade mark of another maker, and on a bill in Chancery being filed against him by the latter for an account, compromised the proceedings at great expense, it was held that he could maintain an action against the defendant for damages amounting to the sum he had paid under the compromise; *Dixon* v. *Fawcus*, Q. B. 1861, 3 Ell. & Ell. 537; 30 L. J. Q. B. 137; 7 Jur. N. S. 895; 3 L. T. N. S. 693; 9 W. R. 414.

Defendant obtaining a verdict to have full indemnity for costs.

23. In every action which any person shall, under the provisions of this Act, commence as plaintiff for or on behalf of her Majesty for recovering any penalty or sum of money, if the defendant shall obtain judgment, he shall be entitled to recover his costs of suit, which shall include a full indemnity for all the costs, charges, and expenses by him expended or incurred in, about, or for the purposes of the action, unless the court or a judge thereof shall direct that costs of the ordinary amount only shall be allowed.

As to the recovery of penalties by action, see sect. 15. On the plaintiff obtaining judgment, he will be entitled to his costs: sect. 17.

As to the effect of Order lxv., Rule 1, of the Rules of the Supreme Court, 1883, upon enactments similar to the above, see *per* Lord Blackburn in *Garnett* v. *Bradley*, H. L. 1878, 3 App. Cas. at p. 970; and see note to sect. 17, *ante*.

SECT. 24.

A plaintiff suing for a penalty may be compelled to give security for costs.

24. In any action which any person shall, under the provisions of this Act, commence as plaintiff for or on behalf of her Majesty for recovering any penalty or sum of money, if it shall be shown to the satisfaction of the court, or a judge thereof, that the person suing as plaintiff for or on behalf of her Majesty has no ground for alleging that he has been aggrieved by the committing of the alleged offence in respect of which the penalty or sum of money is alleged to have become payable, and also that the person so suing as plaintiff is not resident within the jurisdiction of the court, or not a person of sufficient property to be able to pay any costs which the defendant may recover in the action, the court or judge shall or may order that the plaintiff shall give security by the bond or recognisance of himself and a surety, or by the deposit of a sum of money, or otherwise, as the court or judge shall think fit, for the payment to the defendant of any costs which he may be entitled to recover in the action.

The plaintiff suing for penalties, if he obtain judgment, will be entitled to his costs: sect. 17.

As to the recovery of penalties by action, see sect. 15.

As to the meaning of "person," see sect. 1.

By Order lxv., Rule 6, of the Rules of the Supreme Court, 1883, it is provided that "in any cause or matter in which security for costs is required, the security shall be of such amount and shall be given at such times and in such manner and form, as the court or judge shall direct."

It has been held that a foreigner usually resident abroad, who is temporarily residing in England for the purpose of bringing an action, cannot be compelled to find security: *Redondo* v. *Chaytor*,

SECT. 25.

C. A. 1879, 4 Q. B. D. 453; 48 L. J. Q. B. 697; 40 L. T. N. S. 797; 27 W. R. 701; and *Ebrard* v. *Gassier*, C. A. 1884, 28 Ch. D. 232.

But if a plaintiff goes to reside out of the jurisdiction after action brought, security for costs will be ordered: see *Massey* v. *Allen*, infra; *Edwards* v. *Burke*, Kindersley, V.-C., 1863, 9 L. T. N. S. 406.

Where an Englishman and a foreigner join as plaintiffs in an action alleging a right to exist in both, or in the alternative in either of them severally, the two together are to be considered as the plaintiffs, and the foreigner will not be ordered to find security: *D'Hormusgee* v. *Grey*, Q. B. 1882, 10 Q. B. D. 13; for even if the English plaintiff alone is successful and the foreigner unsuccessful, the successful plaintiff will have to pay the costs of joining improperly the foreigner as co-plaintiff: *Umfreville* v. *Johnson*, C. A. 1875, L. R. 10 Ch. 580.

If security is not given in pursuance of the order the action will be dismissed for want of prosecution: *Lagrange* v. *M'Andrew*, Q. B. 1879, 4 Q. B. D. 210.

The application for security may be made at any time, the old Rule of the Court of Chancery, that it should be made promptly, having been abrogated by the above provision in the Rules of the Supreme Court: *Lydney Iron Co.* v. *Bird*, Pearson, J., 1883, 23 Ch. D. 358.

Security for past, as well as for future costs, may be ordered, but in this case the application should be made within a reasonable time after the costs have been incurred: *Massey* v. *Allen*, Hall, V.-C., 1879, 12 Ch. D. 807; 48 L. J. Ch. 692; 41 L. T. N. S. 788; 28 W. R. 243; *Brocklebank* v. *King's Lynn Steamship Co.*, C. P. 1878, 3 C. P. D. 365; 47 L. J. C. P. 321; 38 L. T. N. S. 489; 27 W. R. 94.

Act not to affect the Corporation of Cutlers of Hallamshire, nor to repeal 59 Geo. III., c. 7.

25. Nothing in this Act contained shall be construed to affect the rights and privileges of the Corporation of Cutlers of the Liberty of *Hallamshire* in the county of *York*, nor shall anything in this Act contained be construed in any way to repeal or make void any of

the provisions contained in the fifty-ninth *George* third, chapter seven, intituled *An Act to regulate the Cutlery Trade in* England. SECT. 26.

See, as to the registration of cutlery marks, sect. 81 of the Act of 1883.

26. The expression "The Merchandise Marks Act, 1862," shall be a sufficient description of this Act. Short title.

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

46 & 47 VICT., c. 57.

An Act to Amend and Consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks. [25th *August* 1883.]

BE it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

PART I.

PRELIMINARY.

SECT. 1.
Short title.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.

2. This Act is divided into parts, as follows :— SECTS. 2, 3, 62.

Division of Act into parts.

Part I.—PRELIMINARY.
Part II.—PATENTS.
Part III.—DESIGNS.
Part IV.—TRADE MARKS.
Part V.—GENERAL.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three. Commencement of Act.

PART IV.

TRADE MARKS.

Registration of Trade Marks.

62. (1.) The Comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark. Application for registration.

(2.) The application must be made in the form set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(3.) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes

SECT. 62. of goods in connection with which the applicant desires the trade mark to be registered.

(4.) The Comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the court; and in that event the court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

(1.)

The Comptroller is the Comptroller-General of Patents, Designs, and Trade Marks: sect. 117; as to his position, see sect. 82.

Mode of Application: see Rules 7–13, and Instructions 1–3 and 8–17. The application may, if made by a firm, be signed by one or more members of the firm, and if made by a body corporate, it may be signed by the secretary or other principal officer: Rule 7, Form F, and Instruction 11. In any case the application may be made by an agent duly authorised to the satisfaction of the Comptroller: Rule 8, Form F, and Instruction 12. As to purchase of Forms, see Instructions 2 and 3. The fee payable upon application is 5s.: First Schedule to Rules.

Cutlery.—Applications for the registration of trade marks used on cutlery, edge-tools, or on raw steel, or on goods made of steel, or of steel and iron combined, if made by a person carrying on business in Hallamshire, or within six miles thereof, are to be made to the Cutlers' Company: sect. 81 (3), Rules 53–56, and Instruction 37; the mark is to be registered in the Sheffield Registry, and the registration thereof is to be notified to the

Comptroller, who is also to enter the mark in the Register of Trade Marks: sect. 81 (6). As to the Register of Trade Marks, see sect. 78. SECT. 62.

Person includes a body corporate: sect. 117, and see Rule 7. By Rule 5 of the Rules under the Act of 1875, it was expressly provided that an alien as well as a British subject could make application for the registration of a trade mark, but not, apparently, if he were not using it in his business in Great Britain: see *In re Riviere's Trade Mark*, C. A. 1884, 26 Ch. D. 48; 53 L. J. Ch. 578; 32 W. R. 390; and *In re Leonard and Ellis' Trade Mark*, C. A. 1884, 26 Ch. D. 288; 53 L. J. Ch. 603; 32 W. R. 532. As to the practice before 1875, see Merchandise Marks Act, 1862, sect. 1, and the cases cited in the notes thereto.

The term "person" in this section also seems to be intended to include an alien: see sect. 103 (3). Provided he is using the mark as a trade mark in Great Britain (see *In re Leonard and Ellis' Trade Mark*, supra), he would be "a person claiming to be a proprietor" thereof within the meaning of the cases cited in the notes to sect. 1 of the Merchandise Marks Act, 1862 (and see notes *infra*), and would consequently be entitled to apply for registration under this section. If, however, there has been no user of the trade mark in Great Britain, the foreign owner can have acquired no right to it by common repute—cannot be said to claim property in it—and consequently he cannot apply for registration unless he is entitled to do so under sect. 103. If he be the member of a foreign state to which that section has been declared by Order in Council to be applicable, and if he has applied for registration in the "country of origin," he may obtain registration under this Act: sect. 103 (3). If, further, he is a member of a foreign state with which her Majesty has made an arrangement for mutual protection of trade marks, and to which sect. 103 has been declared by Order in Council to be applicable, he will be entitled to registration under this Act in priority to other applicants: sect. 103 (1).

There seems to be no provision for the case of a member of a foreign state where there is no protection of trade marks, if he has not used his trade mark in this country; but it is presumed that, if there are any such states, sect. 103 will not be declared applicable to them.

SECT. 62.

Claiming to be the Proprietor.—By sect. 77, registration of a trade mark, capable of being registered under this Act or the Act of 1875, or refusal by the Comptroller to register any other trade mark in use before 13th August 1875, is made a condition precedent to proceedings to prevent or to recover damages for infringement. Registration, or the certificate of refusal, as the case may be, may be obtained at any time before action brought; and in the meantime property in the trade mark remains unaffected. The only way in which such property can be acquired is by legal user in this country, whereby proprietorship is acquired by common repute (see Merchandise Marks Act, sect. 1, and notes thereto), or registration under the Act of 1875 or this Act, which is equivalent to public user: see sect. 75. A person therefore who claims to be a proprietor and who is yet unregistered, must be one who has acquired a property by user in this country, or else one who, having invented a new trade mark, seeks to acquire property in it by registration, which is equivalent to such user. As to the effect of registration, see sects. 75–77.

Trade Mark.—As to what is a trade mark generally, and as to acquisition thereof, see notes to Merchandise Marks Act, 1862, sect. 1. As to what is a trade mark capable of registration under this Act, see sect. 64, *post.*

Registration.—If an applicant dies after the date of the application and before the trade mark applied for has been entered on the register, the trade mark may be entered for the successor to the goodwill of his business: Rule 31.

As to mode of registration, see Rules 30–33.

As to the restrictions placed on the Comptroller's authority, see sects. 72, 73, and 86, and Instructions 29–32.

(2.)

The form set forth in the first schedule to the Act has been replaced by Form F in the second schedule to the Rules: see Rules 4 and 5.

Clerical errors in or in connection with the application for a trade mark may be corrected by the Comptroller: see sect. 91, and Form Q in second schedule to Rules.

As to mode of application, see Rules 7–16.

"Prescribed" means prescribed by any of the schedules to the Act, or by general rules made under the Act: see sect. 117. SECT. 62.

As to the Patent Office, see sect. 82.

(3.)

As to representations of trade marks, see Rules 13 and 14, and Forms F and G, and Instructions 13, 16, and 17.

Application may be made for registration of any goods in a class upon one form; but for each separate class a separate form is necessary: Form F, and Instruction 10.

As to the classification of goods, see sect. 65 and Rule 6 and the third schedule there referred to, and Instruction 20.

(4.)

Discretionary Powers.—Before exercising adversely to the applicant a discretionary power like that here conferred, the Comptroller is bound to afford him an opportunity of being heard personally or by an agent, and to give him ten days' notice of an appointment for the purpose: sect. 94, and Rules 17–19.

It was provided by sect. 5 of the Act of 1875 that if the registrar refused to enter on the register, as proprietor of a trade mark, the name of any person who was for the time being entitled to the exclusive use of such trade mark in accordance with the above Act or otherwise in accordance with law, the person aggrieved might apply for an order of the court to rectify the register, and the court might either refuse the application, or, if satisfied of the justice of the case, make an order for the rectification of the register.

With regard to this discretionary power it was held that when the court was satisfied that the applicant was a person who was for the time being entitled to the exclusive use of a trade mark in accordance with law, and that the trade mark was one within the definition contained in the Act, the court was bound *ex debito justitiæ* to rectify the register, just as it would before the Act have been bound *ex debito justitiæ* on similar proof to prevent any one infringing the trade mark shown to be his property. The burden of proof lay upon the person making application to amend the register, but if he produced such proof as would in the

SECT. 62. opinion of the court entitle him to an injunction, the words "if satisfied of the justice of the case" did not give the court a discretion to consider whether the nature of the trade mark was such as to make it inconvenient that he should exercise the right of property which he was proved actually to have: *per* Lord Blackburn in *Orr-Ewing* v. *Registrar of Trade Marks*, H. L. 1879, 4 App. Cas. 479; 48 L. J. Ch. 707; 41 L. T. N. S. 239; 28 W. R. 17.

The words "if satisfied of the justice of the case" are not present in the corresponding section of this Act, sect. 90, nor in other sections of the Act where discretionary powers are conferred. The rule above referred to as to discretionary powers will therefore doubtlessly continue in force.

Restrictions on Registration.—The Comptroller is absolutely prohibited from registering trade marks which come within sects. 72, 73, and 86: see also Instructions 29–32.

Old Procedure.—Under the Act of 1875 four cases of application to the court seem to have been contemplated:

(i.) An appeal by an applicant for registration from the mere refusal of the application by the registrar, where there was no extraneous opposition.

(ii.) An application to rectify the register by altering or expunging an entry, made either by the person registered or by extraneous parties, being aggrieved.

(iii.) An application by the owner of a trade mark opposing the registration of a mark so similar to his own as to be calculated to deceive

(iv.) Conflicting claims to the same trade mark, which more parties than one claimed to register.

The first two classes of cases were dealt with by Rule 43 under the Act of 1875, whereby the procedure authorised was "by motion or by application in chambers or in such other manner as the court may direct." An application by motion was the most common; thus in class i., *Ex parte Stephens*, Jessel, M.R., 1876, 24 W. R. 819 (where a motion was expressly directed as the proper procedure); 3 Ch. D. 659; 46 L. J. Ch. 46; 24 W. R. 963; *In re Barrows' Trade Mark*, 1877, Malins, V.-C., 5 Ch. D. 353; 46 L. J. Ch. 450; 36 L. T. N. S. 291; 25 W. R. 407; and C. A. 5 Ch. D. 364; 46 L. J. Ch. 725; 36 L. T. N. S. 780; 25 W. R. 564; *In*

re Walkden Aerated Water Co., Jessel, M.R., 1877, 54 L. J. Ch. 394; *In re Mitchell's Trade Mark*, Hall, V.-C., 1877, 7 Ch. D. 36; 46 L. J. Ch. 876; 26 W. R. 326; *In re Orr-Ewing's Trade Mark*, Hall, V.-C., 1877, 8 Ch. D. 794; 47 L. J. Ch. 180; 38 L. T. N. S. 313; 26 W. R. 259; and C. A. 1878, 8 Ch. D. 794; 47 L. J. Ch. 807; 38 L. T. N. S. 695; 26 W. R. 777; *In re Brook's Trade Mark*, Hall, V.-C., 1878, 26 W. R. 791; *In re Hargreaves' Trade Mark*, Hall, V.-C., 1879, 11 Ch. D. 669; 27 W. R. 450; *In re Rotherham's Trade Mark*, Bacon, V.-C., 1879, 11 Ch. D. 250; 49 L. J. Ch. 511; 40 L. T. N. S. 387; 27 W. R. 503. And in the following only has the application been made by summons: *In re Meikle's Trade Mark*, Hall, V.-C., 1876, 24 W. R. 1067; *In re Brandreth's Trade Mark*, Jessel, M.R., 1878, 9 Ch. D. 618; 47 L. J. Ch. 816; 27 W. R. 281.

In class ii. all the reported applications seem to have been by motion, either (1.) by the registered owner, *Ex parte Sales, Pollard & Co.*, Jessel, M.R., 1878, Seb. Dig. No. 620; *In re Lysaght*, Jessel, M.R., 1878, Seb. Dig. No. 623; *Ex parte Walker & Co.*, Malins, V.-C., 1878, Seb. Dig. No. 624; or (2.) by persons aggrieved by the mark being on the register, *In re Hyde & Co.'s Trade Mark*, Jessel, M.R., 1878, 7 Ch. D. 724; 54 L. J. Ch. 395; 38 L. T. N. S. 777; 26 W. R. 625; *In re Mitchell's Trade Mark*, Jessel, M.R., W. N. 1878, p. 101; *Ex parte Lawrence & Co.*, Jessel, M.R., 1878, 44 L. T. N. S. 98; 29 W. R. 392; *In re Kuhn & Co.*, Jessel, M.R., 1878, 53 L. J. Ch. 238; *In re Riviere's Trade Mark*, C. A. 1884, 26 Ch. D. 48; 53 L. J. Ch. 578; 50 L. T. N. S. 763; 32 W. R. 390; *In re Wragg's Trade Mark*, Pearson, J., 1885, 54 L. J. Ch. 391.

The above, however, was the only case in which persons, other than applicants for registration, could rightly proceed under Rule 43. In all other cases, *i.e.*, in the cases coming within classes iii. and iv. above, "the Act and Rules do not give the opponent any power to take the initiative by restraining the registration; if he wants to get an injunction, he must commence an action in the usual way. The application to the court, which is referred to in Rule 44 (*quære*, this should be 43), is clearly an application by the persons seeking to register. The rule (*i.e.*, Rule 44) points out a special case as the mode in which such cases as the present are to be tried; but the parties never in practice agree to the facts,

SECT. 62. and the registrar is not a lawyer, so as to be able to decide between the rival representations of the parties. The usual and proper course is for the registrar to require the opponent to apply for a direction as to the mode of trial, upon which my usual practice is to direct the applicant who desires to be registered to take out a summons which is invariably adjourned into court. In one or two cases I have, I believe, directed a motion, but the usual course is to direct a summons: " *per* Jessel, M.R., *In re Simpson, Davies & Sons' Trade Mark*, 1880, 5 Ch. D. 525; 42 L. T. N. S. 675; 28 W. R. 760.

Prior to this decision, however, we find the following cases coming within class iii., where a trade mark owner, opposing the registration of a mark so similar to his own as to be calculated to deceive, proceeded, without any summons for directions, under Rule 43, (1.) by motion, *Ex parte Barrows*, Jessel, M.R., 1877, W.N. 119; *In re Farina's Trade Mark*, Hall, V.-C., 1878, 26 W. R. 261; *In re Sannion & Co.*, Jessel, M.R., 1878, Seb. Dig. No. 625; *In re Farina's Trade Mark*, Hall, V.-C., 1879, 27 W. R. 456; *In re Worthington's Trade Mark*, Jessel, M.R., 1879, and C.A., 1880, 14 Ch. D. 8; 49 L. J. Ch. 646; 42 L. T. N. S. 563; 28 W. R. 747; and (2.) by summons in chambers (in the following cases it does not appear by whom the summons was taken out, but no mention is made of any direction by the court); *In re Jelley, Son, & Jones' Application*, Jessel, M.R., 1878, 51 L. J. Ch. 639; 46 L. T. N. S. 381; *In re Whiteley*, Jessel, M.R., 1879, 43 L. T. N. S. 627; 29 W. R. 235.

In the following cases in class iii., *i.e.*, of opposition by a trade mark owner, directions were sought on *ex parte* motions, not by summons, and it was directed that the case should be heard, (1.) on motion, *Ex parte the King of Saxony*, Hall, V.-C., 1878, Seb. Dig. No. 598; and (2.) on a summons taken out by the opponents (not by the applicants, as in *Re Simpson, Davies & Son's Trade Mark*), *In re Paton*, Jessel, M.R., 1878, Seb. Dig. No. 601.

There seems to be but one reported case of opposition by a trade mark owner to the registration of a trade mark so similar to his own as to be calculated to deceive, which was tried on a special case: *Allsop* v. *Walker*, Jessel, M.R., 1877, Seb. Dig. No. 545. There is also one case within class iv., *i.e.*, of conflicting

claims to registration of the same trade mark where a special case was directed: *Ex parte Grimshaw*, Hall, V.-C., 1877, W. N. 24. SECT. 62.

In other cases within class iv., cross summonses by both claimants have been directed: *In re Powell*, Jessel, M.R., 1878, Seb. Dig. No. 589; *In re Rabone Bros. & Co.*, Jessel, M.R., 1879, Seb. Dig. No. 643; and in one case an action was directed, the question being one of title to the marks: *In re Salamon*, Jessel, M.R., 1877, Seb. Deg., 569, where it was said, "I always direct that these cases should be mentioned to the court, that I may decide the proper way in which they are to come before the court; the way depends on the circumstances of each case. If it be a simple question of law, it had better be by special case; if for directions for carrying out the Act, by summons in chambers; if of disputed facts, by motion."

New Procedure.—Cases of class i., *i.e.*, of refusal by the Comptroller of his own motion to register a trade mark, are dealt with by the above sect. 62. The appeal at any rate in the first instance should, it seems, be to the Board of Trade. The latter may refer the appeal to the court, if it appears expedient, and in the absence of express provision, this may possibly be effected by directing the applicant to proceed by motion or by summons in chambers under sect. 90, in analogy to the procedure under Rule 43 of the Rules under the Act of 1875: see the cases cited above. If, however, the Board hears the appeal and comes to a decision against the applicant, and yet refuses to refer the matter to the court, the remedy of the applicant is not very clear. If the words "omission without sufficient cause of the name of any person" in sect. 90 be taken to include the refusal by the Comptroller to register a trade mark (which from the context of that section, and from the fact that the Board's express power to refer an appeal would then be nugatory, is by no means apparent), then the applicant may proceed by motion or summons; but if the contrary view of the meaning of the words quoted above is adopted, then the appeal to the Board would appear to be final in the event of the Board refusing to refer it to the court.

If the words "omission without sufficient cause of the name of any person" be held to include the mere refusal to register a trade mark, a further question may arise whether an applicant cannot

SECT. 62. proceed under sect. 90 at once without a previous appeal to the Board.

As to proceedings on appeal to Board, see Rules 20–24.

For form of appeal, see Form H.

Cases of class ii., *i.e.*, of application for the alteration or removal of an entry on the register, are dealt with in sects. 90 and 92, and the application to the court will presumably be by summons, or more usually by motion as heretofore: see cases cited above.

Cases of class iii., *i.e.*, of opposition by a trade mark owner to an application for the registration of a mark so similar to his own as to be calculated to deceive, are provided for by sect. 69 and Rule 29. It will be noticed that the summons by the opponent for directions is abolished, and the procedure will now be for the applicant for registration to take out a summons in chambers. This is substantially the course recommended in *Re Simpson, Davies & Son's Trade Mark*, supra.

Cases of class iv., *i.e.*, of conflicting claims for registration of the same trade mark, are treated in sect. 71 and Rule 42, where it is provided that the procedure shall be by special case unless the court otherwise order. This is possibly the most convenient mode: *Ex parte Grimshaw*, supra, but see *In re Salamon* and *In re Simpson, Davies & Son's Trade Mark*, supra.

There are no express provisions in the Act as to costs of proceedings before the Comptroller or the Board.

Under the Act of 1875 it was held that the costs of an appeal from the refusal of the Comptroller to register a trade mark had to be paid by the applicant although the appeal was successful: *In re Rotherham's Trade Mark*, C. A. 1880, 14 Ch. D. 585; 49 L. J. Ch. 513; 43 L. T. N. S. 1; *In re Maignen's Application*, Jessel, M.R., 1880, 28 W. R. 759.

The stamp on the form of appeal to the Board is £1: see first schedule to the Rules.

In an appeal from the Comptroller's refusal to register under this section, the only order which it is competent for the Board or the court to make, is apparently that the application be proceeded with in the ordinary course, subject to such conditions, if any, as may be prescribed; neither the Board nor the court is authorised to dispense with the usual formalities prescribed by statute and to order immediate registration: *In re Meikle's Trade*

Mark, Hall, V.-C., 1876, 24 W. R. 1067; *Orr-Ewing* v. *Registrar of Trade Marks*, Hall, V.-C., 1878, 8 Ch. D. 798; 47 L. J. Ch. 180; 38 L. T. N. S. 313; 26 W. R. 259; and H. L. 1879, 4 App. Cas. 479; 48 L. J. Ch. 707; 41 L. T. N. S. 239; 28 W. R. 17; *Ex parte Lawrence Bros.*, Jessel, M.R., 1878, 44 L. T. N. S. 98; 29 W. R. 392; and see notes to sect. 68.

Conditions.—Where application is made for the registration of a trade mark which is somewhat similar to one already on the register, and which would be liable to deceive if used in a similar way on similar goods, or in the same place, it may yet be registered subject to an undertaking being entered on the register restricting its use.

Illustrative cases.—(1.) Restriction as to mode of user:—

(i.) It appeared that "it is the custom with the bleaching trade to stamp the bleacher's mark in blue colour inside the first fold of each parcel of calico, which is then stitched up, the trade mark of the merchant or manufacturer being stamped upon the outside of the parcel. The bleacher's mark is looked for, not by the public, but by skilled wholesale buyers, who recognise in the mark a guarantee that the calico has been bleached by a particular house, and that the length of calico contained in the parcel has been measured by them. Thus these marks differ from ordinary trade marks, and convey a meaning only to skilled persons, who can readily distinguish between marks closely resembling one another." Registration was therefore granted of a mark resembling others on the register, subject to an undertaking to use it only in the way described above: *In re Sykes & Co.'s Trade Mark*, Hall, V.-C., 1880, 43 L. T. N. S. 626; 29 W. R. 235.

(ii.) A trade mark, which was not stamped upon the goods, but upon adhesive labels and metal labels soldered or otherwise fixed on the goods, or was printed upon the packages or coverings in which the goods were sold, was opposed by a manufacturer who had long impressed a similar mark on cutlery. It was, however, allowed to be registered upon an undertaking being given not to impress it upon metal goods: *In re Whiteley's Trade Mark*, Jessel, M.R., 1879, 43 L. T. N. S. 627; 29 W. R. 235; see also *In re Farina*, Hall, V.-C., 1879, Seb. Dig. 654.

(2.) Restriction as to goods, *i.e.*, in respect of user upon only a

SECT. 62. limited portion of a class: see sect. 65 and Rule 6, and the third schedule there referred to; and see also sect. 72 as to the subdivision of classes.

(i.) An old trade mark was limited to use on galvanised iron only of all the goods contained in class 5: *In re Lysaght*, Jessel, M.R., 1878, Seb. Dig. No. 623.

(ii.) An old trade mark was registered for tin-plates and turn-plates only, a similar mark being used by manufacturers of bar-iron: *Ex parte Barrow*, Jessel, M.R., 1877, W. N. 119.

(iii.) A new mark was limited to fencing wire only in class 5 as not interfering with the trade of the proprietor of a similar mark registered for other goods in that class: *In re Jelley, Son, and Jones' Trade Mark*, Jessel, M.R., 1878, 51 L. J. Ch. 639; 46 L. T. N. S. 381.

(iv.) A new mark was registered in respect of galvanised iron sheets in class 5, although a similar device was on the register in respect of "iron and all kinds of rolled, drawn, and galvanised wire and strand," and also "bar-iron, small rounds and squares, and all kinds of merchant iron": *In re Braby & Co.'s Applications*, North, J., 1882, 21 Ch. D. 223; 51 L. J. Ch. 637; 46 L. T. N. S. 380; 30 W. R. 675. See, however, *In re Hargreaves' Trade Mark*, Hall, V.-C., 1879, 11 Ch. D. 669; 27 W. R. 550.

(3.) Restriction as to locality of user:—

(i.) Two similar trade marks were registered for classes 12 and 13, upon cross undertakings being given and entered on the register,—by the one manufacturer not to use his mark in Europe, and by the other not to use his mark in certain specified colonies: *In re Rabone Bros. & Co.*, Jessel, M.R., 1879, Seb. Dig. No. 643.

(ii.) Where objections were raised by the owner of a registered trade mark to the proposed registration of another trade mark for use in connection with goods included in classes for which the first mark was used, but no formal opposition was lodged to the application in pursuance of an agreement of compromise, the court directed the comptroller, upon an *ex parte* application by the applicant, to enter on the register a note to the effect that the applicant undertook to use his mark only in connection with goods exported to certain specified countries: *In re Keep's Trade Mark*, Pearson, J., 1884, 26 Ch. D. 187; 50 L. T. N. S. 453; 32

W. R. 427. See also *In re Mitchell's and Houghton and Hallmark's Trade Marks*, Chitty, J., 1884, W. N. p. 217; 33 W. R. 148; and 1885, 28 Ch. D. 666; 33 W. R. 408. SECTS. 63, 64.

It is presumable that under Rule 32 the Comptroller, without any application to the court, will henceforth be able to register trade marks subject to restrictions in regard to user, provided he does not transgress the rules contained in sect 72.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, the application shall be deemed to be abandoned. Limit of time for proceeding with application.

This provision is founded on the Rules of 1883 under the Act of 1875.

The Comptroller is bound to register a trade mark as soon as may be after the expiration of two months from the date of the advertisement of the application, if he is satisfied that the applicant is entitled to registration. The registration is, however, subject to the subsequent determination of the court: Rule 30. If there is delay owing to the refusal of the Comptroller to register under sect. 62 or to opposition under sect. 69, it cannot be said to have occurred by reason of the default of the applicant, and there will be no abandonment.

64. (1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars: Conditions of registration of trade mark.

(*a.*) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

(*b.*) A written signature or copy of a written

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signature of the individual or firm applying for registration thereof as a trade mark; or

(*c.*) A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.

(2.) There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words, or figures, or of any of them.

(3.) Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade mark under this part of this Act.

This section is a re-enactment with alterations of sect. 10 of the Act of 1875, and should be read with sects. 72, 73, and 86; and see Instructions 29–32.

Trade marks may be regarded as divided into three classes,—those actually in use before the passing of the Act of 1875, *i.e.*, August 13, 1875, those registered under that Act, and those new trade marks which are sought to be registered under this Act. The first class may, as of course, be registered under this Act, provided the conditions of this section are fulfilled. The second class, having come within the definition contained in sect. 10 of the Act of 1875 and been registered thereunder, is to be deemed duly registered under this Act: see sect. 114 (2.) The third class, *i.e.*, trade marks brought into use since 1875 and not yet registered, must come within the definition contained in sub-sect. 1 if registration is desired; in other words, if the registration is refused or opposed, it will be the duty of the court to ascertain whether some one or more of the essential particulars of a trade mark as defined by the Act is found to exist, so that the mark may be described with one or more than one essential particular or particulars which distinguish it: *per* Cairns, L.C.,

Orr-Ewing v. *Registrar of Trade Marks*, H. L. 1879, 4 App. Cas. 484 ; 48 L. J. Ch. 707 ; 41 L. T. N. S. 239 ; 28 W. R. 17.

An essential particular is that which makes the mark capable of being registered under the Act : see Instruction 7. It is unalterable, whilst the remainder of the mark may be altered under sect. 92.

A mark which contains no essential particular and is therefore not authorised to be registered as a trade mark does not acquire under sect. 76 the character of a trade mark by being on the register for five years, and may be removed from the register though that period has elapsed. *Re Palmer's Trade Mark*, C. A. 1882, 21 Ch. D. 53 ; 51 L. J. Ch. 673 ; 46 L. T. N. S. 787, and C. A. 1883, 24 Ch. D. 504 ; 50 L. T. N. S. 30 ; 32 W. R. 306. See also *Re Leonard and Ellis' Trade Mark*, C. A. 1884 ; 26 Ch. D. 288 ; 53 L. J. Ch. 603 ; 32 W. R. 532 ; *In re Ralph's Trade Mark*, Pearson, J., 1883, 25 Ch. D. 194 ; 53 L. J. Ch. 188 ; 49 L. T. N. S. 504 ; 32 W. R. 168 ; *In re Lloyd's Trade Mark*, Chitty, J., 1884, 27 Ch. D. 646 ; 54 L. J. Ch. 66 ; and *In re Wragg's Trade Mark*, Pearson, J., 1885, 54 L. J. Ch. 391. As to what is a trade mark generally, see the notes to Merchandise Marks Act, 1862, sect. 1 ; and as to the effect of registration under this Act see sects. 75–77, *post*.

It should be noticed that this section does not purport to give an exhaustive definition of a trade mark. It merely enumerates certain attributes which are essential if it is sought to register a trade mark. To complete the definition of a trade mark properly so called it is necessary to remember that it must be affixed to or impressed upon a vendible article actually in the market : see judgment of Jessel, M.R., in *Singer Manufacturing Co.* v. *Wilson*, C. A. 1875, 2 Ch. D. 434 ; 45 L. J. Ch. 490 ; 34 L. T. N. S. 858 ; 24 W. R. 1023 ; and *per* Cairns, L.J., in *Maxwell* v. *Hogg*, C. A. 1867, L. R. 2 Ch. 307 ; 36 L. J. Ch. 433 ; 16 L. T. N. S. 130 ; 15 W. R. 467 ; and *per* Westbury, L.C., in *M'Andrew* v. *Bassett*, 1864, 4 De G. J. & S. 380 ; 33 L. J. Ch. 566 ; 10 Jur. N. S. 550 ; 10 L. T. N. S. 442 ; 12 W. R. 777 ; and see notes to Merchandise Marks Act, 1862, sect. 1.

There is, then, no possibility of registering—

(i.) Such trade marks, properly so called, *i.e.*, affixed to or

SECT. 64. impressed upon a vendible article, as do not fulfil the conditions of this section.

(ii.) Such marks as are not affixed to or impressed on a vendible article, whether they fulfil the conditions in other respects of this section or not; as, for instance, some trade names which have become so appropriated by user as to denote goods of a particular manufacturer though they are not, and never were, impressed on the goods or upon the packages in which they are contained, so as to be trade marks properly so called and within this Act: *per* Lord Blackburn in *Singer Manufacturing Co.* v. *Loog*, H. L. 1882, 8 App. Cas. 33; 52 L. J. Ch. 481; 48 L. T. N. S. 3; 31 W. R. 325; and *per* Lord Cairns in *Singer Manufacturing Co.* v. *Wilson*, H. L. 1877, 3 App. Cas. 389; 47 L. J. Ch. 481; 38 L. T. N. S. 305; 26 W. R. 664.

These, however, although unregistered, will be protected as heretofore (see for practice Merchandise Marks Act, 1862, sects. 1, 21, and 22), for the principles according to which the court acts in preventing a man from passing off his goods as those of another have not been altered by this Act: *Mitchell* v. *Henry*, C. A. 1880, 15 Ch. D. 181; 43 L. T. N. S. 186, and see the cases cited above.

(*a.*) *Name.*—This clause is a *verbatim* reprint from sect. 10 of the Act of 1875.

Prior to the Registration Acts a name affixed to articles for sale was recognised as a trade mark, and a manufacturer or merchant could prevent others using it as a trade mark provided such user would be calculated to deceive purchasers. This would be likely to occur (i.) if a man bearing a different name, but carrying on a similar trade to that of a well-known manufacturer, adopted the latter's name for the purposes of his trade: *Lazenby* v. *White*, C. A. 1871, 41 L. J. Ch. 354; *Ainsworth* v. *Walmsley*, Wood, V.-C., 1866, 1 L. R. Eq. 518; 35 L. J. Ch. 352; 12 Jur. N. S. 205; 14 L. T. N. S. 220; 14 W. R. 363; and (ii.) if a man, who happened to bear the same name and to carry on the same trade as a well-known manufacturer, used his name in such a manner as to be a colourable imitation of the manner adopted by the latter; *Holloway* v. *Holloway*, Romilly, M.R., 1850, 13 Beav. 209; *Burgess* v. *Burgess*, C. A. 1853, 3 De G. M. & G. 896; 22 L. J. Ch. 675; 17 Jur. 292; 21 L. T. 53; *Taylor* v. *Taylor*, Wood, V.-C., 1854, 2 Eq. Rep. 290; 23 L. J. Ch. 255; 22 L. T. 271;

James v. *James*, Romilly, M.R., 1872, 13 L. R. Eq. 421; 41 L. J. Ch. 353; 26 L. T. N. S. 568; 20 W. R. 434. See also *Rodgers* v. *Nowill*, Wigram, V.-C., 1847, 6 Hare 325; and the proceedings in the Common Pleas there referred to.

In regard to names which have ceased to be sufficiently distinctive to be good trade marks, see notes to sub-sect. 3, *infra*.

"Where a person is selling goods under a particular name, and another person not having that name is using it, it may be presumed that he so uses it to represent the goods sold by himself as the goods of the person whose name he uses; but where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that the defendant is selling his goods as the goods of the plaintiff. It is a question of evidence in each case whether there is false representation or not:" *per* Turner, L.J., in *Burgess* v. *Burgess*, supra. In short, the adoption of a name as a trade mark was subject always "to this inconvenience, that if a Mr. Jones or a Mr. Brown relies on his name he will find it a very inadequate security, because there may be several other manufacturers of the same name:" *per* Wood, V.-C., in *Ainsworth* v. *Walmsley*, supra.

The words "printed, impressed, or woven in some particular and distinctive manner" were doubtless inserted with the object of obviating this inconvenience. If the name be distinguished in the prescribed manner, imitation will be easily detected. See *In re Price's Patent Candle Co.*, Pearson, J., 1884, 27 Ch. D. 681.

The name need not necessarily be that of the actual manufacturer, for being a trade mark it is capable of assignment in connection with the goodwill of the business: see sect. 70. But see, as to names which may become deceptive, sect. 73.

Fancy names, however, could not be registered under the Act of 1875: *Ex parte Stephens*, Jessel, M.R., 1876, 3 Ch. D. 659; 46 L. J. Ch. 46; 24 W. R. 963. They may henceforth be registered under clause *c.* of this section.

A name printed in foreign characters will be sufficiently distinctive to be registered; *In re Rotherham's Trade Mark*, C. A. 1880, 14 Ch. D. 585; 49 L. J. Ch. 513; 43 L. T. N. S. 1.

A trade name, as distinguished from a name used as a trade mark, inasmuch as it is not impressed upon goods or upon the

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packages which contain them, is of course not capable of registration, nor is registration a condition precedent to proceedings to protect it. With this exception, however, the principles of law relating to its protection are closely analogous to those in pursuance of which trade marks are protected: *per* Lord Blackburn in *Singer Manufacturing Co.* v. *Loog*, H. L. 1882, 8 App. Cas. 32; 52 L. J. Ch. 481; 48 L. T. N. S. 3; 31 W. R. 325; and *per* Cairns, L. C., in *Singer Manufacturing Co.* v. *Wilson*, H. L. 1877, 3 App. Cas. 389; 47 L. J. Ch. 481; 38 L. T. N. S. 305; 26 W. R. 664.

(*b.*) *Signature.*—This clause also comes from the Act of 1875, sect. 10, but the words "applying for registration thereof" are new. The motive of the addition is not very apparent; for the purchaser of the business of a manufacturer, who had used his signature as a trade mark, although unable to register it under this clause, could yet do so, it would seem, under clause *a*.

Instances of signatures used as trade marks are to be found in *Farina* v. *Silverlock*, Cranworth, C., 1856, 6 De G. M. & G. 214; 26 L. J. Ch. 11; 2 Jur. N. S. 1008; 27 L. T. 277; 4 W. R. 731; *In re Farina*, Hall, V.-C., 1879, 27 W. R. 456; *Massam* v. *Thorley's Cattle Food Co.*, Malins, V.-C., 1877, 6 Ch. D. 574; 46 L. J. Ch. 707; 36 L. T. N. S. 848; *In re Maignen's Application*, Jessel, M.R., 1880, 28 W. R. 759.

(*c.*) The words "brand" and "fancy word or words not in common use" are new.

Under sect. 10 of the Act of 1875, a mere combination of letters (such as "Aeilyton") not used as a trade mark before the passing of the Act, could not be registered: *Ex parte Stephens*, Jessel, M.R., 1876, 3 Ch. D. 659; 46 L. J. Ch. 46; 24 W. R. 963; see *In re Leonard and Ellis' Trade Mark*, C. A. 1884, 26 Ch. D. 288; 53 L. J. Ch. 603; 51 L. T. N. S. 35.

This excluded fancy names, which, however, are now made capable of registration. Various limitations on this clause are contained in sects. 72, 73, and 86, and Instructions 29–32.

As to what is a common mark, see sect. 72, and as to the registration of common marks in combination with trade marks provided the common part is disclaimed, see sect. 74.

It will be noticed that a word will not be registered as a new mark unless it is "a fancy word not in common use," but if

used as a trade mark before August 13, 1875, any word will be registered, provided only it is "special and distinctive:" see sub-sect. 3. SECT. 64.

As to the meaning of distinctive, see notes *infra*, and sect. 72. The registration of a mark consisting of the words "Price's Patent Candle Company" in common letters round the upper border, and "National Sperm" in the centre, and the company's address round the lower border, was refused on the ground that the name of the firm printed in common letters was not distinctive, and that the words "National Sperm" were not "fancy words not in common use:" *In re Price's Patent Candle Co.*, Pearson, J., 1884, 27 Ch. D. 681.

When the name of an inventor has been declared by judicial decision to be a term open to the trade as a proper description of an article made in accordance with his original recipe, the portrait of the inventor is not a sufficiently distinctive device to be capable of registration alone: *In re Anderson's Trade Mark*, Chitty, J., 1884, 26 Ch. D. 409; 53 L. J. Ch. 664; 32 W. R. 677. The words "Zephyr Asiatic Walnut Pipe" are not capable of registration as a new trade mark, not being "fancy words not in common use:" *In re Friedlander's Trade Mark*, Chitty, J., 1885, W. N. p. 85.

Where the words "Strathmore Blend" were registered as a trade mark for whisky, it was held that the word "blend" was not an essential part of the trade mark, being simply a description of an operation of manufacture, and that the use of the name "Strathmore," alone or in combination with a device, by another manufacturer was calculated to deceive: *Blair* v. *Stock*, Kay, J., 1884, 52 L. T. N. S. 123.

(2.)

Figures here mean numerals: *Ex parte Stephens*, supra.

Words.—If the essential particular is in combination with words, or combinations of words which are common to the trade, a disclaimer of the common portion should be entered on the register: see sect. 74, and as the meaning of "common," ibid. sub-sect. 3.

When it is desired to register several trade marks which, while

SECT. 64. resembling each other in the "material" particulars thereof, yet differ in respect of the statement of the goods for which they are used, or statements of numbers, price, quality, or names of places, they should be registered as a series in one registration: see sect. 66.

There is an absolute prohibition in sect. 73 against the registration as part of or in combination with a trade mark of any words, the exclusive use of which would, by reason of their being calculated to deceive, or otherwise, be disentitled to protection in a court of justice: see also sect. 86, and Instruction 30.

Letters may be registered alone as a trade mark if so used before August 1875: sub-sect. 3, *infra;* but in the case of new marks only in combination with an essential particular, as described in sub-sect. 1.

For instances of trade marks composed of devices in conjunction with letters, see notes, *infra.*

(3.)

The 13th August, 1875, was the date of the passing of the Act of 1875.

The sub-section is taken from sect. 10 of the Act of 1875, but is wider in scope, the words "letter, figure," and "of letters and figures" being now added.

As to what constituted a trade mark before the Act of 1875, see Merchandise Marks Act, 1862, sect. 1.

If a trade mark in use before 13th August, 1875, fulfils the conditions of this section it must be registered before an action to prevent or to recover damages for its infringement can be brought: see sect. 77. But non-registration will not affect the owner's title.

If an old trade mark is not capable of registration, as not being within this section, a certificate of the Comptroller's refusal to register must be obtained before action: see sect. 77, Rule 57, Form L, and Instructions 39 and 40.

The certificate is admissible in evidence without further proof: see sect. 96.

The advantage accorded to an application for the registration of an old mark consists in the fact that the court will permit the

registration in respect of the same goods of similar or identical old marks up to the number of three: see sect. 72 as to the three mark rule. SECT. 64.

To obtain the registration of an old mark two things are essential: (i.) There must have been user in this country in connection with the goods in respect of which it is sought to register the trade mark, and (ii.) the trade mark must be distinctive.

User.—The application for registration must contain a statement of the time during which the trade mark has been used: Rule 10, and see Form F. But it would seem that, provided the trade mark has been used before 13th August 1875, the length of user is not material. Length of user was not previously necessary to entitle the proprietor to the protection of the court: see cases cited in notes to Merchandise Marks Act, 1862, sect. 1. And a proprietor is entitled to registration *ex debito justitiæ*, on giving such evidence as would formerly have entitled him to protection: see *per* Lord Blackburn in *Orr-Ewing* v. *Registrar of Trade Marks*, H. L. 1879, 4 App. Cas. 479; 48 L. J. Ch. 707; 41 L. T. N. S. 239; 28 W. R. 17; and see *Mitchell* v. *Henry*, C. A., 1880, 15 Ch. D. 181; 43 L. T. N. S. 186; and *In re Farina*, Hall, V.-C., 1879, 27 W. R. 456.

User abroad is not sufficient to entitle a trade mark owner to registration: *In re Leonard & Ellis' Trade Mark*, C. A., 1884, 26 Ch. D. 288; 53 L. J. Ch. 603; 51 L. T. N. S. 35; *In re Munch's Application*, Chitty, J., 1883, 50 L. T. N. S. 12; *In re Riviere's Trade Mark*, C. A., 1884, 26 Ch. D. 48; 53 L. J. Ch. 578; 50 L. T. N. S. 763; 32 W. R. 390.

There is, however, no necessity that the person claiming to be the proprietor should be a British subject: see notes to sect. 62 (1), and to Merchandise Marks Act, 1862, sect. 1; and see *In re Riviere's Trade Mark*, ubi supra, and *Mouson* v. *Boehm*, Chitty, J., 1884, 26 Ch. D. 398; 53 L. J. Ch. 932; 50 L. T. N. S. 784; 32 W. R. 612; and *In re Heaton's Trade Mark*, Kay, J., 1884, 27 Ch. D. 570; 53 L. J. Ch. 959; 51 L. T. N. S. 220; 32 W. R. 951.

A trade mark sought to be registered as an old mark must be exactly the same in every respect as the trade mark in which property by user is claimed; if any alteration has been made the application will be treated as an application for the registration of a new mark.

SECT. 64. *Illustrative Cases.*—(i.) The registration of the words "braided fixed stars" as a trade mark for matches was held bad, because prior to the passing of the Act of 1875 they had not been used alone, but merely upon a label in conjunction with other words: *In re Palmer's Trade Mark*, C. A., 1883, 24 Ch. D. 504; 50 L. T. N. S. 30; 32 W. R. 306.

(ii.) So too the word "Valvoline" was removed from the register because before 1875 it had been used not alone, but in conjunction with a device: *In re Leonard* v. *Ellis' Trade Mark*, C. A., 1884, 26 Ch. D. 288; 53 L. J. Ch. 603; 51 L. T. N. S. 35.

A trade mark can also only be registered as an old mark in respect of the goods in connection with which it was used before 1875: *In re Jelley, Son, & Jones*, Jessel, M.R., 1878; 51 L. J. Ch. 639. If it is sought to obtain registration in respect of other goods also, the application will be treated as an application for the registration of a new mark.

Distinctive.—"The words 'special and distinctive' import the specialising of the make and manufacture of a particular maker from all other manufacturers, and distinguishing the manufacture of one person from the manufacture of all others:" *per* Fry, L.J., in *In re Leonard & Ellis' Trade Mark*, ubi supra.

Prior to the Registration Acts, distinctiveness was an essential quality in a good trade mark, and the same degree of distinctiveness which was formerly requisite to entitle to the protection of the court, will entitle the owner of a mark to registration, *ex debito justitiæ: per* Lord Blackburn in *Orr-Ewing* v. *Registrar of Trade Marks*, H. L. 1879, 4 App. Cas. 479; 48 L. J. Ch. 707; 41 L. T. N. S. 239; 28 W. R. 17; and *In re Farina*, Hall, V.-C., 1879, 27 W. R. 456.

As to the degree of distinctiveness requisite, see sect. 72, whereby the Comptroller is prohibited from registering a mark so nearly resembling a mark already on the register as to be calculated to deceive; but as to "three mark rule," relating to old marks, see sect. 74.

Word or words may be not sufficiently distinctive, inasmuch as (i.) they are merely descriptive of the article to which they are attached, or of the business in connection with which they are used, or are of too general import to allow any one to monopolise them, or (ii.) though originally new names applied to newly

discovered articles, they have become merely descriptive in process of time and by usage, or (iii.) though originally the names of the inventors of the articles to which they are attached, they have become merely descriptive of the articles in question in consequence of the expiration of patents, or the publication of secret processes.

(i.) *Descriptive and General Terms.*

(1.) Descriptive of the goods, as "Nourishing Stout" in *Raggett* v. *Findlater*, Malins, V.-C., 1873, L. R. 17 Eq. 29; 43 L. J. Ch. 64; 29 L. T. N. S. 448; 22 W. R. 53; "Pictorial Almanac," in *Spottiswoode* v. *Clarke*, Cottenham, L.C., 1846, 2 Ph. 154; 10 Jur. 1043; 8 L. T. 230; "Porous Plasters," in *Re Brandreth*, Jessel, M.R., 1878, Seb. Dig. No. 626; "Golden Ointment," in *Green* v. *Rooke*, Wickens, V.-C., 1872, W. N., p. 49.

It has, however, been held that "Family Salve" in *Reinhardt* v. *Spalding*, Hall, V.-C., 1879, 49 L. J. Ch. 57; 28 W. R. 300; and "Kitchen Crystal Soap" in *Eastman's Trade Mark*, Bacon, V.-C., 1880, W. N., p. 128, are sufficiently distinctive to be registered as old marks.

(2.) Descriptive of the business, as "Colonial" in *Colonial Life Assurance Co.* v. *Home and Colonial Assurance Co.*, Romilly, M.R., 1864, 33 Beav. 548; 33 L. J. Ch. 741; 10 Jur. N. S. 967; 10 L. T. N. S. 448; 12 W. R. 783; "London and Provincial" in *London and Provincial Law Assurance Society* v. *London and Provincial Joint-Stock Life Assurance Company*, Shadwell, V.-C., 1847, 17 L. J. Ch. 37; 11 Jur. 938; 10 L. T. 127; "Capital and Counties" in *London & County Banking Co.* v. *Hampshire & North Wilts Bank*, Jessel, M.R., 1878, Seb. Dig. No. 618; "Australian" in *Australian Mortgage Land & Finance Co.* v. *Australian & New Zealand Mortgage Co.*, C. A. 1880, W. N., p. 6.

The difficulty in these cases is, that while the business name of another cannot be appropriated, yet a man cannot give himself any monopoly in a name which merely describes the nature of the business or the locality of its operations: *per* James, L.J., ibid.

In the majority of cases, such descriptive names as the above are used rather as trade names than as trade marks, properly so called, but the principles in pursuance of which they are protected are closely analogous: *vide* notes, *supra*.

SECT. 64. As regards similarity in the names of companies registered under the Companies Act, 1862, see 25 & 26 Vict., c. 89, s. 20.

(3.) General terms, as "Prize Medal" in *Batty* v. *Hill*, Wood, V.-C., 1863, 1 H. & M. 264; 8 L. T. N. S. 791; 11 W. R. 745; "Royal" in *In re Royal Baking Powder Co.*, C. A. 1880, W. N., p. 49; "Post Office Directory" in *Kelly* v. *Byles*, C. A. 1880, 13 Ch. D. 691; 49 L. J. Ch. 181; 42 L. T. N. S. 338; 28 W. R. 587; "Chronicle," as the name of a newspaper, in *Cowen* v. *Hulton*, C. A. 1882, 46 L. T. N. S. 897; "Patent" in *Edelsten* v. *Vick*, Wood, V.-C., 1853, 11 Hare 78; 18 Jur. 7, and in *Marshall* v. *Ross*, James, V.-C., 1869, 8 Eq. 651; 39 L. J. Ch. 225; 21 L. T. N. S. 260; 17 W. R. 1086. The words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To Counterfeit this is Forgery," will not be registered, and should not therefore be upon the representations of trade marks accompanying an application: Instruction 30; see also *In re Meikle's Trade Mark*, Hall, V.-C., 1876, 24 W. R. 1067.

(ii.) *Names of Articles which have become descriptive.*—"Paraffin Oil" in *Young* v. *Macrae*, Wood, V.-C., 1862, 9 Jur. N. S. 322; "Chlorodyne" in *Browne* v. *Freeman*, Wood, V.-C., 1864, 12 W. R. 305; and C. A. 1873, W. N., p. 173; "Linoleum" in *Linoleum Manufacturing Co.* v. *Nairn*, Fry, J., 1878, 7 Ch. D. 834; 47 L. J. Ch. 430; 38 L. T. N. S. 448; 26 W. R. 463; "Macassar Oil" in *Rowland* v. *Breidenbach*, Romilly, M.R., Seb. Dig. No. 386; "Golden Ointment" in *Green* v. *Rooke*, Wickens, V.-C., 1872, W. N., p. 49; "Valvoline" and "Valvoleum" in *Re Horsburgh*, Jessel, M.R., 1878, 53 L. J. Ch. 237; 50 L. T. N. S. 23; 32 W. R. 530, and in *Re Leonard & Ellis' Trade Mark*, C. A. 1884, 26 Ch. D. 288; 53 L. J. Ch. 603; 51 L. T. N. S. 35; "Braided Fixed Stars" in *Re Palmer's Trade Mark*, C. A. 1883, 24 Ch. D. 504; 50 L. T. N. S. 30; 32 W. R. 306; "Home Washer" in *Re Ralph's Trade Mark*, Pearson, J., 1883, 25 Ch. D. 194; 53 L. J. Ch. 188; 49 L. T. N. S. 504; 32 W. R. 168. The principles governing these cases is that if a person invents a process for making a new article, and at the same time invents a new name for describing such article, and the article comes to be known by that name only, he cannot, afterwards, when everybody is at liberty to make that article, claim a monopoly in the name: *In re Leonard and Ellis' Trade Mark*, supra.

To this class may be added such geographical names as are actually used to indicate the source whence the articles are supplied. These are either descriptive if they are truly indicative of the source of supply, or are deceptive if they are such as to afford a delusive representation of quality by indicating a source whence the articles might be, but actually are not derived. (As to such deceptive trade marks, see sect. 73, *post*.) In either case they cannot be protected, *e.g.*, "Angostura Bitters" in *Siegert* v. *Findlater*, Fry, J., 1878, 7 Ch. D. 801; 47 L. J. Ch. 233; 38 L. T. N. S. 349; 26 W. R. 459; "Anglo-Portuguese Oysters" in *Re Saunion & Co.*, Jessel, M.R., 1878, Seb. Dig. No. 625; "India and China Tea" in *India and China Tea Co.* v. *Teede*, Romilly, M.R., 1871, W. N., p. 241; Radstock Coals" in *Braham* v. *Beachim*, Fry, J., 1878, 7 Ch. D. 848; 47 L. J. Ch. 348; 38 L. T. N. S. 640; 26 W. R. 654; where an injunction was only granted unless and until the defendant should acquire a colliery within the parish of Radstock, and be thus justified in using the name.

There are some names, however, which, though actually geographical, cannot be understood as indicating a source of supply, but were from the first used merely as fancy names; consequently they are not descriptive of the origin of the goods to which they are attached, and may therefore be appropriated. Such are the terms, "Persian Thread" in *Taylor* v. *Taylor*, Wood, V.-C., 1854, 2 Eq. Rep. 290; 23 L. J. Ch. 255; 22 L. T. 271; "Ethiopian Stockings" in *Hine* v. *Lart*, Shadwell, V.-C., 1846, 10 Jur. 106; 7 L. T. 41; "Medicated Mexican Balm" in *Perry* v. *Truefitt*, Langdale, M.R., 1842, 6 Beav. 66; 1 L. T. 384; "Turin" and "Liverpool Shirts" in *Hirst* v. *Denham*, Bacon, V.-C., 1872, L. R. 14 Eq. 542; 41 L. J. Ch. 752; 27 L. T. N. S. 56; "Anatolia Liquorice" in *M'Andrew* v. *Bassett*, Westbury, L.C., 1864, 4 De G. J. & S. 380; 33 L. J. Ch. 566; 10 Jur. N. S. 550; 10 L. T. N. S. 442; 12 W. R. 777; "Glenfield Starch" in *Wotherspoon* v. *Currie*, H. L. 1872, L. R. 5 H. L. 508; 42 L. J. Ch. 130; 27 L. T. N. S. 393; "Strathmore Whisky" in *Blair* v. *Stock*, Kay, J., 1884, 52 L. T. N. S. 123.

As with all fancy names, the more extravagant the geographical name adopted the better; for then the most credulous will not be deceived by regarding it as indicating a certain source of supply or as furnishing a guarantee of quality: see *Young* v. *Macrae*, Wood, V.-C., 1862, 9 Jur. N. S. 322.

SECT. 64. The Merchandise Marks Act, 1862, sects. 7 and 8, renders liable to penalties every person who, with intent to defraud, places upon or sells any article with a false description of the place or country in which such article has been made or produced. And by sect. 20 a vendor of an article with a description thereon of the place or country where it has been made or produced is deemed to warrant that the description is true.

(iii.) *Names of Inventors which have become descriptive.*—"Liebig's Extract" in *Liebig's Extract of Meat Co.* v. *Hanbury*, Wood, V.-C., 1867, 17 L. T. N. S. 298; "Lieutenant James' Horse Blister" in *James* v. *James*, Romilly, M.R., 1872, L. R. 13 Eq. 421; 41 L. J. Ch. 353; 26 L. T. N. S. 568; 20 W. R. 434; "Harvey's Sauce" in *Lazenby* v. *White*, C. A. 1871, 41 L. J. Ch. 354; "Allcock's Porous Plasters" in *Re Brandreth*, Jessel, M.R., 1878, Seb. Dig. No. 626; "Condy's Fluid" in *Condy* v. *Mitchell*, C. A. 1877, 37 L. T. N. S. 766; 26 W. R. 269; "Velno's Vegetable Syrup" in *Canham* v. *Jones*, Plumer, V.-C., 1813, 2 V. & B. 218; "Dr Johnson's Golden Ointment" in *Singleton* v. *Bolton*, K. B. 1783, 3 Doug. 293; "Burgess' Essence of Anchovies" in *Burgess* v. *Burgess*, C. A. 1853, 3 De G. M. & G. 896; 22 L. J. Ch. 675; 17 Jur. 292; 21 L. T. 53; "Tayler's Patent Solid-headed Pins" in *Edelsten* v. *Vick*, Wood, V.-C., 1853, 11 Hare 78; 18 Jur. 7; "Wheeler & Wilson" and "Singer" used to indicate sewing-machines of special contruction in *Wheeler & Wilson Manufacturing Co.* v. *Shakespear*, James, V.-C., 1869, 39 L. J. Ch. 36; and *Singer Manufacturing Co.* v. *Loog*, H. L. 1882, 8 App. Cas. 15; 52 L. J. Ch. 481; 48 L. T. N. S. 3; 31 W. R. 325; "Thorley's Food for Cattle" in *Massam* v. *Thorley's Cattle Food Co.*, Malins, V.-C., 1877, 6 Ch. D. 574; 46 L. J. Ch. 707; 36 L. T. N. S. 848.

A trade mark consisting of an inventor's name may be "so completely personal as of necessity to import that the goods sold under it have been manufactured by a particular individual:" *per* Turner, L.J., *Bury* v. *Bedford*, 1864, 4 De G. J. & S. 352; 33 L. J. Ch. 465; 10 Jur. N. S. 503; 10 L. T. N. S. 470; 12 W. R. 726. In which case, if the business changed hands, the use of such a trade mark might become deceptive: see sect. 73.

But, on the other hand, "a name, though originally the name of the first maker, may in time become a mere trade mark or sign

of quality, and cease to denote or to be current as indicating that any particular person is the maker. In many cases a name once affixed to a manufactured article continues to be used for generations after the death of the individual who first affixed it. In such cases the name is accepted in the market either as a brand of quality, or it becomes the denomination of the article itself, and is no longer a representation that the article is the manufacture of any particular person:" *per* Westbury, L.C., *Hall* v. *Barrows*, 1863, 4 De G. J. & S. 150; 33 L. J. Ch. 204; 10 Jur. N. S. 55; 9 L. T. N. S. 561; 12 W. R. 322; and in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 10 Jur. N. S. 81; 9 L. T. N. S. 558; 12 W. R. 289: see *Singer Machine Manufacturers* v. *Wilson*, H. L. 1878, 3 App. Cas. 376; 47 L. J. Ch. 481; 38 L. T. N. S. 303; 26 W. R. 664.

It has been held that the name of an inventor, which by judicial decision has been declared open to the trade as the proper description of an article made in accordance with the original recipe, cannot be registered even in combination with the portrait of the original inventor, for the portrait itself is not under the circumstances a sufficiently distinctive device: *In re Anderson's Trade Mark*, Chitty, J., 1884, 26 Ch. D. 409; 53 L. J. Ch. 664; 32 W. R. 677.

Letters.—Under the Act of 1875 a single letter could not be registered: *In re Mitchell's Trade Mark*, Hall, V.-C., 1877, 7 Ch. D. 36; 46 L. J. Ch. 876; 26 W. R. 326.

In the case of new marks a combination of letters can only be registered in conjunction with an essential particular as described in sub-sect. 1; in the case of old marks such combinations of letters alone have always been regarded as good trade marks and are registrable.

Illustrative Cases.—(i.) "H. H." and a number denoting size for use on plough-shares: *Ransome* v. *Bentall*, Shadwell, V.-C., 1833, 3 L. J. Ch. 161.

(ii.) "M. C." for use on tin-plates: *Motley* v. *Downman*, Cottenham, L.C., 3 My. & C. 1; 6 L. J. Ch. 308.

(iii.) "J. H." for use on steel: *Millington* v. *Fox*, Cottenham, L.C., 1838, 3 My. & C. 338.

(iv.) "W. C." for use on iron: *Crawshay* v. *Thompson*, C. P. 1842, 4 Man. & G. 357; 11 L. J. C. P. 301.

SECT. 65. It is more usual, however, to find letters printed in some distinctive manner or in conjunction with an additional device.

Illustrative Cases.—(i.) "C. B." in conjunction with a cross upon labels for cotton: *Cartier* v. *Carlile*, Romilly, M.R., 1862, 31 Beav. 292; 8 Jur. N. S. 183.

(ii.) "B. B. H." with a crown upon iron: *Hall* v. *Barrows*, Westbury, L.C., 1863, 4 De G. J. & S. 150; 33 L. J. Ch. 204; 10 Jur. N. S. 55; 9 L. T. N. S. 561; 12 W. R. 322; *In re Barrows' Trade Mark*, C. A. 1877, 5 Ch. D. 364; 46 L. J. Ch. 725; 36 L. T. N. S. 780; 25 W. R. 564.

(iii.) "J. O. B. S." inscribed in the spaces formed by crossed arrows with a lion couchant beneath, used upon steel goods: *Bury* v. *Bedford*, C. A. 1864, 4 De G. J. & S. 352; 33 L. J. Ch. 465; 10 Jur. N. S. 503; 10 L. T. N. S. 470; 12 W. R. 726.

(iv.) "M. & C." in a circle upon champagne bottles: *Moet* v. *Clybouw*, Jessel, M.R., 1877, Seb. Dig. No. 533; *Moet* v. *Pickering*, C. A. 1878, 8 Ch. D. 372; 47 L. J. Ch. 527; 38 L. T. N. S. 799; 26 W. R. 637.

Trade marks consisting wholly of a letter or letters, or of a combination of letters, can only be registered provided they are old marks; but trade marks composed of letters in combination with a distinctive device may be registered whether they be old or new: see sub-sect. 2.

In the case of new marks, however, the device only is the essential particular, and there is nothing to prevent the same letters being registered with another device: see *In re Horsburgh*, Jessel, M.R., 1878, 53 L. J. Ch. 237; 50 L. T. N. S. 23; 32 W. R. 530. As to representative registration, see sect. 66.

As to registration of a trade mark with disclaimer of so much thereof as is common to the trade, see sect. 74.

Figures here mean numerical figures: *Ex parte Stephens*, Jessel, M.R., 1876, 3 Ch. D. 659; 46 L. J. Ch. 46; 24 W. R. 963.

Connection of trade mark with goods.

65. A trade mark must be registered for particular goods or classes of goods.

This is taken from sect. 2 of the Act of 1875. As to the classification of goods, see Rule 6 and the third schedule there referred

to. A guide to the classification of goods under the rules may be obtained at the Patent Office : see Instruction 20. SECT. 66.

The Act of 1875, sect. 6, and Rule 19 thereunder, contained a prohibition against the registration without leave of the court in respect of the same goods or classes of goods of a trade mark identical with one already registered in respect of such goods or classes of goods. The restriction in future will relate only to "the same goods or description of goods," see sect. 72; and there is nothing to prevent the registration of identical marks for goods in the same class, provided such goods are not the same nor of the same description. Consequently the value of the division of goods into the classes specified in Rule 6 and the third schedule is not very evident.

Subdivision of Classes.—Under the Act of 1875 the registration of a trade mark similar to one already on the register for goods essentially different though belonging to the same class was sometimes permitted by the court both in the case of old marks (*In re Lysaght*, Jessel, M.R., 1878, Seb. Dig. No. 623; *In re Rabone*, Jessel, M.R., 1879, Seb. Dig. No. 643; *Ex parte Barrow & Co.*, Jessel, M.R., 1877, W. N., p. 119), and in the case of new marks (*In re Jelley, Son, & Jones' Trade Mark*, Jessel, M.R., 1878, 51 L. J. Ch. 639; 46 L. T. N. S. 381; *Re Braby & Co.'s Trade Mark*, North, J., 1882, 21 Ch. D. 223; 51 L. J. Ch. 637; 46 L. T. N. S. 380; 30 W. R. 675; but see *Re Hargreaves' Trade Mark*, Hall, V.-C., 1879, 11 Ch. D. 669; 27 W. R. 550). See further, as to subdivision of classes, sect. 72; the subdivision is effected by inserting on the register an undertaking restricting the user of the trade mark : see notes to sect. 62; *In re Rabone & Co.*, ubi supra; and *In re Mitchell and Houghton and Hall-mark's Trade Marks*, Chitty, J., 1885, 28 Ch. D. 666; 33 W. R. 408.

Registration of a series of marks.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (*a.*) the statement of the goods for which they are respectively used or proposed to be used, or (*b.*) statements of numbers, or (*c.*) statements of price, or

SECT. 66. (*d.*) statements of quality, or (*e.*) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately.

As to the representations to be furnished of a series of trade marks see Rule 14, and as to mode of advertising see Rule 28: see Instruction 18. The Act of 1875, contained no provision corresponding to this, but the mode, known as representative registration, here defined, was occasionally adopted.

Illustrative Cases.—(i.) Where a firm of iron manufacturers had been in the habit of using as trade marks the letters "B. B. H.," which were the initials of the firm, and also the same marks coupled with symbols or words common to the trade denoting the quality of the iron, it was decided on appeal that the proper mode of registration was to register the trade mark B. B. H. "to be used either alone or with any device or words signifying the quality of the iron:" *In re Barrows' Trade Marks*, Malins, V.-C., 1877, 5 Ch. D. 353; 46 L. J. Ch. 450; 36 L. T. N. S. 291; 25 W. R. 407; and C. A. 1877, 5 Ch. D. 364; 46 L. J. Ch. 725; 36 L. T. N. S. 780; 25 W. R. 564.

(ii.) Where an attempt was made to obtain separate registration of a number of marks in all of which the essential particulars consisted of a goat's head and the name "Brook's," it was held that such a series was not entitled to separate registration, but only to representative registration: *In re Brook's Trade Mark*, Hall, V.-C., 1878, 26 W. R. 791.

Material particular probably means the same as the term "essential particular" in sect. 64 (1), *i.e.*, that which makes the mark capable of registration under the Act, and which is unalterable under sect. 92, even by leave of the court. Just as under sect. 64 there may be registered any letters, words, or figures in addition to the essential particular in the case of a single mark, so in the case of a series there may be registered

the essential particular, as for instance "B. B. H." in *Re Barrows' Trade Mark*, supra, with (*a.*) the statement of the goods on which it is used, *e.g.*, "B. B. H. Plating;" or (*b.*) statements of numbers, *e.g.*, a goat's head and the name Brook's, in *Re Brook's Trade Mark*, supra, followed by various numerals denoting quality; or (*c.*) statements of price, *e.g.*, *In re Steedman's Trade Mark*, L. J. N. of C. 1883, p. 83; (*d.*) statements of quality, *e.g.*, "B. B. H. Special Best, Best;" or (*e.*) statements of names of places, *e.g.*, "B. B. H. Bloomfield."

It seems doubtful whether under this section an additional device, common to the trade, as the Crown and Horse-shoe in *In re Barrows' Trade Mark*, can be registered in connection with a distinctive mark, unless the combination was in use as a trade mark before August 1875: see sect. 74, which seems to place some limitation on the practice of allowing the registration of common marks as additions to trade marks, subject to a disclaimer being entered of the portion common to the trade: see too *In re Kuhn & Co.'s Trade Mark*, Jessel, M.R., 1878, 53 L. J. Ch. 238.

67. A trade mark may be registered in any colour, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour.

Trade marks may be registered in any colour.

Under the Act of 1875 no regard was had to the colour of trade marks owing to the difficulties of advertisement: see *In re Robinson's Trade Mark*, Jessel, M.R., 1880, 29 W. R. 31.

Consequently, in deciding the question of piracy the colour of the marks was not taken into account, but the only test adopted was a comparison of the uncoloured diagrams: *Nuthall* v. *Vining*, C. A. 1880, 28 W. R. 330.

Since under the Act of 1875 a trade mark was registered only in black, and might thereafter be printed in any colour, the registration of a mark, which if printed in a colour similar to that used in the case of a trade mark already on the register would be liable to deceive, was refused: *In re Worthington &*

SECT. 67. *Co.'s Trade Mark*, C. A. 1879, 14 Ch. D. 8; 49 L. J. Ch. 646; 42 L. T. N. S. 563; 28 W. R. 747.

It should be remembered that the principles according to which the court acts in preventing a man passing off his goods as those of another have not been altered by the Registration Acts, and that a question of piracy cannot be disposed of by simple inspection of the trade marks without inquiring whether, according to the understanding of the trade, the resemblance is such as to be likely to cause deception: *Mitchell* v. *Henry*, C. A. 1880, 15 Ch. D. 181; 43 L. T. N. S. 186.

As a consequence of this rule great weight will always be given to the opinion of the committee of experts at Manchester, which, though not a judicial tribunal, is appointed to give an opinion on technical matters peculiarly within the knowledge of its members: *Orr-Ewing* v. *Registrar of Trade Marks*, H. L. 1879, 4 App. Cas. 479; 48 L. J. Ch. 707; 41 L. T. N. S. 239; 28 W. R. 17.

By Rule 13 it is provided that in place of a representation the Comptroller may in exceptional cases deposit a specimen or copy of a trade mark at the Patent Office, and reference may be made to this copy or specimen in the advertisement: see Rule 25. This is to meet the case of coloured trade marks.

Under Rule 8 of the Rules under the Act of 1875 it was likewise the custom to allow the deposit of specimens of trade marks in the textile fabric classes in the majority of cases: see *Mitchell* v. *Henry*, and *In re Robinson's Trade Mark*, supra.

Consequently where the registered trade mark for textile fabrics was a silver rupee, it was held that a mark consisting of a gold mohur which had been so deposited under Rule 8 was not calculated to deceive, and was therefore registrable: *In re Robinson's Trade Mark*, supra.

Ornamental or coloured ground-work, such as tartans or checks, cannot be claimed as part of a mark unless such ground-work be included within the mark by some border or lines: see Instruction 29.

The general effect of the above section cannot be held very important. It enables manufacturers to register a trade mark in any colour, and places a mark so registered in exactly the same position as though it were registered in black. It does not render it incumbent upon the owner to use the mark coloured to

correspond with the deposited representation; nor does it affect the rules whereby the courts are guided in forming decisions upon questions of piracy. SECT. 68.

68. Every application for registration of a trade mark under this part of this Act shall, as soon as may be after its receipt, be advertised by the Comptroller. Advertisement of application.

As to advertisement of application, see Rules 25–28, and also Instructions 21–28.

Since the object of the prescribed advertisement is to give people an additional opportunity, besides looking at the register, of knowing what is going to be done (per Jessel, M.R., in *Re Hyde's Trade Mark*, 1878, 7 Ch. D. 724; 54 L. J. Ch. 395; 38 L. T. N. S. 777; 26 W. R. 625), the usual practice has been for the court, in reversing the Registrar's refusal to register, to order, not that the trade mark should be entered on the register, but that the Registrar should proceed with the application in the ordinary course: *In re Meikle's Trade Mark*, Hall, V.-C., 1876, 24 W. R. 1067. See also *Orr-Ewing* v. *Registrar of Trade Marks*, Hall, V.-C., 1878, 8 Ch. D. 793; 47 L. J. Ch. 180; 38 L. T. N. S. 313; 26 W. R. 259; and H. L. 1879, 4 App. Cas. 497; 48 L. J. Ch. 707; 41 L. T. N. S. 239; 28 W. R. 17; *Ex parte Lawrence Bros.*, Jessel, M.R., 1878, 44 L. T. N. S. 98; 29 W. R. 392.

The same rule will doubtless be adhered to by the Board of Trade under sect. 62.

There is no obligation to see the advertisement, and if a person interested does not see it, he is in no worse position than he would have been before; he must merely use due diligence, when the fact comes to his knowledge, to remove the trade mark: *In re Hyde's Trade Mark*, supra. Consequently, when a common mark has been registered without opposition, its removal may be obtained by a person aggrieved within a reasonable time after the fact of its registration became known to him (ibid.)

This can be effected even after the expiration of five years from the date of registration, for it has been heldthat sect. 3 of the Act of 1875 (to which sect. 76 of this Act corresponds), making the registration of a trade mark *primâ facie* evidence, and the continuance

SECT. 69. of the registration for five years conclusive evidence of the right of the registered proprietor to the exclusive use of that trade mark, does not control, and has no bearing upon the right of any one who holds himself aggrieved by improper registration to apply to the court for the removal of the trade mark alleged to have been improperly registered: *In re Palmer's Trade Mark*, C. A., 1882, 21 Ch. D. 47; 51 L. J. Ch. 673; 46 L. T. N. S. 787; *In re Leonard & Ellis' Trade Mark*, C. A., 1884, 26 Ch. D. 288; 53 L. J. Ch. 603; 32 W. R. 532; and *In re Ralph's Trade Mark*, Pearson, J., 1883, 25 Ch. D. 194; 53 L. J. Ch. 188; 49 L. T. N. S. 504; 32 W. R. 168; *In re Lloyd's Trade Mark*, Chitty, J., 1884, 27 Ch. D. 646; 54 L. J. Ch. 66; *In re Wragg's Trade Mark*, Pearson, J., 1885, 54 L. J. Ch. 391.

As to rectification of the register, see sect. 90.

By sect. 63 it is provided that if registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the application shall be deemed to be abandoned.

The Comptroller is bound, unless, of course, prevented by the default of the applicant, to register the trade mark as soon as may be after the expiration of two months from the first advertisement of the application, if he considers the applicant entitled to registration: see Rule 30.

Opposition to registration.

69. (1.) Any person may, within two months of the first advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade mark, and the Comptroller shall send one copy of such notice to the applicant.

(2.) Within two months after receipt of such notice, or such further time as the Comptroller may allow, the applicant may send to the Comptroller a counter statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

(3.) If the applicant sends such counter statement, the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the Comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the Comptroller may allow, the opposition shall be deemed to be withdrawn. SECT. 69.

(4.) If the person who gave notice of opposition duly gives such security as aforesaid, the Comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the court.

This section is substantially the same as Rule 16 of the Rules of 1876, as modified by Rule 15 of the Rules of 1883 made under the Act of 1875.

(1.)

For notice of opposition see Form J, and as to counter statement and bond, see Instruction 33. The stamp on the notice of opposition is £1: see first schedule to Rules. The bond will bear the ordinary *ad valorem* duty: see Stamp Act, 1870, 33 & 34 Vict., c. 97, and note to sub-sect. (3), *infra*. No stamp is required on the counter statement.

Person includes a body corporate: sect. 117. It is not necessary that a person opposing registration should himself be entitled to register the trade mark, or should be carrying on business in this country. Any one presumably who, being "aggrieved" within the meaning of sect. 90, can apply for the rectification of the register, can also oppose under this section an application to register: *In re Riviere's Trade Mark*, C. A. 1884, 26 Ch. D. 48; 53 L. J. Ch. 578; 32 W. R. 390. See also *In re Heaton's Trade*

SECT. 69. *Mark*, Kay, J., 1884, 27 Ch. D. 570; 53 L. J. Ch. 959; 51 L. T. N. S. 220; 32 W. R. 951; and *Mouson* v. *Boehm*, Chitty, J., 1884, 26 Ch. D. 398; 53 L. J. Ch. 932; 50 L. T. N. S. 784; 32 W. R. 612. This section does not deal with a case of opposition to the registration of a trade mark where the opponent also seeks registration of the identical trade mark; such a case is one of conflicting claim, and is provided for in sect. 71. But it includes all cases of opposition where the mark to which the application relates is similar to a mark of the opponent, whether registered, or only proposed to be registered.

By sect. 72 the Comptroller is prohibited from registering a trade mark so nearly resembling a trade mark already on the register as to be calculated to deceive.

If the opponent's mark is not registered, but registration is claimed at the time of opposition, an order will not be made for registration, in the event of the opposition being successful, but the opponent must make an application in the ordinary manner: see *In re Meikle*, Hall, V.-C., 1876, 24 W. R. 1067; and *Ex parte Lawrence Bros.*, Jessel, M.R., 1878, 40 L. T. N. S. 98; 29 W. R. 392; and see notes to sect. 68.

(2.)

For form of counter-statement, see Instruction 33. No stamp is apparently required.

(3.)

For form of security, see Instruction 33. Before the applicant is required to bring an opposition matter before the court, he will be afforded an opportunity of objecting to the solvency of the security: Instruction 34.

The following are the *ad valorem* duties imposed by the Stamp Act, 1870, 33 & 34 Vict., c. 97.

	£	s.	d.
For securing the payment of money not exceeding £25	0	0	8
Exceeding £25 and not exceeding £50 . .	0	1	3
„ 50 „ „ „ 100 . .	0	2	6
„ 100 „ „ „ 150 . .	0	3	9
„ 150 „ „ „ 200 . .	0	5	0
„ 200 „ „ „ 250 . .	0	6	3

	£	s.	d.
Exceeding £250 and not exceeding £300 . .	0	7	6
„ 300, for every £100, and also for any fractional part of £100 of such amount	0	2	6

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(4.)

Procedure.—Where a case stands for the determination of the court under this section, the Comptroller is to require the applicant for registration to issue a summons in the chambers of a judge for an order that, notwithstanding the opposition of which notice has been given, the registration be proceeded with by the Comptroller: see, as to the practice, Rule 29. This is approximately the old practice, which was for the Registrar to require the opponent to apply for a direction as to the mode of trial, whereupon the person seeking to register was usually directed to take out a summons which could be adjourned into court: *In re Simpson, Davies & Sons' Trade Mark*, Jessel, M.R., 1880, 15 Ch. D. 525; 42 L. T. N. S. 675; 28 W. R. 760.

The summons for directions is now abolished.

A motion for an injunction by the opponent was held to be irregular under the Act of 1875 (*In re Simpson, Davies & Sons' Trade Mark*, supra), although that course had been adopted in previous cases: see *In re Worthington & Co.'s Trade Mark*, Jessel, M.R., 1879, 14 Ch. D. 8; 49 L. J. Ch. 646; 42 L. T. N. S. 563; 28 W. R. 747; *In re Farina*, Hall, V.C., 1878, 26 W. R. 261; *In re Farina*, Hall, V.-C., 1879, 27 W. R. 456.

The practice was never consistent. In the following cases directions seem to have been sought by the opponent by motion and not by summons, and the directions given were (i.) motion: *Ex parte King of Saxony*, Hall, V.-C., 1878, Seb. Dig. No. 598, (ii.) summons taken out by the opponents: *In re Paton*, Jessel, M.R., 1878, Seb. Dig. No. 601, and not by the applicant as recommended in *Re Simpson, Davies & Sons' Trade Mark*, supra; and (iii.) an action, the question proving to be one of title to the mark: *In re Salamon*, Jessel, M.R., 1877, Seb. Dig. No. 569.

As to the notification of the order of the court to the Comptroller, see Rule 44.

When a registered owner does not desire the absolute rejection

SECT. 70. of an application, but is satisfied with the limitation of the user of the mark proposed to be registered, no formal notice of opposition is requisite under this section, but the court will give the Comptroller directions to add a note to the desired effect upon an *ex parte* application by the person desiring registration: *In re Keep's Trade Mark*, Pearson, J., 1884, 26 Ch. D. 187; 50 L. T. N. S. 453; 32 W. R. 427, and see Rule 32. And as to limited registration, see notes to sect. 62 (4).

Costs.—The case stands for the determination of the court only when security for costs has been given, and consequently the court, in exercising the discretionary power given to it by the Rules of Court, 1883, Order lxv., as to costs "of and incident to all proceedings in the High Court," has only jurisdiction to order the payment of costs incurred subsequently to that time, and has no power to order the payment of the costs of previous proceedings: *In re Brandreth's Trade Mark*, Jessel, M.R., 1878, 9 Ch. D. 618; 47 L. J. Ch. 618; 27 W. R. 281. The words in sect. 90 authorising the court to make such order as to the costs of proceedings as it shall think fit, are presumably not intended to extend its jurisdiction to costs incurred in previous proceedings before the Comptroller. In regard to these latter there seems to be no provision in the Act.

An unsuccessful opponent will have to pay the costs even though the opposition is raised by a public body acting in the public interest: *In re Rosing*, C. A., 1878, Seb. Dig., No. 621. But no costs will be given if the application, being in respect of several classes, succeeds as to same and fails as to others: *In re Rosing*, supra, and *In re Jelley, Son, & Jones' Trade Mark*, Jessel, M.R., 1878, 51 L. J. Ch. 639: 46 L. T. N. S. 381.

In any case the costs of the Comptroller, if he appear, will have to be paid: *In re Orr-Ewing's Trade Marks*, Hall, V.-C., 1880, W. N., p. 24; and see *In re Rotherham's Trade Mark*, C. A., 1880, 14 Ch. D. 585; 49 L. J. Ch. 513; 43 L. T. N. S. 1; *In re Maignen*, Jessel, M.R., 28 W. R. 759.

Assignment and transmission of trade mark.

70. A trade mark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or

classes of goods for which it has been registered, and shall be determinable with that goodwill. SECT. 70.

This section is a re-enactment of a part of sect. 2 of the Act of 1875.

When a person becomes entitled to a registered trade mark by assignment or transmission he must apply to have his name inserted on the register: sects. 78 and 87, Rules 34–36, Form K, and Instructions 42.

The application must be accompanied by a statutory declaration verifying his title: Rule 37, and Form K. See Rule 58.

The fee for the registration of a subsequent proprietor is for the first mark £1, and for every additional mark assigned or transmitted at the same time 2s.

The person for the time being on the register has full power to assign and deal with a trade mark: sect. 87. But it is questionable whether the five years, affording conclusive evidence of title, will date from the registration of the trade mark rather than merely from the date of the registration of the assignment or transmission: sect. 76. By sect. 4 of the Act of 1875 it was provided that every person subsequently registered should stand in the same position as if his title were a continuation of the title of the first registered proprietor. A similar provision seems wanting in this Act.

The intimate connection between the trade marks and the goodwill of a business has long been recognised.

Illustrative Cases.—(i.) In a contract the words "goodwill," &c., were held to include "such other things as are necessarily connected with and belong to the goodwill," as, for instance, the trade marks: *Cooper* v. *Hood*, Romilly, M.R., 1858, 26 Beav. 293; 28 L. J. Ch. 212; 4 Jur. N. S. 1266; 32 L. T. 171; 7 W. R. 83.

(ii.) It appears also that just as the firm name is a very important part of the goodwill of the business, so is it with a trade mark. Each proves that the articles to which it is affixed emanate from the firm: *Churton* v. *Douglas*, Wood, V.-C., 1859, Johns. 174; 28 L. J. Ch. 841; 5 Jur. N. S. 887; 33 L. T. 57; 7 W. R. 365.

(iii.) So the sale of a business includes the sale of the goodwill and trade marks without special mention: *Shipwright* v. *Clements*,

SECT. 70. Malins, V.-C., 1871, 19 W. R. 599. See *Levy* v. *Walker*, C. A. 1879, 10 Ch. D. 436; 48 L. J. Ch. 273; 39 L. T. N. S. 656. See *per* Blackburn in *Singer Manufacturing Co.* v. *Loog*, H. L. 1882, 8 App. Cas. 33; 52 L. J. Ch. 481; 31 W. R. 325.

Conversely, as is specially provided in this section, a trade mark could never exist nor be transferred in gross, that is, independently of the business in which it had been used: *Cotton* v. *Gillard*, Jessel, M.R., 1874, 44 L. J. Ch. 90. See *Ex parte Lawrence Bros.*, Jessel, M.R., 1878, 44 L. T. N. S. 98; 29 W. R. 392.

Determinable with that Goodwill.—By Rule 34 of the rules under the Act of 1875 (numbered 33 in the issue of 1883) the court was empowered to remove, upon the application of a person aggrieved, any trade mark from the register, on the ground that the registered proprietor was not engaged in any business concerned in the goods within the same class as the goods with respect to which the trade mark was registered.

There seems now to be no provision equivalent to this, for, provided the registration were originally proper, sect. 90 appears not to apply.

The words "a trade mark shall be determinable with the goodwill" appear to mean that on the determination of the goodwill the mark *ipso facto* ceases to be a trade mark within the meaning of the Act. The result consequently will be that marks, which are not trade marks, may remain on the register, incapable of removal unless the registered proprietor applies for cancellation under sect. 91, or until on non-payment of the requisite fees the Comptroller's power to cancel under sect. 79 arises.

Since, however, such marks, though on the register, have ceased to be trade marks, properly so called, their continuance on the register may possibly be held not to render operative the restrictions imposed by sect. 72, and they may consequently be disregarded.

Under the above-mentioned Rule 33 of the Rules under the Act of 1875 it was held that a patentee of a machine, which had been exclusively manufactured by a licensee on payment of a royalty, carried on business so long as the patent subsisted; but that a trade mark which he had registered must be removed on his failing to continue to manufacture the machines himself for a year and nine months after the expiration of the patent: *In re Ralph's Trade Mark*, Pearson, J., 1883, 25 Ch. D. 194; 53 L. J. Ch. 188; 49 L. T. N. S. 504; 32 W. R. 168.

71. Where each of several persons claims to be registered as proprietor of the same trade mark, the Comptroller may refuse to register any of them until their rights have been determined according to law, and the Comptroller may himself submit or require the claimants to submit their rights to the court.

SECT. 71. Conflicting claims to registration.

This is a re-enactment of a part of sect. 5 of the Act of 1875.

The submission to the court is to be by special case: see Rules 40–43. This was also the course under the Act of 1875: *Ex parte Grimshaw*, W. N. 1877, p. 24, where Hall, V.-C., refused to use his discretion "to order otherwise;" see Rule 44 of the Rules under the repealed Act.

In practice, however, the statement of the special case gave rise to so much difficulty, that it was abandoned, and one of the parties was, as a rule, directed to take out a summons for directions: see *In re Simpson, Davies & Son's Trade Mark*, Jessel, M.R., 1880, 15 Ch. D. 525; 42 L. T. N. S. 675; 28 W. R. 760. See also notes to sects. 62 (4), and 69.

Cross summonses, taken out by both claimants and at once adjourned into court, have been directed: *In re Powell*, Jessel, M.R., 1878, Seb. Dig. No. 589; *In re Rabone*, Jessel, M.R., 1879, Seb. Dig. No. 643.

In one case an action was directed, because the question to be tried was a question of title, and it was said that the way in which cases of conflicting claims should come before the court depended upon the circumstances of each individual case. "If it be a simple question of law it had better be by special case; if for directions for carrying out the Act, by summons in chambers; if of disputed facts, by motion:" *In re Salamon*, Jessel, M.R., 1877, Seb. Dig. No. 569.

Henceforth procedure by special case would seem to be obligatory, unless the court gives some special directions to the contrary: see Rule 43.

For form of application for settlement by the comptroller of a special case see Form T. It has to be signed by both claimants, and bears a stamp of £2, which includes apparently the whole

SECT. 71. cost of the settlement by the Comptroller of the special case: see first schedule to the Rules.

The section being directory only in form it is competent for the Comptroller to decide between the conflicting titles of the applicants and to select one for registration without referring to the court. He cannot register more than one: see sect. 72.

The applicant whose application is thus refused may proceed, it would seem, under sect. 90, as a "person aggrieved by the omission without sufficient cause of his name from the register."

Before exercising adversely to an applicant a discretionary power like that here given, the Comptroller is bound to afford him an opportunity of being heard personally or by an agent, and to give him ten days' notice of an appointment for the purpose: sect. 94, and Rules 17–19.

The section deals only with conflicting claims to the same trade mark. The case of opposition to an application on the ground that the trade mark sought to be registered is, although not identical, yet so similar to a mark claimed by the opponent as to be calculated to deceive, comes within sect. 69, even when the opponent claims registration of his mark concurrently with his opposition to the other application.

A title to the same trade mark may be acquired by two or more persons in several ways.

Illustrative Cases.—(i.) When they have used the mark independently for several years: *In re Powell*, Jessel, M.R., 1878, Seb. Dig. No. 589; *In re Rabone Bros. & Co.*, Jessel, M.R., 1879, Seb. Dig. No. 643.

(ii.) When on a dissolution of partnership it is agreed that the several partners may continue the same trade: *Benbow* v. *Low*, Bacon, V.-C., 1880, 44 L. T. N. S. 875; 29 W. R. 837. See also *Hine* v. *Lart*, Shadwell, V.-C., 1846, 10 Jur. 106; 7 L. T. 41; and *Banks* v. *Gibson*, Romilly, M.R., 1865, 34 Beav. 566; 34 L. J. Ch. 591; 11 Jur. N. S. 680; 13 W. R. 1012.

(iii.) When a trader who has carried on business in two shops bequeaths the business carried on at one of them to one legatee and the business carried on at the other to another legatee: see *Dent* v. *Turpin*, Wood, V.-C., 1861, 2 J. & H. 139; 30 L. J. Ch. 495; 7 Jur. N. S. 673; 4 L. T. N. S. 637; 9 W. R. 548.

The trade marks will pass without a distinct stipulation upon an

assignment or transmission of the goodwill of the business in connection with which they have been used: see sect. 70.

As to the registration of the same old marks for use on the same goods up to the number of three when equally valid titles are shown, see notes on the "three-mark rule" to sects. 72 and 74.

Restrictions on registration.

72. (1.) Except where the court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the Comptroller shall not register in respect of the same goods or description of goods a trade mark identical with one already on the register with respect to such goods or description of goods.

(2.) The Comptroller shall not register with respect to the same goods or description of goods a trade mark so nearly resembling a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

The section is derived from sect. 6 of the Act of 1875. There, however, the restriction was against registration of identical or similar trade marks "in respect of the same goods or classes of goods." Greater latitude is here given to the Comptroller, for he can, it seems, register identical or similar trade marks provided the goods, although they may be in the same class, are substantially different.

A refusal to register by the Comptroller under this section would seem to come within sect. 62, in which case the appeal seems to be to the Board of Trade in the first place. The Board will be able to decide, when the trade marks are similar but not identical, whether they are so similar as to be calculated to deceive, and to order the registration to proceed or not as the case may be. If, however, the trade marks are identical the Board cannot order registration, but must refer at once to the

SECT. 72. court; for the registration of identical trade marks, it will be noticed, is absolutely prohibited except by leave of the court.

As to whether an applicant can proceed at once to the court without the appeal being referred by the Board, see notes to sect. 62 (4).

Where the refusal is not at the instance of the Comptroller, but is the result of opposition by the registered owner, the mode of procedure is regulated by sect. 69.

And where several persons, all unregistered, claim simultaneously the registration of the same trade mark the procedure is regulated by sect. 71.

Where a person claims to be the proprietor of several marks which, while resembling each other in the essential particulars, yet differ in certain respects, they should be registered as a series in one registration: see sect. 66.

As to notifying the Comptroller of an order of the court, see Rule 44.

Subdivision of Classes.—In spite of the prohibition against the registration in respect of the same goods or classes of goods of a trade mark identical with one already on the register, or so similar as to be calculated to deceive, the court under the Act of 1875 permitted in some cases the subdivision of classes.

Illustrative Cases.—(1.) In the case of old marks.

(i.) In class 5 for use only on tin-plates, turn-plates, and sheet iron: *Ex parte Barrow & Co.*, Jessel, M.R., 1877, W. N., p. 119.

(ii.) In classes 11, 12, and 13 with a proviso that it should not be stamped on metal goods: *In re Whiteley*, Jessel, M. R., 1879, 43 L. T. N. S. 627; 29 W. R. 235.

(iii.) In class 5 for use only on galvanised iron: *In re Lysaght*, Jessel, M.R., 1878, Seb. Dig. No. 623.

(iv.) In classes 12 and 13 for use only on goods exported to certain colonies: *In re Rabone Bros.*, Jessel, M.R., 1879, Seb. Dig. No. 643.

(2.) In the case of new marks.

(i.) In class 5 for use only on fencing wire: *In re Jelley, Son, & Jones' Trade Mark*, Jessel, M.R., 1878, 51 L. J. Ch. 639; 46 L. T. N. S. 381.

(ii.) In class 5 for use only on corrugated galvanised iron sheets: *In re Braby & Co.'s Applications*, North, J., 1882, 21

Ch. D. 223; 51 L. J. Ch. 637; 46 L. T. N. S. 380; 30 W. R. 675. SECT. 72.

(iii.) In classes 5, 12, and 13 for use excepting in certain specified colonies: *In re Keep's Trade Mark*, Pearson, J., 1884, 26 Ch. D. 187; 50 L. T. N. S. 453; 32 W. R. 427.

The mode in which the subdivision was effected was by inserting on the register a note containing an undertaking restricting the user in the way desired: see sect. 62 (4), and *In re Rabone Bros.*, ubi supra, and *In re Mitchell's and Houghton and Hallmark's Trade Marks*, Chitty, J., 1885, 28 Ch. D. 666; 33 W. R. 408. Under Rule 32 it would seem that the Comptroller may now insert such a note without leave of the court provided he do not transgress the restriction on his authority contained in this section.

Three-mark Rule.—The registration of similar or identical marks for use in connection with goods in the same class has always been subject to the restriction that in no case whatever should the number registered exceed three: *In re Walkden Aerated Water Co.*, Jessel, M.R., 1877, 54 L. J. Ch. 394; *In re Jelley, Son, & Jones*, ubi supra; *In re Hargreave's Trade Mark*, Hall, V.-C., 1879, 11 Ch. D. 669; 27 W. R. 550.

In the case of old marks, the court adopted the course of allowing, where equally valid titles were shown, the registration of even identical marks up to the number of three for use on the same goods: *In re Jelley, Son, & Jones*, ubi supra; *In re Powell*, Jessel, M.R., 1878, Seb. Dig. No. 589.

But if it were found that more manufacturers than three were entitled to use the same old mark for goods in the same class, it was treated as common to the trade: *In re Jelley, Son, & Jones*, and *In re Walkden Aerated Water Co.*, ubi supra.

A similar test of what constitutes a common mark is adopted in sect. 74, excepting that the words "the same or a similar description of goods" are substituted for the words "the same goods or class of goods." Thus, it would seem, the new test is slightly less stringent.

In the case of new marks, a mark similar to one already on the register was only allowed to be registered for goods in the same class provided the goods and trades of the proprietors were sufficiently distinct for no confusion to take place: *In re Braby*

SECT. 72. *& Co.'s Applications*, *In re Jelley, Son, & Jones*, and *In re Hargreave's Trade Mark*, ubi supra.

Sometimes the consent of the proprietor of the registered mark was required: *In re Walkden Aerated Water Co.*, ubi supra.

And, provided this consent was obtained, the applicant for registration might apply *ex parte* to the court for registration subject to a restrictive note: *In re Keep's Trade Mark*, ubi supra.

In calculating the number of persons who have used a device, alleged to be common to the trade, cases will be taken into consideration in which devices substantially similar, though not identical, have been used; and also cases in which substantially similar devices have been used though never claimed as valid trade marks: *In re Wragg's Trade Mark*, Pearson, J., 1885, 54 L. J. Ch. 391; and *In re Walkden Aerated Water Co.*, ubi supra.

Calculated to Deceive.—It is for the court alone to decide on the question of similarity, and consequently registration may be granted or refused notwithstanding the decision of a foreign court (*In re Farina*, Hall, V.-C., 1879, 27 W. R. 456), or the contrary opinion of the Manchester Committee of Experts (*Orr-Ewing* v. *Registrar of Trade Marks*, H. L. 1879, 4 App. Cas. 479; 48 L. J. Ch. 707; 41 L. T. N. S. 239; 28 W. R. 17). In deciding this question the court will have before it the circumstance that the opinion of the committee was adverse to the claim of a trade mark; but this would be an opinion only and not a decision after hearing both sides, or rendered in any judicial proceeding: *per* Cairns, L.C., ibid.

The question, however, cannot be disposed of by simple inspection of the trade marks without considering whether, according to the understanding of the trade, the resemblance is such as to be calculated to cause deception: *Mitchell* v. *Henry*, C. A. 1880, 15 Ch. D. 181; 43 L. T. N. S. 186.

Consequently great weight will always be given to the opinion of the Committee of Experts, which, though not a judicial tribunal, is appointed to give an opinion upon technical matters peculiarly within the knowledge of its members: *Orr-Ewing* v. *Registrar of Trade Marks*, ubi supra.

Illustrative Cases.—(i.) A female hand pointing horizontally has been held too similar to a male hand pointing upwards: *Allsop* v. *Walker*, Jessel, M.R., 1877, Seb. Dig. No. 545.

(ii.) So too the letters "B. B. S." in italic characters with a crown, to the letters "B. B. H." in Roman characters with a crown also: *Barrows* v. *Pelsall Iron Co.*, Hall, V.-C., 1877, Seb. Dig. No. 530.

(iii.) Again, a mark consisting of a sprig of two roses and a twisted horn was considered too similar, especially when stamped upon metal, to a mark composed of a plain horn suspended by a looped cord: *In re Rosing*, C. A. 1878, Seb. Dig. No. 621.

(iv.) So a mark consisting of a pointer eating out of a porridge-pot is similar to a device consisting of a pointer standing at a point: *In re Jelley, Son, and Jones' Trade Mark*, Jessel, M.R., 1878, 51 L. J. Ch. 640; 46 L. T. N. S. 381.

Since a trade mark may be printed in any colour, in deciding a question of similarity the court will not take the difference of colour into consideration, but will merely compare the uncoloured diagrams: *Nuthall* v. *Vining*, C. A. 1880, 28 W. R. 330; and see sect. 67.

Consequently, when a registered mark consisted of a plain triangle coloured red, the registration of a device, consisting of a triangle with a conspicuous design of a church within it, was refused on the ground that if printed in a red colour it would be so similar to the mark already registered as to be calculated to deceive: *In re Worthington & Co.'s Trade Mark*, C. A. 1880, 14 Ch. D. 8; 49 L. J. Ch. 646; 42 L. T. N. S. 563; 28 W. R. 747.

In cases where a representation of a trade mark cannot be sent, and a specimen or copy is deposited under Rule 13 with the Comptroller, the above rule may possibly not be adopted, but difference of colour may be taken by the court into account in deciding whether marks are so similar as to be deceptive: see *In re Robinson's Trade Mark*, Jessel, M.R., 1880, 29 W. R. 31; and *Mitchell* v. *Henry*, ubi supra.

The degree of similarity which has been held to constitute infringement will be sufficient to render a mark incapable of registration, for the principles upon which the court proceeds have not been altered by the Registration Acts: see *Mitchell* v. *Henry*, supra; *In re Farina*, Hall, V.-C., 1879, 27 W. R. 456; and *per* Lord Blackburn, in *Orr-Ewing* v. *Registrar of Trade Marks*, H. L. 1879, 4 App. Cas. 479; 48 L. J. Ch. 707; 41 L. T. N. S. 239; 28 W. R. 17.

SECT. 72. In cases of infringement the test adopted has always been the probability of deception.

"In order to entitle a party to relief it is by no means necessary that there should be absolute identity. What decree of resemblance is necessary is, in the nature of things, a matter incapable of definition, *a priori*. All that the courts of justice can say, is that no trader can adopt a trade mark so resembling that of a rival as that ordinary purchasers, purchasing with ordinary caution, are likely to be misled. It would be a mistake, however, to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side. The rule so restricted would be of no practical use. If a purchaser, looking at the article offered to him, would naturally be led, from the mark impressed on it, to suppose it to be the production of a rival manufacturer, and would purchase it in that belief, the court considers the use of such a mark to be fraudulent:" *per* Cranworth, L.C., in *Seixo* v. *Provezende*, 1866, L. R. 1 Ch. 192; 14 L. T. N. S. 314; 14 W. R. 357. See also *per* Shadwell, V.-C., in *Ransome* v. *Benthall*, 1833, 3 L. J. Ch. 161; and in *Guinness* v. *Ullmer*, 1847, 10 L. T. 127; *per* Langdale, M.R., in *Perry* v *Truefitt*, 1842, 6 Beav. 66; 1 L. T. 384; and in *Croft* v. *Day*, infra; *per* Westbury, L.C., in *Hall* v. *Barrows*, 1863, 4 De G. J. & S. 150; 33 L. J. Ch. 204; 10 Jur. N. S. 55; 9 L. T. N. S. 561; 12 W. R. 322; and in *M'Andrew* v. *Bassett*, 1864, 4 De G. J. & S. 380; 33 L. J. Ch. 566; 10 Jur. N. S. 550; 10 L. T. N. S. 442; 12 W. R. 777; *per* Wood, V.-C., in *Blackwell* v. *Crabb*, 1867, 36 L. J. Ch. 504; *per* Lord Chelmsford, in *Wotherspoon* v. *Currie*, H. L. 1872, L. R. 5 H. L. 519; 42 L. J. Ch. 130; 27 L. T. N. S. 393.

By the Merchandise Marks Act, 1862, sect. 5, the probability of deception is also constituted the test of what degree of imitation amounts to forgery within that Act.

Illustrative Cases where infringement has been established:—(i.) "Day & Martin, 97 High Holborn," and "Day & Martin, 90½ Holborn Hill," in *Croft* v. *Day*, Langdale, M.R., 1843, 7 Beav. 84.

(ii.) "J. W. Taylor's Persian Thread," and "Sam. Taylor's Persian Thread," in *Taylor* v. *Taylor*, Wood, V.-C., 1854, 2 Eq. Rep. 290; 23 L. J. Ch. 255; 22 L. T. 271.

(iii.) "Anchor Brand Wire," and "Crown and Anchor Wire," with an anchor as a device in each case, in *Edelsten* v. *Edelsten*, Westbury, L.C., 1863, 1 De G. J. & S. 185; 9 Jur. N. S. 479; 7 L. T. N. S. 768; 11 W. R. 328.

(iv.) A crown and eagle and the letters "B. S." on a cask with a crown, "Seixo" and the date at the bunghole, and a crown with the letters "C. B." on a cask, and "Seixo de Cima," a crown and the date at the bunghole, in *Seixo* v. *Provezende*, supra.

(v.) Where the plaintiffs labelled their starch "Glenfield Starch," and the defendant, obtaining a factory at Glenfield, sold starch in packets upon which appeared the word "Glenfield," although his own name was also given in smaller type: *Wotherspoon* v. *Currie*, supra.

(vi.) A triangular ticket in green and gold, containing two elephants supporting a banner, with a crown between the elephants, and a similar ticket with a Hindoo elephant-headed goddess between the elephants in place of the crown: *Orr-Ewing* v. *Johnston*, H. L. 1882, 7 App. Cas. 219; 51 L. J. Ch. 797; 46 L. T. N. S. 216.

(vii.) "Holloway's Pills," with the address "244 Strand," and "H. Holloway's Pills," with the address "210 Strand," upon labels otherwise identical: *Holloway* v. *Holloway*, Langdale, M.R., 1850, 13 Beav. 209.

(viii.) Where the plaintiffs used a label with the words "Taylor & Co.," and the defendant adopted a similar label, adding merely the words, "T. Vick, from the late:" *Edelsten* v. *Vick*, Wood, V.-C., 1853, 11 Hare 78; 18 Jur. 7.

(ix.) Labels containing the words "Graduated, grooveless, drill-eyed, ground-down needles, invented and made solely by Shrimpton & Hooper at the Albion Needle-works, Studley," and similar labels, excepting that the words "Albion Needle-works" were omitted, and the words "Shrimpton Turvey" were substituted for "Shrimpton & Hooper:" *Shrimpton* v. *Laight*, Romilly, M.R., 1854, 18 Beav. 164.

(x.) A cross with the letters "C. B.," and a cross with the letters "C. S.:" *Cartier* v. *Carlile*, Romilly, M.R., 1862, 31 Beav. 292; 8 Jur. N. S. 183.

(xi.) A label containing the words "Stephens' Blue-Black Writing Fluid," and a similar label, except the substitution of

SECT. 73. "Steel Pens" for "Stephens:" *Stephens* v. *Peel*, Wood, V.-C., 1867, 16 L. T. N. S. 145.

(xii.) "Schweitzer's Cocoatina or Anti-Dyspeptic Cocoa, Registered," and "Otto Schweitzer, Atkins & Co.'s Cacaotine, Registered:" *Schweitzer* v. *Atkins*, Malins, V.-C., 1868, 37 L. J. Ch. 847; 19 L. T. N. S. 6; 16 W. R. 1080.

(xiii.) "Shrewsbury, Marshall, & Co., Patent Thread," and "Schrewsbury, Marchal, Patent Thread:" *Marshall* v. *Ross*, James, V.-C., 1869, L. R. 8 Eq. 651; 39 L. J. Ch. 225; 21 L. T. N. S. 260; 17 W. R. 1086.

(xiv.) "Apollinaris Water" and "London Apollinaris Water," although in other respects the labels were not similar: *Apollinaris Co.* v. *Norrish*, Bacon, V.-C., 1875, 33 L. T. N. S. 242.

(xv.) A label consisting of a bull-dog's head on a black ground surrounded by a circular band on which were the words "Read Brothers, London; the Bull-dog Bottling," and a label consisting of a rough terrier's head on a black ground, surrounded by a red circular band, on which were the words "Celebrated Terrier Bottling; E. Richardson:" *Read* v. *Richardson*, C. A., 1881, 45 L. T. N. S. 54. See also *Woollam* v. *Ratcliff*, Wood, V.-C., 1863, 1 H. & M. 259; *Browne* v. *Freeman*, Wood, V.-C., 1864, 12 W. R. 305; *Welch* v. *Knott*, Wood, V.-C., 1857, 4 K. & J. 747; 4 Jur. N. S. 330; *Harrison* v. *Taylor*, Wood, V.-C., 1865, 11 Jur. N. S. 408; *Standish* v. *Whitwell*, Wood, V.-C., 1866, 14 W. R. 512; *Cope* v. *Evans*, Hall, V.-C., 1874, L. R. 18 Eq. 138; 30 L. T. N. S. 292; 22 W. R. 453; *Mitchell* v. *Henry*, supra.

Further restriction on registration.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would, by reason of their being calculated to deceive, or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.

This section follows sect. 6 of the Act of 1875. See also sect. 86, which, however, so far as trade marks are concerned,

does not appear to extend this section, for a mark which is contrary to law and morality would be disentitled to protection in a court of justice.

A refusal by the Comptroller to register under this section or under sect. 86, is a refusal within sect. 62, and the appeal in the first place is to the Board of Trade: see notes to sect. 62 (4).

Calculated to Deceive.—A trade mark may be calculated to deceive in two ways—(i.) It may be similar to another trade mark, or (ii.) it may contain a misrepresentation, leading purchasers to believe that the goods to which it is affixed are other than they are. The first case comes within sect. 72, and the second kind of deceptiveness alone is dealt with here. In other words, the section has reference to deceptiveness inherent in the mark itself, and not to any question of comparison or similarity between two or more marks: *In re Horsburgh*, Jessel, M.R., 1878, 53 L. J. Ch. 237; 50 L. T. N. S. 23; 32 W. R. 530.

The principle upon which the courts refuse to assist a plaintiff himself guilty of misrepresentation has long been well established. "When the owner of a trade mark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not in his trade mark, or in his business connected with it, be himself guilty of any false or misleading representation:" *per* Westbury, L.C., in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1863, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 10 Jur. N. S. 81; 9 L. T. N. S. 558; 12 W. R. 289.

Illustrative Cases.—Where the plaintiff has been held disentitled to protection on the ground of his own misrepresentation.

(i.) The plaintiff sold tea in packets labelled "Howqua's Mixture," although the tea was neither grown nor sold by Howqua, a well-known merchant: *Pidding* v. *How*, Shadwell, V.-C., 1837, 8 Sim. 477; 6 L. J. Ch. 345.

(ii.) The plaintiff sold "Perry's Medicated Mexican Balm," but failed to obtain an injunction to restrain the sale of "Truefitt's Medicated Mexican Balm," because his show-cards contained representations that his mixture was made from a special recipe and of Mexican plants, which was not the fact: *Perry* v. *Truefitt*, Langdale, M.R., 1842, 6 Beav. 66; 1 L. T. 384.

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(iii.) The plaintiffs having succeeded to the business of J. R. & C. P. Crockett, used a stamp containing the words "J. R. & C. P. Crockett, Manufacturers" and "tanned, patented." They were refused protection on the ground that the stamp falsely represented that J. R. & C. P. Crockett were the actual existing makers of the goods, and that the goods were tanned and patented, which was not the case: *Leather Cloth Co.* v. *American Leather Cloth Co.*, Wood, V.-C., 1863, 1 H. & M. 271; 32 L. J. Ch. 721; 8 L. T. N. S. 829; 11 W. R. 931; Westbury, L.C., 1863, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 10 Jur. N. S. 81; 9 L. T. N. S. 558; 12 W. R. 289; H. L. 1865, 11 H. L. C. 523; 35 L. J. Ch. 53; 11 Jur. N. S. 513; 12 L. T. N. S. 742; 13 W. R. 873.

(iv.) Again, protection will be refused to a plaintiff who deals in a substance intended to be mixed with beer and represented to be an extract of hops: *Estcourt* v. *Estcourt Hop Essence Co.*, C. A. 1875, L. R. 10. Ch. 276; 44 L. J. Ch. 223; 32 L. T. N. S. 80; 23 W. R. 313.

The misrepresentation may, however, be so trifling and immaterial as not to disentitle the person making it to the protection of the court, as for instance the assumption of the title "Professor:" *Holloway* v. *Holloway*, Langdale, M.R., 1850, 13 Beav. 209; and the result will be the same if it is made only after the institution of the action: *Siegert* v. *Findlater*, Fry, J., 1878, 7 Ch. D. 801; 47 L. J. Ch. 233; 38 L. T. N. S. 349; 26 W. R. 459; or in collateral documents, as advertisements in newspapers, and not in the trade mark itself; *Ford* v. *Foster*, C. A. 1872, L. R. 7 Ch. 611; 41 L. J. Ch. 682; 27 L. T. N. S. 219; 20 W. R. 818; see, however, *Perry* v. *Truefitt*, ubi supra. The fact that the misrepresentation is so gross as to be absurd and unlikely to deceive a reasonable man will not exonerate the person making it: see *Leather Cloth Co.* v. *American Leather Cloth Co.*, supra.

To the above instances of misrepresentation there may be added:—

(i.) Names of makers or inventors which are "so completely personal as to import that the goods sold under them have been manufactured by particular individuals:" *per* Turner, L.J., in *Bury* v. *Bedford*, 1864, 4 De G. J. & S. 352; 33 L. J. Ch. 465; 10 Jur. N. S. 503; 10 L. T. N. S. 470; 12 W. R. 726.

Such names, however, may come to indicate only that the goods

are manufactured according to a particular process, in which case they will not necessarily convey a false impression when used by others who have acquired a knowledge of the process: *per* Westbury, L.C., in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1863, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 10 Jur. N. S. 81; 9 L. T. N. S. 558; 12 W. R. 289; and in *Hall* v. *Barrows*, 163, 4 De G. J. & S. 150; 33 L. J. Ch. 204; 10 Jur. N. S. 55; 9 L. T. N. S. 561; 12 W. R. 322.

See, in regard to such names becoming merely descriptive, notes to sect. 64 (3) and the cases there cited.

(ii.) Such geographical names as convey an indication of a source of production or supply which, if true, renders them merely descriptive, and, if false, makes them deceptive: see *Braham* v. *Beachim*, Fry, J., 1878, 7 Ch. D. 848; 47 L. J. Ch. 348; 38 L. T. N. S. 640; 26 W. R. 654; and *In re Saunion & Co.*, Jessel, M.R., 1878, Seb. Dig. No. 625, and notes to sect. 64 (3).

(iii.) The word "Patent," when used either after the expiration of the patent in such a manner as to indicate that the patent is still subsisting, or upon articles for which no patent has ever been granted: see notes to Merchandise Marks Act, 1862, sect. 7.

Sect. 105 of this Act provides further that any person who represents that any article sold by him is a patented article when no patent has been granted for the same, or describes any trade mark applied to any article sold by him as registered when it is not, shall be liable for every offence on summary conviction to a fine not exceeding five pounds. See also Instruction 30.

A similar penalty is imposed by the Merchandise Marks Act, 1862, upon any person who with intent to defraud shall mark or sell any article marked in such a way as falsely to indicate the place or country where it was made or produced, or shall place upon any article a mark falsely indicating that it is the subject of an existing patent, privilege, or copyright: see sects. 7 and 8 of that Act.

And by sect. 20 of the same Act any person who sells an article with, among other things, an indication upon it of the place or country where it was made or produced is to be deemed to warrant that the indication is true.

Saving for power to provide for

74. (1.) Nothing in this Act shall be construed to prevent the Comptroller entering on the register, in the

SECT. 74.

entry on register of common marks as additions to trade marks.

prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

(*a.*) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made;

(*b.*) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

(2.) The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five,

publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods. SECT. 74.

(1.)

This section is new, and qualifies sect. 64. It relates only to marks not already on the register, and simply means that the mere fact that a trade mark, comprising some of the essential particulars defined in sect. 64, comprises also a mark common to the trade, will not prevent its registration provided the common part be disclaimed.

The alteration of so much of a registered trade mark as is not an essential particular, is dealt with in sect. 92.

It is noticeable that in the case of new marks only words and combination of words which are common to the trade can be included in a trade mark, if registration be desired. This rule may be compared with sect. 64 (2). See Instruction 19.

"Prescribed" means prescribed by the schedules to, or rules under the Act: sect. 117. No "manner" nor "conditions" have been so prescribed. The old practice was to insert a note containing a disclaimer on the register, and now by Rule 32, the Comptroller may enter on the register such particulars as he may think necessary. The Board of Trade also is empowered, by sect. 62 (4), to order registration, subject to conditions.

(2.)

Disclaimers.—The practice of entering a note on the register containing a disclaimer of so much of a mark as was proved to be common to the trade, was adopted under the Act of 1875: see *In re Leonardt*, Jessel, M.R., 1878, Seb. Dig. No. 610; *In re Mitchell*, Jessel, M.R., 1878, W. N. 101; *In re Kuhn & Co.*, Jessel, M.R., 1878, 53 L. J. Ch. 238.

As to mode of disclaiming, see Instruction 19.

(3.)

Common Marks.—The following may be taken as instances of

SECT. 74. marks which have been found to be common to various trades since the passing of the Registration Acts :—

(i.) In the iron trades, a crown, a horse-shoe, and the words "Best," "Bloom," and "Plating;" *In re Barrows' Trade Mark*, C. A. 1877, 5 Ch. D. 364; 46 L. J. Ch. 725; 36 L. T. N. S. 780; 25 W. R. 564.

(ii.) On sealing-wax, the words "Bank of England:" *In re Hyde & Co.'s Trade Mark*, Jessel, M.R., 1878, 7 Ch. D. 724; 54 L. J. Ch. 395; 38 L. T. N. S. 777; 26 W. R. 625.

(iii.) In the steel pen trade, the words "Selected," "Improved," "Office," Commercial," &c.: *In re Leonardt*, *In re Mitchell*, and *In re Kuhn & Co.*, supra.

(iv.) In the tobacco trade, the letters "S. P.:" *Exp. Sales, Pollard & Co.*, Jessel, M.R., 1878, Seb. Dig. No. 620.

(v.) In the match trade, the term "Braided Fixed Stars:" *In re Palmer's Trade Mark*, C. A. 1883, 24 Ch. D. 504; 50 L. T. N. S. 30; 32 W. R. 306.

(vi.) In the mineral water trade, a device of a syphon: *In re Wragg's Trade Mark*, Pearson, J. 1885, 54 L. J. Ch. 391.

See also, as to names which have become descriptive in course of time, notes to sect. 64 (3.)

Three-Mark Rule.—Under the Act of 1875 the Registrar was forbidden to register substantially similar or identical trade marks in respect of the same goods or classes of goods. It was found, however, that in so many cases similar or identical marks were in use prior to the passing of the Act in connection with substantially similar goods, that a new arrangement was necessary. It was therefore held that in the case of old marks, even identical marks might be registered up to the number of three for use on identical goods: *In re Walkden Aerated Water Co.*, Jessel, M.R., 1877, 54 L. J. Ch. 394; *In re Jelley, Son, & Jones*, Jessel, M.R., 1878, 51 L. J. Ch. 639; 46 L. T. N. S. 381; *In re Powell*, Jessel, M.R., 1878, Seb. Dig. No. 589; see also note to sect. 72.

A mark which was found to be used in connection with goods of the same class by three or more persons was treated as common to the trade: ibid.

In calculating the number of persons who have used a device, alleged to be common to the trade, cases will be taken into consideration in which devices substantially similar, though not

identical, have been used; and also cases in which substantially similar devices have been used, though never claimed as valid trade marks: *In re Wragg's Trade Mark*, Pearson, J., 1885, 54 L. J. Ch. 391; *In re Walkden Aerated Water Co.*, Jessel, M.R., 1877, ibid.

The test now adopted of what constitutes a common mark is somewhat less stringent, for identically the same marks may, it seems, be registered even in excess of the number of three for goods which are in the same class, but are not the same, nor of the same description. In other words, there is now no restriction placed upon the number of similar or identical trade marks which may be registered for a class of goods, provided the goods themselves, in respect of which they are registered, are sufficiently distinct that no confusion is caused: see sect. 72, and *In re Braby & Co.'s Applications*, North, J., 1882, 21 Ch. D. 223; 51 L. J. Ch. 637; 46 L. T. N. S. 380; 30 W. R. 675.

It has been held that the books of the Registrar of Trade Marks which show that applications for the registration of particular marks have been refused, are not evidence that these marks have become common: *Orr-Ewing & Co.* v. *Johnston & Co.*, C. A. 1880, 13 Ch. D. 434; 42 L. T. N. S. 67; 28 W. R. 330.

But an earlier judicial decision that a term has become open to the trade is of course conclusive: *In re Anderson's Trade Mark*, Chitty, J., 1884, 26 Ch. D. 409; 53 L. J. Ch. 664; 32 W. R. 677.

Mere length of user will not of itself make a mark, which was originally a trade mark, *publici juris*, where such user was originally fraudulent, and is still calculated to deceive, but it throws upon the trader claiming an exclusive right to the mark the onus of proving such original fraud, and continuing misrepresentation, and the longer the user the stronger must be the evidence. Upon this principle an application to register, in combination with the name of the applicants, a foreign trade mark, which had been used by the applicants, and by thirty other firms in this country in combination with their own respective names, or with some device for fifty years, was refused upon the opposition of the foreign proprietor of the mark who had only recently discovered such user: *In re Heaton's Trade Mark*, Kay, J., 1884, 27 Ch. D. 570; 53 L. J. Ch. 959; 51 L. T. N. S. 220; 32 W. R. 951.

SECT. 75.

Effect of Registration.

Registration equivalent to public use.

75. Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.

This section is derived from sect. 2 of the Act of 1875. Prior to the Registration Acts a title to a trade mark could only be acquired by user upon or in connection with goods actually in the market: *M'Andrew* v. *Bassett*, Westbury, L.C., 1864, 4 De G. J. & S. 380; 33 L. J. Ch. 566; 10 Jur. N. S. 550; 10 L. T. N. S. 442; 12 W. R. 777. Length of user was wholly immaterial; it was only essential that the mark should actually be used upon a vendible article: *Hall* v. *Barrows*, Romilly, M.R., 1863, 32 L. J. Ch. 548; 9 Jur. N. S. 483; 8 L. T. N. S. 227; 11 W. R. 525; *Cope* v. *Evans*, Hall, V.-C., 1874, L. R. 18 Eq. 138; 30 L. T. N. S. 292; 22 W. R. 453. See notes to Merchandise Marks Act, 1862, sect. 1, and also sect. 64 of this Act.

This section "is for the benefit of those making new trade marks. As the law at present stands, if the mark be not already in use, and is sufficiently distinctive to distinguish the goods to which it is applied as being those of the person using it, the public use of the mark gives a property to it:" *per* Lord Blackburn in *Orr-Ewing* v. *Registrar of Trade Marks*, H. L. 1879, 4 App. Cas. 496; 48 L. J. Ch. 807; 41 L. T. N. S. 239; 28 W. R. 17.

By sect. 2 of the Act of 1875, registration was only equivalent to public user, provided there was a continuing connection of the trade mark with the goodwill of the business concerned in the goods for which it was originally registered.

Now by sect. 70 a trade mark is determinable with that goodwill; yet though no longer a trade mark it appears not to be removable from the register except on the application of the owner under sect. 91.

What will be the effect of a mark, which has ceased to be a trade mark, remaining on the register it is impossible to determine. Since it is no longer a trade mark within the meaning of the Act, neither this nor the succeeding section would appear to be applicable. Consequently it may perhaps be disregarded in practice, although present on the register.

SECT. 76.

Right of first proprietor to exclusive use of trade mark.

76. The registration of a person as proprietor of a trade mark shall be *primâ facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act.

This section follows sect. 3 of the Act of 1875. A mark which is not authorised to be registered as a trade mark, does not acquire the character of a trade mark by being on the register five years, and may be removed from the register though that period has elapsed: *In re Palmer's Applications*, C. A. 1882, 21 Ch. D. 53; 51 L. J. Ch. 673; 46 L. T. N. S. 787; *In re Leonard & Ellis' Trade Mark*, C. A. 1884, 26 Ch. D. 288; 53 L. J. Ch. 603; 51 L. T. N. S. 35; *In re Ralph's Trade Mark*, Pearson, J., 1884, 25 Ch. D. 194; 53 L. J. Ch. 188; 32 W. R. 168; 49 L. T. N. S. 504; *In re Wragg's Trade Mark*, Pearson, J., 1885, 54 L. J. Ch. 391; *In re Hyde's Trade Mark*, Jessel, M.R., 1878, 7 Ch. D. 742; 54 L. J. Ch. 395; 38 L. T. N. S. 777; 26 W. R. 625. And probably a person sued for infringing a trade mark that has been on the register upwards of five years, can defend himself on the ground that it should never have been registered: *In re Palmer's Application*, supra.

It has been definitely laid down that this section is qualified by sect. 90, and that consequently any person aggrieved within the meaning of sect. 90 by an entry on the register is not precluded by the expiration of five years from the date of such registration from showing that the mark ought not to have been registered: *In re Lloyd's Trade Mark*, Chitty, J., 1884, 27 Ch. D. 646; 54 L. J. Ch. 66.

It seems that conclusive evidence of right to the exclusive use of a trade mark is furnished by the expiration of five years from the registration, not of the trade mark itself, but of the person who claims the exclusive right. Consequently in the case of assignment or transmission, the benefit, in this respect, of registration does not apparently descend to the subsequent proprietor.

SECT. 77. There is no provision corresponding to sect. 4 of the Act of 1875, by which it was enacted that every proprietor registered in respect to a trade mark subsequently to the first registered proprietor shall, as respects his title to that trade mark, stand in the same position as if his title were a continuation of the title of the first registered proprietor. See, however, sect. 87.

The marginal note seems in conflict with the enactment. The word "first" therein was apparently borrowed without consideration from the Act of 1875.

Restrictions on actions for infringement, and on defence to action in certain cases.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The Comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

This section is derived from sect. 1 of the Act of 1875, as amended by the Acts of 1876 and 1877, but contains important modifications. Under the earliest Act a person was not entitled to institute proceedings to prevent the infringement of any trade mark as defined by the Act until, and unless, such trade mark was registered.

By the Act of 1876, the necessity for registration as a condition precedent to the institution of proceedings either to prevent, or to recover damages for infringement, was limited to the case of trade marks adopted since the commencement of the Act of 1875,

and it was provided that in respect of any device, mark, name, combination of words, or other matter or thing in use as a trade mark, before the passing of the Act of 1875, a certificate that registration had been refused should be sufficient to entitle the proprietor to institute proceedings, either to prevent infringement, or to recover damages.

The amendment introduced by the Act of 1876 was, as will be seen, of two kinds: "It renders registration a condition precedent to a proceeding to recover damages, as well as to a proceeding to prevent infringement; and it provides that if the proprietor of a trade mark in use before the passing of the principal Act has been refused registration, he may, notwithstanding such refusal, institute proceedings either for prevention of, or damages for the infringement of such trade mark, and need not wait till he has got the register rectified. . . . The effect of the Act of 1876 is that if one who says he is the proprietor of a trade mark (*i.e.*, a trade mark used before the passing of the Act of 1875), wishes to institute proceedings against some one who, as he says, is infringing it, he must first try to have his trade mark registered. If the registration is refused for any reason, he may apply to have the register rectified, and then the court will have to determine as the principal question whether the reason of the refusal was sufficient. But he may also seek for more speedy redress. He may obtain a certificate of the refusal and then institute proceedings to prevent infringement, and then the court will have to determine whether he was the proprietor of the trade mark, and in so doing will have incidentally to determine whether the reason of the refusal was sufficient; for he cannot obtain an injunction unless he proves, to the satisfaction of the court, that the alleged trade mark was 'a special or distinctive word or words, or combination of figures or letters used as a trade mark before the passing of the Act,' and that 'he was for the time being entitled to the exclusive use of such trade mark in accordance with law:'" *per* Lord Blackburn in *Orr-Ewing* v. *Registrar of Trade Marks*, H. L. 1879, 4 App. Cas. 479; 48 L. J. Ch. 707; 41 L. T. N. S. 239; 28 W. R. 17.

The effect of the new provision in this Act is as follows:—

(i.) Both new and old trade marks which are capable of registra-

SECT. 78. tion as coming within the definition contained in sect. 64, must be registered, or else proceedings cannot be taken.

(ii.) In the case of old marks which do not fulfil the conditions of sect. 64, application for registration must be made and a certificate of refusal obtained before action. To ascertain what is "any other trade mark" within the meaning of this section, recourse must be had to the case law preceding legislation on the subject. Two qualities must undoubtedly be present: (1.) the mark must be distinctive, and (2.) it must be actually in use upon or in connection with an article in the market: see notes to sect. 64, and to sect. 1 of the Merchandise Marks Act, 1862.

If these qualities are taken to be essential, a trade name which is "so appropriated by user as to come to mean the goods of a particular person, though it is not, and never was impressed on the goods or on the packages in which they are contained, so as to be a trade mark properly so called," will not be within the section, nor will a certificate of refusal be a necessary condition precedent to an action; see *Singer Manufacturing Co.* v. *Loog*, H. L. 1882, 8 App. Cas. 15; 52 L. J. Ch. 481; 31 W. R. 325.

(iii.) New marks incapable of registration as not coming within the definition of sect. 64, will receive protection as heretofore without the necessity of either registration, or a certificate of refusal. The definition is very wide, so there will probably not be many such.

As to the certificate of refusal to register, see Rule 57, and Form L, and Instructions 39–41. A stamp of £1 is impressed on the form of request: see First Schedule to the Act.

The certificate is admissible in evidence without proof: see sect. 96.

The latter part of the marginal note is at variance with the section.

As to the practice in proceedings for the prevention of, and recovery of damages for, infringement, see Merchandise Marks Act, 1862, sects. 21 and 22.

Register of Trade Marks.

Register of Trade Marks.

78. There shall be kept at the Patent Office a book called the Register of Trade Marks, wherein shall be

entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed. SECT. 79.

As to the entries to be made, see Rule 32.

As to the entry of orders of the court, see Rule 44, and as to the entry of assignments, see sect. 87, Form K, and Instruction 42. As to the alteration of the register, see sects. 91 and 92, and Rules 45–48.

As to the "Sheffield Register" for marks used on cutlery, and belonging to persons carrying on business in Hallamshire, or within six miles thereof, see sect. 81.

Removal of trade mark after fourteen years unless fee paid.

79. (1.) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the Comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the Comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

(2.) If such fee be not paid before the expiration of such fourteen years the Comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

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(3.) If before the expiration of the said three months the registered proprietor pays the said fee, together with the additional prescribed fee, the Comptroller may, without removing such trade mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4.) Where after the said three months a trade mark has been removed from the register for non-payment of the prescribed fee, the Comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee.

(5.) Where a trade mark has been removed from the register for non-payment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during the five years next after the date of such removal, be deemed to be a trade mark which is already registered.

This section is a re-enactment, with modifications, of Rules 29 and 30 of the Rules under the Act of 1875.

(1.)

The prescribed fee was formerly £2. It is now £1: see first schedule to the Rules.

(2.)

Where a trade mark is removed under this section, the Comptroller must enter in the register a record of such removal: see Rule 45.

(3.)

The additional fee was £1, it is now only 10s.: see first schedule to the Rules.

(4.)

The additional fee for the restoration of the trade mark when removed for non-payment of the fee is £1 : see First Schedule. SECT. 80.

(5.)

The meaning of this sub-section is that when a trade mark has been removed under this section, the Comptroller shall, until the expiration of five years, treat all applications for registration as though it were still on the register ; in other words, he will not be able to register for the same description of goods a mark so similar as to be calculated to deceive : see sect. 72.

The language of this sub-section is sufficiently wide to cover all cases of removal from the register, *e.g.*, under sect. 90 as well as under this section. Consequently a trader justly entitled to a trade mark, who has been anticipated in registration by another, should move under sect. 90 to rectify the register by the insertion of his name, and not by removal *in toto* of the trade mark, otherwise he will preclude himself from registering for five years. There seems no reason why this should not be done, since upon the original application all the necessary formalities will have been observed : *In re Rust & Co.*, Jessel, M.R., 1878, 44 L. T. N. S. 98 ; 29 W. R. 393 ; but see *Ex parte Lawrence Bros.*, Jessel, M.R., 1878, and *In re Farina's Trade Mark*, Jessel, M.R., 1881, ibid.; and *In re Meikle's Trade Mark*, Hall, V.-C., 1876, 24 W. R. 1067 ; and *Orr-Ewing* v. *Registrar of Trade Marks*, Hall, V.-C., 1879, 8 Ch. D. 798 ; 47 L. J. Ch. 180 ; 38 L. T. N. S. 313 ; 26 W. R. 259.

Fees.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade ; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct. Fees for registration, &c.

SECT. 81. By sect. 7 of the Act of 1875, the Lord Chancellor was empowered to make, with the assent of the Treasury, general rules as to fees. This power is now vested in the Board.

As to the fees now fixed by the Board of Trade, see Rule 3, and the first schedule to the Rules, and also Instruction 3. They will only be received in exchange for the stamped forms supplied by the Patent Office : see Instruction 2.

Sheffield Marks.

Registration by Cutlers' Company of Sheffield marks.

81. With respect to the Master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company), and the marks or devices (in this Act called Sheffield marks) assigned or registered by the Master, wardens, searchers, and assistants of that company, the following provisions shall have effect:

(1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield Register):

(2.) The Cutlers' Company shall enter in the Sheffield Register, in respect of cutlery, edge-tools, or raw steel and the goods mentioned in the next sub-section, all the trade marks entered before the commencement of this Act in respect of cutlery, edge-tools, or raw steel and such goods in the register established under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register,

in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act, 1875.

(3.) An application for registration of a trade mark used on cutlery, edge-tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company:

(4.) Every application so made to the Cutlers' Company shall be notified to the Comptroller in the prescribed manner, and unless the Comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5.) If the Comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the court.

SECT. 81.

(6.) Upon the registration of a trade mark in the Sheffield Register the Cutlers' Company shall give notice thereof to the Comptroller, who shall thereupon enter the mark in the Register of Trade Marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Comptroller on that day:

(7.) The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the Register of Trade Marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark, shall apply in the case of applications and registration in the Sheffield Register; and notice of every entry made in the Sheffield Register must be given to the Comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life-estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register:

(8.) Where the Comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for

registration of a trade mark used on cutlery, edge-tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company: SECT. 81.

(9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' Register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield Register, be deemed to have been abandoned:

(10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield Register as proprietor of two or more trade marks:

(11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield Register as proprietor of a trade mark or trade marks:

(12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the Comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the

SECT. 81.

Comptroller shall be subject to a further appeal to the court:

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield Register.

These are new provisions, and they differ materially from those of the Act of 1875.

(1.)

It is to be observed that an entirely new register is to be established in Sheffield, which in effect will comprise exact duplicates of the entries made in respect of the goods specified in sub-sect. 3 in the principal register. See sub-sect. 6.

(2.)

By the Act of 1875, sect. 9, the Cutlers' Company were bound to deliver to the registrar copies of all Sheffield corporate marks then in force, and also thereafter to notify to the registrar all applications for the registration of marks in respect of the specified goods. The registrar was also bound to inform them of similar applications made to him. Thus the register under the Act of 1875 contained in duplicate all the entries in the Sheffield Register.

The class of goods in respect of which marks are to be registered at Sheffield is considerably enlarged by sub-sect. 3.

The new Sheffield Registry will contain not only the marks registered in the previous one, and also registered in duplicate in

the general register established by the Act of 1875, but also all the marks contained in the latter register in respect of the goods now for the first time rendered registrable at Sheffield. SECT. 81.

It was held under the Act of 1875 that, where a corporate mark had been assigned, but had not been surrendered by the assignee to the Cutlers' Company, and re-assigned by them to him, he could not obtain registration until he had properly perfected his title: *In re Rabone & Co.*, Jessel, M.R., 1879, Seb. Dig. No. 643.

(3.)

It will be noticed that the class of goods in respect of which marks are to be registered in Sheffield is by this sub-section considerably enlarged. See Cutlers' Company Act, 1860, sect. 2.

Applications under this sub-section are to be made in duplicate, accompanied by the prescribed fees and representations: Rule 53, and Instruction 37.

As to the representations, see Rule 13; and as to the fees, see first schedule to the Rules, which are applicable to the registration of Sheffield marks: see sub-sect. 7 below. As to metal goods other than those here specified, see Instruction 14.

(4.)

Notice to the Comptroller is given by sending to him within seven days of the receipt of the application a copy of such application, together with two representations of the mark: Rule 54.

The Comptroller has to give notice of any objection within one month of the receipt by him of the notice. If he makes no objection the Cutlers' Company is to require the applicant to send him a wood block or electrotype of the mark, so that it may be advertised in the ordinary way, *i.e.*, in accordance with Rules 25–28: see Rule 55.

(5.)

It is noticeable that in case of objection by the Comptroller under this section there is no appeal to the Board of Trade as under sect. 62, but the application must be made direct to the court, presumably under sect. 90.

As to who is a person aggrieved, see sect. 90, although in this

SECT. 81. case it is difficult to conceive that any person other than the applicant can be aggrieved by the objection of the Comptroller to a mark.

(7.)

By Rule 56, the procedure upon application to register a Sheffield mark is to be similar to that adopted in London.

This rule, and the above sub-section, seem in contradiction to sub-sect. 5. Standing alone they would allow of an appeal to the Board of Trade against the refusal of the Comptroller to register, but this course is not contemplated by sub-sect. 5.

As to the assignment of trade marks and the restrictions thereon, see sect. 70.

(8.)

The manner prescribed is by sending to the Cutlers' Company a copy of the official paper (Rule 26) containing the application, with a note thereon distinguishing it; see Rule 55 (3).

The object of thus giving notice to the Cutlers' Company is to give them an opportunity of opposing the registration. When the Cutlers' Company opposed the registration of a trade mark for three classes on the ground that it so nearly resembled a Sheffield corporate mark many years previously assigned to another manufacturer and still used by him as to be calculated to deceive, and succeeded on appeal in their opposition in respect of two classes but abandoned it in respect of the third, the applicant for registration was ordered to pay the costs of the appeal, but no costs of the motion in the court below were given because he had virtually succeeded in obtaining registration of the mark for one class of goods: *In re Rosing*, 1878, C. A., Seb. Dig. No. 621.

(9.)

All trade marks entered before the commencement of this Act in respect of the specified goods are to be entered in the new Sheffield Register, so it is difficult to conceive that there will be any cases of abandonment.

(10.)

Since the provisions of the Act relating to applications for registration are to apply (see sub-sect. 7), registration of a series of marks will be permissible: see sect. 66. SECT. 82.

(11.)

An application may be made by one or more members of a firm or by the secretary of a body corporate: Rule 7.

A body corporate may also be registered as proprietor of an ordinary trade mark: Rule 39.

(12.)

Form of notice of appeal, see Form W, the fee being £1: see first schedule to the Rules.

There seems to be no appeal from the Comptroller to the Board of Trade: see sub-sect. 5.

It is presumed that the appeal to the court will be held to come with sect. 90, although that section does not appear to deal with the mere refusal to register a trade mark.

PART V.

GENERAL.

Patent Office, and proceedings thereat.

82. (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office. Patent Office.

(2.) Until a new Patent Office is provided, the offices of the Commissioners of Patents for Inventions and for the Registration of Designs and Trade Marks existing at

SECT. 83. the commencement of this Act shall be the Patent Office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the Comptroller-General of Patents, Designs, and Trade Marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the Comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

The present Patent Office is in Southampton Buildings. The Patent Office and the Comptroller take the place of the Registry Office and Registrar under the repealed Acts. See sect. 7 of the Act of 1875.

As to the sale of official publications, &c., see Instructions 1–6.

As to registration by the Cutlers' Company, see sect. 81, Rules 53–56, and Instructions 37. As to the Manchester office for facilitating the recording of trade marks used in respect of cotton goods, see Instruction 38.

Officers and clerks.

83. (1.) The Board of Trade may, at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the Comptroller-General of Patents, Designs, and Trade Marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses

of the execution of this Act shall be paid out of money provided by Parliament. SECTS. 84, 85.

The powers here given to the Board of Trade as to the appointment of officers, &c., were under sect. 7 of the Act of 1875 exercisable by the Lord Chancellor with the consent of the Treasury.

As to the Comptroller, see sect. 82. Anything directed by the Act to be done by or to him may in his absence be done by or to any person for the time being authorised by the Board.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence. Seal of Patent Office.

Copies of documents in the Patent Office and extracts from the registers purporting to be certified by the Comptroller and sealed by the official seal are admissible in evidence without further proof: see sect. 89.

85. There shall not be entered in any register kept under this Act, or be receivable by the Comptroller, any notice of any trust, expressed, implied, or constructive. Trust not to be entered in registers.

So far as this section refers to trade marks, it is a re-enactment of Rule 23 of the Rules of 1883, which itself was a reprint of Rule 22 of the Rules of 1876.

As to the general effect of such a provision as the above upon the rights of equitable assignees and mortgagees, see *Société Générale de Paris* v. *Tramways Union Co.*, C. A. 1884, 14 Q. B. D. 424;—a case dealing with the somewhat similar provision, in respect of share registers, contained in the Companies Act, 1862, 25 & 26 Vict., c. 89, s. 30.

In consequence of this enactment, when by agreement between two traders similar trade marks are registered in respect of the same description of goods, a note will be added to the register, not to the effect that the user has been restricted by agreement

SECTS. 86, 87. between the parties, but containing cross undertakings by the parties to use their trade marks only in the manner desired: *In re Mitchell and Houghton and Hallmark's Trade Marks*, Chitty, J., 1885, W. N., p. 42; S. C., Chitty, J., 1884, 28 Ch. D. 666; 33 W. R. 148, 408; *In re Rabone Bros.*, Jessel, M.R., 1879, Seb. Dig. No. 643.

Refusal to grant patent, &c., in certain cases.

86. The Comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

The Comptroller will not register the Royal Arms (except in the case of old marks) or the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To Counterfeit this is Forgery:" see Instruction 30.

The following also will not be registered as trade marks or prominent parts of trade marks unless in use before 1875:

Representations of her Majesty the Queen or of any member of the royal family.

Representations of the royal crown.

The national arms or flags of Great Britain.

By sect. 73, the Comptroller is prohibited from registering in combination with a mark any words the exclusive use of which would be deemed disentitled to protection in a court of justice, or any scandalous design.

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the Comptroller shall, on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the Register of Patents, Designs, or Trade Marks, as the case may be. The person for the time being entered in the Register

of Patents, Designs, or Trade Marks, as proprietor of a patent, copyright in a design, or trade mark, as the case may be, shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, license, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property. SECTS. 86, 87.

A trade mark may be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered : see sect. 70.

As to the mode of obtaining registration of an assignment, see Rules 34–38, Form K, and Instruction 42.

By sect. 4 of the Act of 1875 it was provided that every proprietor registered in respect of a trade mark subsequently to the first registered proprietor should, as respected his title to that mark, stand in the same position as if his title were a continuation of the title of the first registered proprietor. A re-enactment of this section was possibly considered unnecessary in consequence of the rights, conferred by registration, being given to every person registered as proprietor (see sect. 76, though the marginal note thereto seems in conflict with this view), and not merely to a person registered as the *first* proprietor (see sect. 3 of the Act of 1875).

The five years, however, which under sect. 76 afford conclusive evidence of exclusive right to a trade mark, date apparently from the registration not of the trade mark but of the name of the proprietor. Consequently a subsequent proprietor would seem to derive no benefit from the prior registration.

Licenses.—Since a trade mark can be used only in connection with the goodwill of the business concerned in the particular

SECT. 88. goods or classes of goods for which it has been registered (see sect. 70, *ante*), a license can be granted, if at all, only for use in such a business. And to avoid all imputation of fraud the trade mark should only be affixed to goods which are substantially the same as those sold by the licensor.

If the Comptroller refuse to register a person claiming a trade mark by assignment or transmission on the ground that he is not satisfied with the title shown or otherwise, the claimant's remedy is under sect. 90, as being a person aggrieved by the omission of his name from the register; see, however, *In re Ward, Sturt & Sharp's Trade Mark*, Hall, V.-C., 1881, 50 L. J. Ch. 347; 44 L. T. N. S. 97; 29 W. R. 395, which, owing to the difference between the phraseology used in the Act of 1875 and in sect. 90 of this Act, can scarcely be regarded any longer as a binding authority.

Before exercising the discretionary power here given to him adversely to the applicant, the Comptroller is bound to give him an opportunity of being heard personally or by an agent, and to give him ten days' notice of an appointment for the purpose: sect. 94, and Rules 17–19.

Inspection of and extracts from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

"Prescribed" means prescribed by general rules under the Act: see sect. 117. As to the prescribed regulations, see Rule 49. The fees for inspecting the register (1s. for every quarter of an hour) and for obtaining certified copies are prescribed in the first schedule to the Rules.

As to the seal of the Patent Office, see sect. 84. Sealed and certified copies are admissible in evidence without further proof: sect. 89.

Searches can be made on payment of a similar fee for trade marks in classes of textiles from class 23 to class 35 at the Manchester office: see Instruction 38.

There seems to be no provision in regard to searches in the Sheffield Registry: see sect. 81 (7), however.

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the Comptroller, and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

As to the seal of the Patent Office, see sect. 84.

As to the fees for obtaining copies, &c., see the first schedule to the Rules.

As to certificates under the hand of the Comptroller only, see sect. 96.

Rectification of registers by court.

90. (1.) The court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the court thinks fit; or the court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the court thinks fit.

(2.) The court may, in any proceeding under this section, decide any question that it may be necessary

SECT. 90. or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the court rectifying a register shall direct that due notice of the rectification be given to the Comptroller.

This is a re-enactment with modifications of sect. 5 of the Act of 1875.

(1.)

A "person aggrieved" is a term of wide import. There is no definition of the grievance contained in the Act. "It must be a legal grievance. It must be shown in some way that it tends to his (the applicant's) injury, or tends to damages in the legal sense of the word:" *per* Selborne, L.C., *In re Riviere's Trade Mark*, C. A. 1884, 26 Ch. D. 48; 53 L. J. Ch. 578; 32 W. R. 390. If this be shown the applicant is within the section. He need not be the registered proprietor of a trade mark, or even entitled to registration, nor, perhaps, need he carry on or intend to carry on business in the United Kingdom: ibid.

Illustrative Cases.—(i.) If a mere word not used as a trade mark before the Act of 1875 is registered, any dealer who has used the word in his trade, in connection with, or as descriptive of, an article in which he deals is a person aggrieved by the registration: *Rose* v. *Evans*, Hall, V.-C., 1879, 48 L. J. Ch. 618.

(ii.) In a case where the owner of a patented article, which had been exclusively manufactured by a licensee on payment of a royalty, registered the name of the article as a trade mark a year before the expiration of the patent, and then claimed the exclusive use of the name, it was held that the licensee who had exclusively manufactured the article during the continuance of the patent was a person aggrieved: *In re Ralph's Trade Mark*, Pearson, J., 1883, 25 Ch. D. 194; 53 L. J. Ch. 188; 49 L. T. N. S. 504; 32 W. R. 168.

(iii.) Consequently, any trader is aggrieved by the registration of a mark common to his trade: *In re Hyde & Co.'s Trade Mark*,

Jessel, M.R., 1878, 7 Ch. D. 724; 38 L. T. N. S. 777; 26 W. R. 625; *In re Mitchell's Trade Mark*, Jessel, M.R., 1878, W. N., p. 101; *In re Kuhn & Co.*, Jessel, M.R., 1878, 53 L. J. Ch. 238; *In re Palmer's Trade Mark*, C. A. 1882, 21 Ch. D. 47; 51 L. J. Ch. 673; 46 L. T. N. S. 787; *In re Wragg's Trade Mark*, Pearson, J., 1885, 54 L. J. Ch. 391.

(iv.) Or of a mark composed wholly or in part of a name which is merely descriptive of an article: *In re Brandreth's Trade Mark*, Jessel, M.R., 1878, 9 Ch. D. 618; 47 L. J. Ch. 816; 27 W. R. 281; Seb. Dig. No. 626; *In re Sannion & Co.*, Jessel, M.R., 1878, Seb. Dig. No. 625, and see notes to sect. 64 (3).

(v.) Or of a mark containing a name which has become merely descriptive, as, for instance, the name of a patented article after the expiration of a patent or of an article manufactured by a particular process which has become generally known and adopted: *In re Palmer's Trade Mark*, C. A. 1883, 24 Ch. D. 504; 50 L. T. N. S. 30; 32 W. R. 306; *In re Leonard & Ellis' Trade Mark*, C. A. 1884, 26 Ch. D. 288; 53 L. J. Ch. 603; 51 L. T. N. S. 35; *In re Ralph's Trade Mark*, supra; and see notes to sect. 64 (3).

(vi.) Where a wine merchant in Madras requested his shipper to register a trade mark for him in England, and the shipper registered it in his own name, the wine merchant, though not using the mark in England, was held aggrieved: *In re Riviere's Trade Mark*, supra.

(vii.) Where a servant unknown to his employers obtained registration of a trade mark which they used in their trade, they were sufficiently aggrieved to obtain its removal: *Ex parte Lawrence Bros.*, Jessel, M.R., 1878, 44 L. T. N. S. 98; 29 W. R. 392.

(viii.) Where a manufacturer had not registered his trade mark, nor used it for six years, he was yet considered not to have abandoned it, and to be aggrieved by the registration of a similar mark: *Mouson* v. *Boehm*, Chitty, J., 1884, 26 Ch. D. 398; 53 L. J. Ch. 932; 50 L. T. N. S. 784; 32 W. R. 612.

And it seems that a registered owner, finding he had registered a mark which from being common to the trade or from some other cause was a bad trade mark, was aggrieved within the meaning of the Act of 1875, and could move to expunge it or

SECT. 90. to vary the entry: *Ex parte Sales, Pollard & Co.*, Jessel, M.R., 1878, Seb. Dig. No. 620; *In re Lysaght*, Jessel, M.R., 1878, ibid. No. 623; *Ex parte Walker & Co.*, Malins, V.-C., 1878, ibid. No. 624. Henceforth he will proceed under sect. 91, *post*, when he desires cancellation. And analogously, where two manufacturers arranged that each of them should register the same trade mark, subject to restrictions as to user, and at the time of registration the restrictive notes were accidentally omitted, they were held to be persons aggrieved, and entitled to have the register rectified by the addition of the requisite notes: *In re Mitchell's and Houghton and Hallmark's Trade Marks*, Chitty, J., 1885, 28 Ch. D. 666; 33 W. R. 408.

Procedure.—It would appear that there are four cases of appeal from the decision of the Comptroller recognised by the Act:—

(i.) A refusal by the Comptroller to register a trade mark as being in contravention of sects. 72, 73, and 86, or Instructions 29–32. In this case, a right of appeal is given by sect. 62 to the Board of Trade, and the Board is empowered to refer the appeal to the court. It is open to argument whether the words "omission without sufficient cause of the name of any person from the register" in this section can be taken to cover such a refusal by the Comptroller to register a trade mark. They seem rather to point to a case where a trade mark is on the register, but is entered in the name of the wrong proprietor. If this is so, an applicant has no right of appeal to the court from the refusal of the Comptroller to register a mark, in the event of the Board declining to refer the case. If, on the other hand, the words are held to include such a refusal by the Comptroller, the express power given to the Board to refer an appeal appears to be nugatory, and further questions arise whether an applicant has the option of appealing either to the Board or to the court, and whether if, in exercise of this option, he appeal under sect. 62 to the Board, he can subsequently apply to the court if the Board refuse to refer the appeal.

(ii.) A refusal under sect. 72 by the Comptroller to register a trade mark owing to the opposition of a proprietor of a trade mark very similar to that sought to be registered. This case is dealt with in sect. 69 and Rule 29, and is altogether outside the above sect. 90.

(iii.) A refusal under sect. 71 of the applications of several persons who claim the same trade mark by conflicting titles. This case also is not within sect. 90, but is specially provided for by sect. 71 and Rule 42. If, however, the Comptroller selects one of the rival applicants for registration, the other applicant may, it would seem, apply to the court under this section as a "person aggrieved by the omission of his name." SECT. 90.

(iv.) A refusal by the Comptroller to rectify the register on the ground that such rectification is unnecessary, or in excess of the powers given to him by sect. 91. It is cases of this class which an application to the court under sect. 90 is more especially intended to remedy.

The Act of 1875, sect. 5, contained the words "if the registrar refuses to enter on the register as proprietor of a trade mark, the name of any person who is for the time being entitled to the exclusive use of such trade mark in accordance with the Act, or otherwise in accordance with law," which obviously included the case of mere refusal by the registrar to register. It was held under that section that upon application to the court owing to such refusal, "the first duty cast upon the court is to ascertain whether some one, or more than one, of the essential particulars of a trade mark as defined by the Act is found to exist, so that the mark may be described with one, or more than one, essential particular or particulars which distinguish it:" *per* Cairns, L.C., in *Orr-Ewing* v. *Registrar of Trade Marks*, H. L. 1879, 4 App. Cas. 479; 48 L. J. Ch. 707; 41 L. T. N. S. 239; 28 W. R. 17; and further, "that when the Court of Chancery is satisfied that the applicant is a person who is for the time being entitled to the exclusive use of a trade mark in accordance with law, and that the trade mark is one within the definition in the Act, the court is, *ex debito justitiæ*, to rectify the register, just as it would before the Act of 1875 have been bound *ex debito justitiæ*, on similar proof, to prevent any one infringing the trade mark shown to be his property: *per* Blackburn, L., ibid.

The procedure under the Act of 1875 was usually by motion, in accordance with Rule 43 of the Rules of 1876, even in cases where the person aggrieved did not himself seek registration, although it was held incidentally, in a case of opposition to registration, that the application to the court referred to in that rule was

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clearly an application by persons seeking to register: *In re Simpson, Davies & Sons' Trade Mark*, Jessel, M.R., 1880, 15 Ch. D. 525; 42 L. T. N. S. 675; 28 W. R. 760. The above seems to be the meaning of the judgment, but the report is somewhat confused.

It was customary to give to the Registrar two days' clear notice of the application, and to support the application by an affidavit of the person aggrieved, verifying the facts. No further evidence seems to have been required: *Ex parte Stephens*, Jessel, M.R., 1876, 24 W. R. 819.

Rectification will not, it seems, be granted in the absence of the registered proprietor, unless his consent be obtained: *In re Mitchell's Trade Mark*, Jessel, M.R., 1878, W. N., p. 101. But if his consent be first obtained, there seems no reason why the application should not be made *ex parte*: see *In re Keep's Trade Mark*, Pearson, J., 1884, 26 Ch. D. 187; 50 L. T. N. S. 453; 32 W. R. 427; and *In re Mitchell's, and Houghton and Hallmark's Trade Mark*, Chitty, J., 1884, W. N., p. 42; 33 W. R. 408.

If the registered owner of a trade mark goes into liquidation after notice has been given to him of an application to rectify the register, leave will be granted to serve the notice on the trustee in the liquidation: *In re Rowe's Trade Mark*, Chitty, J., 1882, 48 L. T. N. S. 388.

Where a person seeks to rectify the register, the *onus* is upon him to show that it ought to be rectified, but though his own evidence may be insufficient for the purpose, the *onus* is discharged if it appears from the evidence of the owner of the mark that the register ought to be rectified: *In re Leonard and Ellis' Trade Mark*, infra.

The application under this section will probably be by motion as under the Act of 1875, although there is no provision in regard to the practice contained in the Rules, *e.g.*, (i.) by the registered owner: *Ex parte Sales, Pollard & Co.*, Jessel, M.R., 1878, Seb. Dig. No. 620; *In re Lysaght*, Jessel, M.R., 1878, Seb. Dig. No. 623; *Ex parte Walker & Co.*, Malins, V.-C., 1878, Seb. Dig. No. 624; see sect. 9, as to the practice henceforward; or (ii.) by a person aggrieved: *In re Hyde & Co.'s Trade Mark*, Jessel, M.R., 1878, 7 Ch. D. 724; 38 L. T. N. S. 777; 26 W. R. 625; *In re Mitchell's Trade Mark*, Jessel, M.R., 1878, W. N., p. 101; *Ex parte Lawrence*

Bros., Jessel, M.R., 1878, 44 L. T. N. S. 98; 29 W. R. 392; *In re Kuhn & Co.*, Jessel, M.R., 1878, 53 L. J. Ch. 238; *In re Riviere's Trade Mark*, C. A. 1884, 26 Ch. D. 48; 53 L. J. Ch. 578; 32 W. R. 390; *Mouson* v. *Boehm*, Chitty, J., 1884, 53 L. J. Ch. 932; 50 L. T. N. S. 784; 32 W. R. 612; *In re Palmer's Trade Mark*, C. A. 1882, 21 Ch. D. 47; 51 L. J. Ch. 673; 46 L. T. N. S. 787; and C. A. 1883, 24 Ch. D. 504; 50 L. T. N. S. 30; 32 W. R. 306; *In re Ralph's Trade Mark*, Pearson, J., 1883, 25 Ch. D. 194; 53 L. J. Ch. 188; 49 L. T. N. S. 504; 32 W. R. 168; and *In re Leonard & Ellis' Trade Mark*, C. A. 1884, 26 Ch. D. 288; 53 L. J. Ch. 603; 51 L. T. N. S. 35; *In re Wragg's Trade Mark*, Pearson, J., 1885, 54 L. J. Ch. 391.

It is noticeable that when the Comptroller raises any objection to the registration of a mark in the Sheffield Registry, the appeal by a person aggrieved lies direct to the court, and not, as in the case of other trade marks, to the Board of Trade: see sect. 81 (5). But it is questionable whether such an appeal comes within this section: see, as to meaning of "omission of any name," supra.

Rectification.—Upon the suggested construction of this section it appears that the jurisdiction of the court to rectify the register arises:—

(i.) Upon the omission without sufficient cause of the name of any person from the register, but not upon the omission of a trade mark.

(ii.) Upon any entry being made improperly.

Cases of the omission of a name, although the trade mark is duly on the register, will occur:—

(i.) When the Comptroller, in the exercise of his discretion under sect. 71, registers one of two or more rival claimants to the same trade mark.

(ii.) When the Comptroller is dissatisfied with the title of an applicant claiming by assignment or transmission, and refuses to register him under sect. 87.

In the Act of 1875 the word "rectify" was used, and it was held that the term "rectification" is applicable only to cases in which there has been some mistake or error in the registration, and that consequently the court had no power to rectify in cases of transmission or assignment where no mistake or error was shown: *In re Ward, Sturt & Sharp's Trade Mark*, Hall, V.-C.,

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1881, 50 L. J. Ch. 347 ; 44 L. T. N. S. 97 ; 29 W. R. 395. In consequence of the altered wording of the new provision, this decision would appear to be no longer pertinent.

(iii.) When a trade mark has been registered in due course by an agent or by a single partner on behalf of his firm, and the person so registered subsequently refuses to assign the trade mark to those actually entitled : see *In re Riviere's Trade Mark*, C. A. 1884, 26 Ch. D. 48 ; 53 L. J. Ch. 578 ; 32 W. R. 390 ; *In re Rust & Co.'s Trade Mark*, Jessel, M.R., 1881, 44 L. T. N. S. 98; 29 W. R. 393 ; and *In re Farina's Trade Mark*, Jessel, M.R., 1881, ibid.

The right to the exclusive use of a trade mark after the expiration of five years from the date of registration, given by sect. 76 *ante*, is subject to and controlled by this section ; and therefore any person who considers himself aggrieved within the meaning of this section is not precluded by the expiration of five years from the date of the entry from showing that the entry should be rectified : *In re Lloyd's Trade Mark*, Chitty, J., 1884, 27 Ch. D. 646 ; 54 L. J. Ch. 66 ; *In re Palmer's Application*, C. A. 1882, 21 Ch. D. 47 ; 51 L. J. Ch. 673 ; 46 L. T. N. S. 787 ; *In re Leonard & Ellis' Trade Mark*, C. A. 1884, 26 Ch. D. 288 ; 53 L. J. Ch. 603; 51 L. T. N. S. 35; *In re Ralph's Trade Mark*, Pearson, J., 1883, 25 Ch. D. 194 ; 53 L. J. Ch. 188 ; 49 L. T. N. S. 504 ; 32 W. R. 168 ; *In re Wragg's Trade Mark*, Pearson, J., 1885, 54 L. J. Ch. 391.

Although the original application for registration of the mark was duly advertised, yet this fact alone will not prejudice the claim of a person who desires the rectification of the register. "There is no obligation to see the advertisement. It is as a precaution that the Act gives people an additional opportunity, besides looking at the register, of knowing what is going to be done. But if a person does not see the advertisement, he is in no worse position than he would have been before. He must use due diligence when the fact comes to his knowledge to remove the trade mark :" *per* Jessel, M.R., *In re Hyde & Co.'s Trade Mark*, 7 Ch. D. 724 ; 54 L. J. Ch. 395 ; 38 L. T. N. S. 777 ; 26 W. R. 625 ; see also *In re Meikle's Trade Mark*, Hall, V.-C., 1876, 24 W. R. 1067, and notes to sect. 68.

Rectification may be effected in three ways—By (i.) making (ii.) expunging, or (iii.) varying an entry. Of these the last is practically a combination of the other two. The principal entries in the register will consist of (1.) the trade mark; (2.) the name of the proprietor; (3.) the class and description of goods; (4.) the date of the application, and such other particulars as the Comptroller may think necessary: see Rule 32. SECT. 90.

(1.) Trade Mark:—(i.) As we have seen, the court under this section has apparently no jurisdiction to order the registration of a trade mark which the Comptroller in his discretion has refused. In the cases of opposition or of conflicting claims it is specially empowered by sect. 69 and Rule 29, and sect. 71 and Rule 42 respectively.

(ii.) The court has power to expunge an entry of a trade mark under this section on the application of a person aggrieved: see cases cited *supra*.

Under the Act of 1875 the court would make an order to this effect on the application also of a registered owner, but such an application seems no longer necessary: see sect. 91, empowering the Comptroller to cancel an entry on request of the registered owner: see *Ex parte Sales, Pollard & Co.*, Jessel, M.R., 1878, Seb. Dig. No. 620.

(iii.) Under this section, upon the application of a person aggrieved the court will give leave to alter a trade mark in any particular not being an essential particular within the meaning of sect. 64; *e.g.*, by inserting on the register a disclaimer of a common portion as defined in sect. 74: *In re Leonardt*, Jessel, M.R., 1878, Seb. Dig. No. 610; *In re Mitchell's Trade Mark*, Jessel, M.R., 1878, W. N., p. 101; *In re Kuhn & Co.'s Trade Mark*, Jessel, M.R., 1878, 53 L. J. Ch. 238.

A registered proprietor, however, seeking to make an alteration in his trade mark must proceed under sect. 92 and not under this section: see *Ex parte Walker & Co.*, Malins, V.-C., 1878, Seb. Dig. No. 624.

(2.) Name of the Proprietor:—The rectification of the entry of the proprietor's name will be effected (i.) when a name has been omitted without sufficient cause, as explained above; and (ii.) when a name has been entered without sufficient cause.

If mere cancellation is required by the registered owner, he

SECT. 90. should proceed under sect. 91, but an alteration, other than mere cancellation, of the name, can only be effected on an application to the court under this section.

Under the Act of 1875 it was held that when the original registration of a proprietor had been properly made, as would be the case when a name is omitted in the sense indicated above, the court could order one name to be substituted for another without further formalities being observed: *In re Rust & Co.'s Trade Mark*, Jessel, M.R., 1881, 44 L. T. N. S. 98; 29 W. R. 393. See *In re Farina's Trade Mark*, Jessel, M.R., 1881, ibid.

But if the original application was defective in some particulars, or a wrongful act from the beginning, the court would only order cancellation and direct the rightful owner to make a fresh application: *Ex parte Lawrence Bros.*, Jessel, M.R., 1878, 44 L. T. N. S. 98; 32 W. R. 392.

The ground of the distinction seems to have been that the word "rectification" implied that not a wrong but an error had been committed, and that consequently the power to "rectify" only arose where there had been a mistake in the registration: see *In re Ward, Sturt & Sharp's Trade Mark*, Hall, V.-C., 1881, 50 L. J. Ch. 347; 44 L. T. N. S. 97; 29 W. R. 395.

Now, however, that an express power to make an entry is given to the court, and the word "rectify," which was used in the Act of 1875, does not appear, it may be fairly presumed that, in all cases where the court can expunge an entry of a name, it has power also to substitute another name, provided the statutory formalities in regard to advertising, &c., were duly observed on the original application: see *Ex parte Lawrence Bros.*, supra; and *In re Hyde & Co.'s Trade Mark*, Jessel, M.R., 1879, 7 Ch. D. 724; 54 L. J. Ch. 395; 38 L. T. N. S. 777; 26 W. R. 625; and *In re Meikle's Trade Mark*, Hall, V.-C., 1876, 24 W. R. 1067.

It is to be noticed in this connection that by sect. 79 (5), where a trade mark has been removed from any cause whatever, such trade mark is, nevertheless, for the purpose of any application for registration during the five years next after the date of such removal, to be deemed to be still registered; consequently, the only safe course for a person aggrieved seems to be to ask, not for mere cancellation, but for the substitution of his own name for the name entered on the register without sufficient cause.

Otherwise he will be debarred for five years from registering his own mark. SECT. 90.

(3.) In respect of the remaining entries in the register it may be said generally that cancellation at the request of the registered proprietor may be effected under sect. 91, but rectification in any other manner or on the application of any other person can only be made by the court under this section.

Where two manufacturers agreed that each should register the same trade mark, subject in each case to a note restricting user, and such notes were accidentally omitted, an application by both parties under this section to rectify the register by adding the restrictive notes was successful: *In re Mitchell's and Houghton and Hallmark's Trade Marks*, Chitty, J., 1884, 28 Ch. D. 666; 33 W. R. 408.

As to the subdivision of classes see sect. 72, and as to the limitation of the user of trade marks by inserting a note on the register see sect. 62 (3).

Costs.—As a rule, costs will be given to the successful applicant for rectification; and this will be the case although he gives no notice to the registered proprietor of his intention to take action in the matter: *In re Kuhn & Co.'s Trade Mark*, Jessel, M.R., 1878, 53 L. J. Ch. 238; and although he offered no opposition to the original application, having overlooked the usual advertisements: *In re Hyde's Trade Mark*, Jessel, M.R., 1878, 7 Ch. D. 724; 38 L. T. N. S. 777; 26 W. R. 625; 54 L. J. Ch. 395.

The provision as to costs contained in this section applies presumably only to applications under the section, and not to applications to the court under sects. 69, 71, and 92.

In any event it does not appear to extend the general rule, that the costs of and incident to all proceedings in the Supreme Court are in the discretion of the court (Rules of Court, 1883, Order lxv. Rule 1), to costs incurred previous to the application: see *In re Brandreth's Trade Mark*, Jessel, M.R., 1878, 9 Ch. D. 618; 47 L. J. Ch. 816; 27 W. R. 281.

In all cases where the Comptroller appears his costs will have to be paid, but it is not apparent that service of the notice of motion on him is essential: *In re Riviere's Trade Mark*, Pearson, J., 1883, 26 Ch. D. 52; 53 L. J. Ch. 455; 49 L. T. N. S. 506; and see *In re Rotherham's Trade Mark*, C. A. 1880, 14 Ch. D. 585;

SECT. 91. 49 L. J. Ch. 513; 43 L. T. N. S. 1; *In re Maignen's Application*, Jessel, M.R., 1880, 28 W. R. 759.

(2.)

Damages.—This enactment is new. It is difficult to conceive of a case where damage can be shown excepting where there has been infringement. As to actions for damages generally, see notes to Merchandise Marks Act, 1862, sect. 22.

(3.)

As to notifying the Comptroller of an order of the court, see Rule 44 and Form N. He may advertise the order if he think fit: Rule 47.

Power for Comptroller to correct clerical errors.

91. The Comptroller may, on request in writing, accompanied by the prescribed fee,—

(*a.*) Correct any clerical error in or in connection with an application for a patent, or for registration of a design or trade mark; or

(*b.*) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade mark.

(*c.*) Cancel the entry or part of the entry of a trade mark on the register; provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

All documents and drawings for amending which there is no special provision may be amended by the Comptroller's leave (Rule 51), and in addition to the powers here given, the Comp-

troller is expressly empowered to alter the addresses of the proprietors in the register (Rule 46). SECT. 92.

(*a.*) As to Form of Request, see Form Q. The fee on request to alter a clerical error is 5s.: see first schedule to Rules.

(*b.*) See also Rule 46 and Form M.

(*c.*) For the form of application to cancel, see Form O, and of declaration to accompany it, see Form P. As to mode of making declarations, see Rule 58.

This section empowers the Comptroller to cancel an entry, or part of an entry, on the application of the registered proprietor. An alteration in the trade mark itself can only be effected under sect. 92.

Persons aggrieved by an entry can obtain the rectification of the register by its removal under sect. 90.

Under the Act of 1875 a trade mark would be removed by the court on an application by the registered proprietor: *Ex parte Sales, Pollard & Co.*, Jessel, M.R., Seb. Dig. No. 620.

And a trade mark registered in respect of all the goods in a class, might be limited, on the application of the registered proprietor, to certain specified goods only, by means of an addition to the entry in the register: *In re Lysaght*, Jessel, M.R., 1878, Seb. Dig. No. 623.

As such an alteration as this amounts to more than cancellation, an application to the court may still be necessary to effect it. This will be made under sect. 90, by motion: see *Ex parte Stephens*, Jessel, M.R., 1876, 24 W. R. 819.

The Comptroller and also the Board of Trade have, however, power in the case of new applications to register trade marks subject to such a condition: see sect. 62 (4), and Rule 32.

Alteration of registered mark.

92. (1.) The registered proprietor of any registered trade mark may apply to the court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the court may refuse or grant leave on such terms as it may think fit.

(2.) Notice of any intended application to the court

SECT. 93. under this section shall be given to the Comptroller by the applicant; and the Comptroller shall be entitled to be heard on the application.

(3.) If the court grants leave, the Comptroller shall, on proof thereof and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

This is practically a re-enactment of Rules 34 and 35 of the Rules of 1883.

As to what constitutes an essential particular, see sect. 64.

The application has usually been by motion. Under the Act of 1875, the address of the proprietor inserted in the trade mark was allowed to be changed: *Ex parte Walker & Co.*, Malins, V.-C., 1878, Seb. Dig. No. 624.

Notice must be given to the Comptroller fourteen days, at least, before the application: see Rule 48.

As to the mode of informing the Comptroller of the order, see Rule 44 and Form N.

Representations of the trade mark as altered must also be supplied: Rule 48. The fee for entering an alteration in the register is 10s.: see first schedule to the Rules.

The Comptroller may, if he think fit, make public the alteration in the register by advertisement or otherwise at the expense of the applicant: Rule 47.

As to the cancellation of an entry upon the application of the registered proprietor, see sect. 91, and upon the application of any person aggrieved, see sect. 90.

The costs of the Comptroller's appearance will have to be provided for: see *In re Maignen's Application*, Jessel, M.R., 1880, 28 W. R. 759; *In re Rotherham's Trade Mark*, C. A. 1880, 14 Ch. D. 585; 49 L. J. Ch. 513; 43 L. T. N. S. 1; *In re Riviere's Trade Mark*, Pearson, J., 1883, 26 Ch. D. 52; 53 L. J. Ch. 455; 49 L. T. N. S. 506.

Falsification of entries in register.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a

writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor. SECTS. 94, 95, 96.

This section is based on sect. 37 of the Patents Act of 1852 (15 & 16 Vict., c. 83), which, however, was only applicable to patents.

As to the punishment of a misdemeanor in the Isle of Man, see sect. 112.

94. Where any discretionary power is by this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent. Exercise of discretionary power by Comptroller.

As to the exercise of discretionary powers, see Rules 17–19.

95. The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter. Power of Comptroller to take directions of law officers.

"Law officer" means the Attorney-General or the Solicitor-General for England: sect. 117.

96. A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made Certificate of Comptroller to be evidence.

SECT. 97. thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

This is based on sect. 8 of the Act of 1875, which, however, provided that the certificate should be evidence, not *primâ facie* evidence merely.

The Comptroller is empowered (sect. 77) to grant a certificate of his refusal to register an old mark, if he is requested to do so (see Form L), and also on request (Forms R and S) to give a certificate of any entry, matter, or thing, which he is authorised to make or do, for the purpose of legal proceedings or other special purpose (Rule 57). See also Form T[1]. The Instructions (39) contemplate the giving of certificates of four kinds :—

(i.) For use in legal proceedings : Form S, fee 10s.

(ii.) For use in applying for registration in foreign countries : Form R, fee 5s.

(iii.) Of any application and proceedings : Form T[1], fee 5s.

(iv.) Of refusal to register an old mark : Form L, fee £1.

As to obtaining these forms and the payment of the fees, see Instructions 2 and 3.

Applications and notices by post.

97. (1.) Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

There is a similar provision in regard to the Rules: see Rule 16.

Provision as to days for leaving documents at office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day or days if two or more of them occur consecutively.

Declaration by infant, lunatic, &c.

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

SECTS. 100, 101. So far as this section has reference to trade marks, it is based upon Rule 67 of the Rules of 1883 made under the Act of 1875.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

This section is based upon 16 & 17 Vict., c. 115, sect. 5, which, however, was applicable to patents only; the language of the above section is wide enough to include designs and trade marks as well, but probably this is not intended.

In respect of trade marks in classes of textiles from class 23 to class 35, a branch office exists at Manchester where searches may be made: Instruction 38.

As to admission of certified copies of entries, &c., as evidence, see sect. 89.

Power for Board of Trade to

101. (1.) The Board of Trade may, from time to time, make such general rules and do such things as

they think expedient, subject to the provisions of this Act—

SECT. 101.

make general rules for classifying goods and regulating business of Patent Office.

(*a.*) For regulating the practice of registration under this Act:

(*b.*) For classifying goods for the purposes of designs and trade marks:

(*c.*) For making or requiring duplicates of specifications, amendment, drawings, and other documents.

(*d.*) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments, and other documents:

(*e.*) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

(*f.*) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad:

(*g.*) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.

(2.) Any of the forms in the first schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

(3.) General rules may be made under this section

SECT. 101. at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the Comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

Under the Act of 1875, sect. 7, the power of making rules was vested in the Lord Chancellor.

(1.)

(*a.*) Practice of registration: see Rules 7–16.
(*b.*) Classification of goods: see Rule 6 and third schedule.

(2.)

Form F in the schedule has been withdrawn and a new form substituted: see Rule 4 and the second schedule to the Rules.

(3.)

Commencement of the Act was Dec. 31, 1883: sect. 3.

SECTS. 102, 103.

(4.)

The annual reports of the Comptroller, which are to be laid before both Houses of Parliament, are to contain the general rules made during the preceding year: see sect. 102.

Annual reports of Comptroller.

102. The Comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

International and Colonial Arrangements.

International arrangements for protection of inventions, designs, and trade marks.

103. (1.) If her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have

SECT. 103. the same date as the date of the protection obtained in such foreign state.

Provided that his application is made, in the case of a patent, within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom, or the Isle of Man, during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark.

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: Provided that, in the case of trade marks, any

trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act: SECT. 103.

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which her Majesty shall from time to time, by Order in Council, declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

Prior to the Registration Acts, an alien could acquire such a right to the exclusive right of a trade mark as would entitle him to bring an action in England to prevent its infringement. "I apprehend that every subject of every country, not being an alien enemy—and even to an alien enemy the court has extended relief in cases of fraud—has a right to apply to this court, to have a fraudulent injury to his property arrested. And here the plaintiffs have the right—a right recognised, I imagine, everywhere in the world, or at least in every civilised community—of saying, We, being the manufacturers of certain goods, claim that another man shall not manufacture goods, and put upon them our trade mark, and then pass them off as manufactured by us:" *per* Wood, V.-C., 1857, *Collins Co.* v. *Cowen*, 3 K. & J. 428; 3 Jur. N. S. 929; 29 L. T. 245; 30 L. T. 62; 5 W. R. 676. See also *Collins Co.* v. *Reeves*, Stuart, V.-C., 1858, 28 L. J. Ch. 56; 4 Jur. N. S. 865; 33 L. T. 101; 6 W. R. 717; and see notes to the Merchandise Marks Act, 1862, sect. 1.

By Rule 5 of the Rules under the Act of 1875, it was provided that an alien could apply for the registration of a trade mark under that Act; but it appears that in order to succeed in his application it was essential that he should have used the trade mark in Great Britain, otherwise he could have acquired no property in it by common repute; mere user abroad would not suffice: *In re Leonard and Ellis' Trade Mark*, C. A. 1884, 26 Ch. D. 288; 53 L. J. Ch. 603; 51 L. T. N. S. 35; *In re Riviere's Trade Mark*, C. A. 1884, 26 Ch. D. 48; 53 L. J. Ch. 578; 50 L. T. N. S. 763;

SECT. 104. 32 W. R. 390; *In re Munch's Application*, Chitty, J., 1883, 50 L. T. N. S. 12; W. N., p. 170.

If the trade mark be in use in Great Britain, an alien owner may doubtlessly apply for its registration under this Act also in the ordinary way, being "a person claiming to be the proprietor" within the meaning of sect. 62; see also *Mouson* v. *Boehm*, Chitty, J., 1884, 26 Ch. D. 398; 53 L. J. Ch. 932; 50 L. T. N. S. 784; 32 W. R. 612.

If, however, there has been no user in this country, then an alien owner of a trade mark can only apply for registration under this Act, provided he has already applied for protection in a foreign state to which the above section 103 has, by Order in Council, been declared applicable. Then, it would appear from sub.-sect. 3, he is entitled to registration without going through the formality of the usual mode of application; but how otherwise he is to obtain registration does not appear.

Again, if protection has been applied for in a foreign state, with which an arrangement has been made for mutual protection, any person who has so applied is *ipso facto* entitled to registration under this Act, in priority to other applicants; and the registration is to date back to the time when protection was obtained in the foreign state. This provision, if taken literally, is calculated to work great injustice.

The whole section is so vague and confused that it is impossible to suggest what will be the construction ultimately placed upon it.

The section has been declared by Order in Council to be applicable to Belgium, Brazil, France, Guatemala, Italy, Netherlands, Portugal, Salvador, Servia, Spain, Switzerland, Ecuador, and Tunis, with which countries an arrangement for mutual protection has been made.

Provision for colonies and India.

104. (1.) Where it is made to appear to her Majesty that the Legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for her

Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to her Majesty in Council may seem fit, to such British possession. SECT. 105.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for her Majesty in Council to revoke any Order in Council made under this Act.

"British possession" means any territory or place situate within her Majesty's dominions not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man: see sect. 117.

Offences.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds. Penalty on falsely representing articles to be patented.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the

SECT. 106. article stamped, engraved, or impressed on, or otherwise applied to, the article.

This section follows sect. 7 of the Patents Act of 1835 (5 & 6 Will. IV., c. 83), as to patents; see sect. 11 of the Act of 1843 (6 & 7 Vict., c. 65) as to designs.

Sect. 7 of the Merchandise Marks Act, 1862 (25 & 26 Vict., c. 88), imposes a penalty of not more than £5 nor less than 10s. upon any one who shall untruly represent goods to be the subject of an existing patent, privilege, or copyright. A person himself wrongfully making use of the word "patent" in his trade mark, cannot take advantage of the Act, but if an article has been sold during the existence of a patent as a "patent" article, it may properly be sold as such even after the expiry of the patent: *Morgan* v. *M'Adam*, Wood, V.-C., 1866, 36 L. J. Ch. 228; 15 L. T. N. S. 348. And the same rule will possibly hold under this Act, for it is to be noticed that the words used are "when no patent has been granted for the same," which obviously do not cover the case of an expired patent. Care must, however, be taken, if the patent has expired, not to represent that it is subsisting; *Cheavin* v. *Walker*, C. A. 1877, 5 Ch. D. 850; 46 L. J. Ch. 686; 36 L. T. N. S. 938; see also *Edelsten* v. *Vick*, Wood, V.-C., 1853, 11 Hare 78; 18 Jur. 7; *Marshall* v. *Ross*, James, V.-C., 1869, L. R. 8 Eq. 651; 39 L. J. Ch. 225; 21 L. T. N. S. 260; 17 W. R. 1086. See notes to sect. 73, and to Merchandise Marks Act, 1862, sect. 7.

As to summary conviction in Scotland, see sect. 108; in the Isle of Man, see sect. 112; and in Ireland, see sect. 117.

Penalty on unauthorised assumption of royal arms.

106. Any person who, without the authority of her Majesty, or any of the royal family, or of any government department, assumes or uses in connection with any trade, business, calling, or profession, the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe

that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

As to summary conviction in Scotland, see sect. 108; in the Isle of Man, see sect. 112; and in Ireland, see sect. 117. The royal arms, or arms so nearly resembling them as to deceive, will not be registered as a new trade mark; see Instruction 30.

Scotland; Ireland; &c.

Saving for courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the court shall otherwise direct; but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts.

For the purposes of this section "court of appeal" shall mean any court to which such action is appealed.

Since the term "court of appeal" is not previously used in the section, the object of the last clause is not apparent. By sect. 111 the term "the court" as applied to Scotland is defined as any Lord Ordinary of the Court of Session, and the term "court of appeal" as either division of the said court.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

SECTS. 109, 110, 111.

It is an offence punishable on summary conviction for any person to describe a trade mark as registered which is not so (see sect. 105), or to assume without authority the royal arms in such a manner as to lead other persons to believe that he is carrying on his trade under such authority: sect. 106.

Proceedings for revocation of patent in Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

General saving for jurisdiction of courts.

111. (1.) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the court" shall mean any Lord Ordinary of the Court of Session, and the term "court of appeal" shall mean either division of the said court; and with reference to any such proceedings in Ireland, the

terms "the court" and "the court of appeal" respectively mean the High Court of Justice in Ireland and her Majesty's Court of Appeal in Ireland. SECT. 112.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the Comptroller, and he shall rectify the register accordingly.

"The court," as defined by this Act, means (subject to the provisions for Scotland, Ireland, and the Isle of Man) her Majesty's High Court of Justice in England: see sect. 117.

As to notification of orders to Comptroller, see Rule 44.

112. This Act shall extend to the Isle of Man, and— Isle of Man.

(1.) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those courts;

(2.) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of

SECT. 113. any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

It is a misdemeanor under the Act to make or to cause to be made a false entry in any register kept thereunder or a writing falsely purporting to be a copy of an entry in any such register: see sect. 93.

It is an offence punishable on summary conviction for any person to describe a trade mark as registered which is not so (see sect. 105), or to assume without authority the royal arms in such a manner as to lead other persons to believe that he is carrying on his trade under such authority: sect. 106.

Repeal; Transitional Provisions; Savings.

Repeal and saving for past operation of repealed enactments, &c.

113. The enactments described in the third schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(*a.*) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(*b.*) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(c.) Take away or abridge any protection or benefit in relation to any such action or proceeding. SECTS. 114, 115.

The date of the commencement of the Act is December 31, 1883 : see sect. 3.

The Register of Trade Marks kept under the Act of 1875, hereby repealed, is to be deemed part of the new register established under sect. 78.

114. (1.) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act. Former registers to be deemed continued.

(2.) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

The register of trade marks existing at the date of the passing of this Act was that established by sect. 1 of the Act of 1875 under the superintendence of the Commissioners of Patents.

As to registration under this Act see sect. 78, and Rules 30 *et seq.*

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, altered, or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal, alteration, or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, Saving for existing rules.

SECTS. 116, 117. so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

See Rule 60, which repeals all previous rules relating to trade marks.

Saving for prerogative.

116. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

General Definitions.

General definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,—

"Person" includes a body corporate:

"The court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) her Majesty's High Court of Justice in England:

"Law officer" means her Majesty's Attorney-General or Solicitor-General for England:

"The Treasury" means the Commissioners of Her Majesty's Treasury:

"Comptroller" means the Comptroller-General of Patents, Designs, and Trade Marks:

"Prescribed" means prescribed by any of the schedules to this Act, or by general rules under or within the meaning of this Act:

"British possession" means any territory or place situate within her Majesty's dominions, and not being or forming part of the United Kingdom, or of the

Channel Islands, or of the Isle of Man; and all territories and places under one Legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act: SECT. 117.

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local Legislatures as well as a central Legislature, means the central Legislature only.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

As to the meaning of "the court" in reference to Scotland and Ireland, see sect. 111.

SCHEDULES.

The First Schedule:—Forms of Application, &c.

N.B.—For the only form relating to trade marks, Form F in the second schedule to the Rules has been substituted: see Rule 4, *post.*

The Second Schedule:—Fees on Instruments for Obtaining Patents.

The Third Schedule:—Enactments Repealed (inter alia).

38 & 39 Vict., c. 91.—The Trade Marks Registration Act, 1875.

39 & 40 Vict., c. 33.—The Trade Marks Registration Amendment Act, 1876.

40 & 41 Vict., c. 37.—The Trade Marks Registration Extension Act, 1877.

TRADE MARKS RULES, 1883.

By virtue of the provisions of the Patents, Designs, and Trade Marks Act, 1883, the Board of Trade do hereby make the following Rules:—

Preliminary.

1. These Rules may be cited as the Trade Marks Rules, 1883, and shall come into operation from and immediately after the 31st day of December 1883.

These Rules are made by the Board of Trade under sect. 101 of the Act. Under the Act of 1875 the Lord Chancellor, with the assent of the Treasury, was authorised to make general rules. They are now wholly repealed: see Rule 60.

Interpretation.

Interpretation.

2. In the construction of these Rules any words herein used, defined by the said Act, shall have the meanings thereby assigned to them respectively.

See, for interpretation of terms, sect. 117 of the Act.

Fees.

Fees.

3. The fees to be paid in pursuance of the said Act,

so far as it relates to trade marks, shall be the fees specified in the first schedule hereto.

See sect. 80 of the Act. The fees are payable only by means of impressed stamps on the various authorised forms: see Instruction 2.

Forms.

Forms. 4. The Form F in the first schedule to the said Act shall be altered or amended by the substitution therefor of the Form F in the second schedule to these Rules.

Form F in the schedule to the Act was withdrawn in pursuance of sect. 62.

5. (1.) An application for registration of a trade mark shall be made in the Form F in the second schedule to these Rules. (2.) The remaining forms in such schedule may be used in all cases to which they are applicable.

As to the forms and the places where they may be obtained, see Instruction 3. It would seem that the use of these forms is obligatory, for payment of the fees will be accepted only in the stamps impressed upon them: see Instructions 2 and 36.

Classification of Goods.

Classification of goods. 6. For the purposes of trade marks registration and of these Rules, goods are classified in the manner appearing in the third schedule hereto.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Comptroller.

See sect. 65 of the Act. A guide to the classification of goods is furnished at the Patent Office: see Instruction 20.

The object of the classification of the kind adopted is not very apparent, seeing that the subdivision of classes is permissible, and the existing restriction on registration consists of a prohibition against the registration of identical or similar marks, not in respect of the same class of goods, but only in respect of the same goods or description of goods: see sect. 72.

Application for Registration.

Application by firm.

7. An application for registration of a trade mark, if made by any firm or partnership, may be signed by some one or more members of such firm or partnership, as the case may be.

If the application be made by a body corporate it may be signed by the secretary or other principal officer of such body corporate.

As to applications generally, see sect. 62, and Instructions 8–20. For form of application see Form F in the second schedule.

A separate application form is required for each class: Instruction 10. As to applications by a firm or company, see Instruction 11.

Agency.

8. An application for registration and all other communications between the applicant and the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller.

An agent signing an application should add the description "agent:" Instruction 12.

Acknowledgment of application.

9. On receipt of the application the Comptroller shall furnish the applicant with an acknowledgment thereof.

Contents of form of application.

10. Where application is made to register a trade mark which was used by the applicant or his predecessors in business before the 13th of August 1875, the application shall contain a statement of the time during which and of the person by whom it has been so used in respect of the goods mentioned in the application.

As to the advantages pertaining to an application for registration of an old mark, see sects. 64 and 72. A statutory declaration of the length of user is no longer necessary.

Size, &c., of documents.

11. Subject to any other directions that may be given by the Comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed, or other documents required by the said Act or by these Rules to be left with or sent to the Comptroller or to the Cutlers' Company, shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

As to Cutlers' Company, see sect. 81 and Rules 53–56 and Instruction 37.

Qualification of metal goods.

12. In the case of an application for the registration of a trade mark used on any metal goods, other than cutlery, edge-tools, and raw steel, the applicant shall state in the specification of goods in the form of application of what metal or metals the goods in respect to which he applies are made.

See also Instruction 14.

Representations of trade mark.

13. Subject to any other directions that may be given by the Comptroller, three representations of each trade mark, except in the case of marks applied for in classes 23 to 35 inclusive, must be supplied upon paper of the size aforesaid, and must be of a durable nature. One of such representations must be made upon or affixed to the form of application, the others upon separate half-sheets. In the case of trade marks exceeding the limits of the foolscap paper of the size aforesaid, such marks may be pasted and folded upon the sheets of foolscap.

In the case of marks applied for in classes 23 to 35 inclusive, the applicant shall supply four representations of each mark for each class.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as the Comptroller may think most convenient.

The Comptroller may, if dissatisfied with the representation of a trade mark, require a fresh representation, either before he proceeds with the application or before he registers the trade mark.

The Comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may think fit.

As to representations, see Instructions 13, 16, and 17.

Four representations are required in the textile classes, so that one of them may be exhibited at Manchester: Instruction 38.

One representation is affixed to the form of application (Form F), and the additional representations to separate sheets of paper (Form G).

Representations of a series of trade marks.

14. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in sect. 66 of the said Act, a representation of each trade mark of the series shall be made or affixed upon the form of application, and also upon each of the separate half-sheets of paper aforesaid.

As to a series, see Instruction 18 and Rule 28.

Translation of foreign characters.

15. Wherever a mark consists of or includes words printed in other than Roman character, there shall be given at the foot or on the back of each representation a translation of such words, signed by the applicant or his agent.

See Instruction 15, and *In re Rotherham's Trade Mark*, C. A. 1880, 14 Ch. D. 585; 49 L. J. Ch. 513; 43 L. T. N. S. 1.

Mode of sending notices, &c.

16. Any application, statement, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Communications relating to different applications should be made in different letters: see Instruction 8. Compare sect. 97, and see Instruction 1.

Exercise of Discretionary Powers.

Hearing by Comptroller.

17. Before exercising any discretionary power given to the Comptroller by the said Act adversely to the applicant for registration of a trade mark, the Comptroller shall give him ten days' notice of the time when he may be heard personally or by his agent before the Comptroller.

See sect. 94. As to meaning of "applicant" here, see Rule 40.

Notice of wish to be heard before Comptroller.

18. Within five days from the date when such notice would be delivered in the ordinary course of post, the applicant shall notify to the Comptroller whether or not he intends to be heard upon the matter.

Notification of decision.

19. The decision of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant.

Appeal to the Board of Trade.

Appeal to Board of Trade.

20. Where the Comptroller refuses to register a trade mark, and the applicant intends to appeal to

the Board of Trade from such refusal, he shall, within one month from the date of the decision appealed against, leave at the Patent Office, Trade Marks Branch, a notice of such his intention.

See sect. 62.

Statement of grounds of appeal.

21. Such notice shall be accompanied by a statement of the grounds of appeal, and of the applicant's case in support thereof.

For form of appeal see Form H in second schedule.

Copy of notice to Board of Trade.

22. The applicant shall forthwith, on leaving such notice, send a copy thereof to the secretary of the Board of Trade, No. 7 Whitehall Gardens, London.

Directions by Board.

23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the court to hear and determine the same.

As to procedure, see notes to sects. 62 and 90.

Notice of time of hearing.

24. Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the Comptroller and the applicant.

Advertisement of Application.

Advertisement of application.

25. Every application shall be advertised by the Comptroller in the official paper, during such times, and in such manner, as the Comptroller may direct.

If no representation of the trade mark be inserted in the official paper in connection with the advertisement of an application, the Comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trade mark is deposited for exhibition.

As to advertisements, see Instructions 21 to 28. The Comptroller is bound to advertise at once on receiving the application: sect. 68.

Definition of official paper.

26. The official paper for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.

Means of advertising trade mark to be supplied to official paper.

27. For the purposes of such advertisement the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of the trade mark, of such dimensions as may from time to time be directed by the Comptroller, or with such other information or means of advertising the trade mark as may be required by the Comptroller; and the Comptroller, if dissatisfied with the block or electrotype furnished by the applicant or his agent,

may require a fresh block or electrotype before proceeding with the advertisement.

In classes 23, 24, and 25, no blocks are required: Instruction 22. As to wood blocks and electrotypes to be supplied, see further Instructions 22–28.

Advertisement of series.

28. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in sect. 66 of the said Act, the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of any or of each of the trade marks constituting the series; and the Comptroller may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another.

See Instruction 23. As to representations of a series, see Rule 14.

Opposition to Registration.

Manner of bringing case before court.

29. (1.) Where a case stands for the determination of the court, under the provisions of sect. 69 of the said Act, the Comptroller shall require the applicant within one month, or such further time as the Comptroller may allow, to issue a summons in the chambers of a judge of her Majesty's High Court of Justice for an order that, notwithstanding the opposition of which notice has been given, the registration of the trade mark be proceeded with by the Comptroller, or to take such other proceedings as may be proper and necessary for the determination of the case by the court.

(2.) The applicant shall thereupon issue such summons, or take such other proceedings as aforesaid, within the period of one month above named, or such further time as the Comptroller may allow, and shall also within the like period give notice thereof to the Comptroller.

(3.) If the applicant shall fail to issue such summons, or to take such other proceedings, of which failure the non-receipt by the Comptroller of the said notice shall be sufficient proof, the applicant shall be deemed to have abandoned his application.

Mode of giving notice that the matter has been brought before the court.

(4.) Such notice to the Comptroller shall be given by delivering at or sending to the Patent Office a copy of the summons or other initiatory proceeding bearing an endorsement of service signed by the applicant or his solicitor, or an endorsement of acceptance of service signed by the opponent or his solicitor.

As to procedure in cases of opposition see notes to sect. 69, and for forms of counter-statement and bond see Instruction 33. The applicant for registration will be afforded an opportunity of objecting to the solvency of the security: Instruction 34. The case stands for the determination of the court only when security has been given: *In re Brandreth's Trade Mark*, Jessel, M.R., 1878, 9 Ch. D. 618; 47 L. J. Ch. 816; 27 W. R. 281. As to form of notice of opposition, see Form J in the second schedule.

Register of Trade Marks.

Time of registration of trade marks.

30. As soon as may be after the expiration of two months from the date of the first advertisement of the application, the Comptroller shall, subject to any such

summons or other proceeding as aforesaid and the determination of the court thereon, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee, enter the name, address, and description of the applicant in the Register of Trade Marks as the registered proprietor of the trade mark in respect of the particular goods or classes of goods described in his application.

The fee is £1 : see first schedule. It is payable only by the stamp impressed on Form L : see Instruction 36.

Where applicant dies before registration, the trade mark may be registered for successor to goodwill of business.

31. In case of the death of any applicant for a trade mark after the date of his application, and before the trade mark applied for has been entered on the register, the Comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the Comptroller.

Entries to be made in register.

32. Upon registering any trade mark the Comptroller shall enter in the register the date on which the application for registration was received by the Comptroller (which day shall be deemed to be the date of the registration), and such other particulars as he may think necessary.

As to registration subject to a note containing limitations as to user, see sect. 62 (4). This rule appears to empower the Comptroller to add such a note.

Notice of registration.

33. The Comptroller shall send notice to the applicant of the registration of his trade mark, together with a reference to the advertisement of such trade mark in the official paper.

Request by subsequent proprietor.

34. Where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, a request for the entry of his name in the register as proprietor of the trade mark shall be addressed to the Comptroller, and left at the Patent Office.

For form of request and declaration see Form K in the second schedule. The fee is £1 : see first schedule and Instructions 3 and 42.

Signature of request.

35. Such request shall in the case of an individual be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or more members of such firm or partnership, or in either case by his or their agent respectively duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorised in like manner.

Compare Rules 7 and 8.

Contents of request.

36. Every such request shall state the name, address, and description of the person claiming to be entitled to the trade mark (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor,

so as to show the manner in which, and the person or persons to whom, the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade mark has been registered.

As to connection with goodwill, see sect. 70.

Declaration to accompany request.

37. Every such request shall be accompanied by a statutory declaration to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade mark as claimed by such request.

For declaration see Form K in the second schedule.

Further proof of title if required.

38. The claimant shall furnish to the Comptroller such other proof of title and of the existence and ownership of such goodwill as aforesaid as he may require for his satisfaction.

Body corporate.

39. A body corporate may be registered as proprietor by its corporate name.

Definition of applicant.

40. The term "applicant" in Rules 17, 18, and 19 shall include each of several persons claiming to be registered as proprietor of the same trade mark.

As to conflicting claims to the same mark, see sect. 71 and Rules 42 and 43.

Comptroller may require statement from rival claimants.

41. Whether all of such persons so claiming require to be heard before the Comptroller or not, he may, before exercising the discretion vested in him by section 71 of the said Act, require such persons, or any or either of them, to submit a statement in writing within a time to be notified by him, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

Submission to court of conflicting claims.

42. Where each of several persons claims to be registered as proprietor of the same trade mark, and the Comptroller refuses to register any of them until their rights have been determined according to law, the manner in which the rights of such claimants may be submitted to the court by the Comptroller, or, if the Comptroller so require, by the claimants, shall, unless the court otherwise order, be by a special case; and such special case shall be filed and proceeded with in like manner as any other special case submitted to the court, or in such other manner as the court may direct.

As to procedure, see notes to sect. 71.

Settlement of special case.

43. Where the special case is to be submitted to the parties it may be agreed to by them, or if they differ, may be settled by the Comptroller on payment of the prescribed fees.

The form of application to the Comptroller to settle a special case is Form T. The fee, payable only by the stamp impressed thereon, is £2: see first schedule, and Instructions 2, 3, and 36.

44. Where an order has been made by the court in either of the following cases, viz.:

(*a.*) Allowing an appeal under section 62 of the said Act;

(*b.*) Disallowing an opposition to registration under section 69; or,

(*c.*) Under the provisions of sections 72, 90, or 92 of the said Act,

the person in whose favour such order has been made, or such one of them, if more than one, as the Comptroller may direct, shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the register, as the case may be.

The notice of an order is to be given in Form N, the fee being 10s.: see first schedule, and Instructions 2, 3, and 36.

45. Where a trade mark has been removed from the register for non-payment of the prescribed fee or otherwise, under the provisions of section 79 of the said Act, the Comptroller shall cause to be entered in the register a record of such removal and the cause thereof. Removal of mark from register.

Although removed, the mark is, for the purpose of any application made during the five years next after the date of removal, to be deemed still registered: see sect. 79 (5). And as to the effect of this see notes to sects. 72 and 90.

46. If the registered proprietor of a trade mark send to the Comptroller, together with the prescribed Alteration of address in register.

fee, notice of an alteration in his address, the Comptroller shall alter the register accordingly.

The notice is to be given on Form M, and the fee is 5s.: see first schedule and Instructions 2, 3, 35, and 36.

The empowering section is sect. 91.

Publication of rectification or variation of register.

47. Whenever an order is made by the court for making, expunging, or varying an entry from or in the register, the Comptroller shall, if he thinks that such rectification or variation should be made public, and at the expense of the person applying for the same, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the register.

Notice to Comptroller of order of court for alteration of trade mark under sect. 92 of Act.

48. Whenever the registered proprietor of any trade mark intends to apply for the leave of the court to add to or to alter such trade mark, under section 92 of the said Act, the notice to be given to the Comptroller shall be given fourteen days at least before such application. If leave be granted on such application the applicant shall forthwith supply to the Comptroller such a number of representations of the trade mark as altered as he may deem sufficient.

The marginal note seems in conflict with the rule. The notice referred to is not the notice of the order (see Rule 44), but the notice of the application to the court: see sect. 92 (2). No form of this latter notice is given, but any intimation sent by post will doubtlessly be sufficient: see sect. 97, and Rule 16.

Inspection of Register.

49. The Register of Trade Marks shall be open to the inspection of the public, on payment of the prescribed fee, on every week-day between the hours of ten and four, except on the days and at the times following:— Hours of inspection.

(*a.*) Christmas Day, Good Friday, the day observed as her Majesty's birthday, days observed as days of public fast and thanksgiving, and days observed as holidays at the Bank of England; or

(*b.*) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

(*c.*) Times when the register is required for any purpose of official use.

See sect. 88. The fee is 1s. for each quarter of an hour: see first schedule.

Power to Dispense with Evidence.

50. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign Dispensing with evidence.

such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

Amendments.

Amendment of documents.

51. Any document or drawing or other representation of a trade mark for the amending of which no special provision is made by the said Act, may be amended, and any irregularity in procedure which in the opinion of the Comptroller may be obviated without detriment to the interests of any person may be corrected, if the Comptroller think fit, and on such terms as he may direct.

The Comptroller has power to correct clerical errors under sect. 91 (see also Form Q), and also to alter addresses in the Register: Rule 16 and Form M.

Enlargement of Time.

Comptroller may enlarge time.

52. The time prescribed by these rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Cutlers' Company.

Sheffield applications in duplicate.

53. All applications to the Cutlers' Company for registration of a trade mark, under section 81 of the said Act, shall be in duplicate, accompanied by the prescribed fees and representations.

The mode of application and the fees payable are the same as in an ordinary case: see Rule 56 and Instruction 37.

As to the Cutlers' Company generally, see sect. 81. As to applications in respect of metal goods other than those specified in sect. 81 (3), see Instruction 14.

Notice to Comptroller.

54. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade mark, send the Comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Time within which Comptroller may object to application made at Sheffield.

55. (1.) The time within which the Comptroller shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registration made to the said company shall be one month from the date of the receipt by the Comptroller of the notice from the said company of the making of the application.

Advertisement of application made at Sheffield.

(2.) If no such objection is made by the Comptroller, the Cutlers' Company shall require the applicant to send the Comptroller a wood block or electrotype as the Comptroller may direct, and the Comptroller shall, if satisfied with such wood block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office.

Manner of notifying to Cutlers' Company application received by Comptroller.

(3.) The manner in which the Comptroller shall notify to the Cutlers' Company an application and proceedings thereon, made as mentioned in sub-section 8 of section 81 of the said Act, shall be by sending to the Cutlers' Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application.

For notice of appeal from the company to the Comptroller, see Form W in the second schedule.

The fee, payable only by an impressed stamp, is £1: first schedule, and Instructions 2 and 3.

Similarity of proceedings at London and at Sheffield.

56. The provisions of these rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.

It is to be noticed that there is no appeal in the case of cutlers' marks to the Board of Trade (see Rules 20–24), but any person aggrieved may apply to the court: see sect. 81 (5). This presumably will be done under sect. 90.

Certificates.

Certificate by Comptroller.

57. The Comptroller, when required for the purpose of any legal proceeding or other special purpose to give a certificate as to any entry, matter, or thing which he is authorised by the said Act or any of these rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate, and shall specify on the face of it the legal

proceeding or other purpose for which such certificate is granted.

See Instructions 39–41. Certificates are admissible in evidence without further proof: sects. 89 and 96. They are of four kinds—
(i.) For use in legal proceedings: Form S, fee 10s.
(ii.) For use in applying for registration abroad: Form R, fee 5s.
(iii.) Of any application and proceedings: Form T[1], fee 5s.
(iv.) Of refusal to register an old mark: Form L, fee £1.
As to obtaining forms and payment of fees, see Instructions 2 and 3.

Declarations.

58. The statutory declarations required by the said Act and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:— Manner in which, and persons before whom, declaration is to be taken.

(*a.*) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(*b.*) In any other part of her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(*c.*) If made out of her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

The declarations required by the Act are—

(i.) In a case of assignment or transmission of a trade mark: see Rule 37, and Form K.

(ii.) In an application to cancel an entry: sect. 91, and Form P.

As to declaration by persons under disability, see sect. 99.

Notice of seal of officer taking declaration to prove itself.

59. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the Comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

Repeal.

Previous rules repealed.

60. All general rules as to the registration of trade marks heretofore made by the Lord Chancellor under the Trade Marks Registration Act, 1875, and in force on the 31st day of December 1883, shall be, and they are hereby repealed, as from that date, without prejudice, nevertheless, to any proceeding which may have been taken under such Rules.

J. CHAMBERLAIN,
President of the Board of Trade.

21*st December* 1883.

. . . . . .

SCHEDULES.

FIRST SCHEDULE.

FEES.

	£	s.	d.
1. On application to register a trade mark for one or more articles included in one class . . .	0	5	0
2. On appeal to Board of Trade on refusal of Comptroller to register	1	0	0
3. For registration of a trade mark for one or more articles included in one class	1	0	0
4. For registering a series of trade marks, for every additional representation after the first in each class	0	5	0
5. For entering notice of opposition for each trade mark, whether in one or more classes . .	1	0	0
6. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	1	0	0
7. For every additional mark assigned or transmitted at the same time	0	2	0
8. For certificate of refusal to register a trade mark under section 77	1	0	0
9. For certificate of refusal at the same time for more than one trade mark, for each additional trade mark after the first	0	10	0
10. For continuance of mark at expiration of 14 years	1	0	0
11. Additional fee where fee is paid within three months after expiration of 14 years . . .	0	10	0
12. Additional fee for restoration of trade mark where removed for non-payment of fee . . .	1	0	0
13. For altering address on the register, for every mark	0	5	0

SCHED. I.

	£	s.	d.
14. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged	0	10	0
15. For cancelling the entry or part of the entry of a trade mark upon the register, on the application of the owner of such trade mark	0	5	0
16. On request to Comptroller to correct a clerical error	0	5	0
17. For certificate of registration to be used in legal proceedings	0	10	0
18. For certificate of registration to be used for the purpose of obtaining registration in foreign countries	0	5	0
19. For copy of notification of registration	0	2	0
20. Settling a special case by Comptroller	2	0	0
21. For inspecting register, for every quarter of an hour	0	1	0
22. For making a search among the classified representations of trade marks, for every quarter of an hour	0	1	0
23. For office copy of documents, for every 100 words (but never less than one shilling).	0	0	4
24. For certifying office copies, MS. or printed	0	1	0
25. For certificate of Comptroller under section 96	0	5	0
26. In cases where a trade mark requires a greater space than two inches of the depth of the page of the *Trade Marks Journal*, for each additional inch or part of an inch	0	2	0
27. Manchester Trade Marks Office	Same as above.		
28. Sheffield Marks	Same as above.		
29. On appeal from Cutlers' Company, Sheffield, to Comptroller	1	0	0

J. CHAMBERLAIN,
President of the Board of Trade.

Approved,

CHARLES C. COTES,
HERBERT J. GLADSTONE,
Lords Commissioners of her Majesty's Treasury.

4th December 1883.

SECOND SCHEDULE.

FORMS.

		PAGE
Form of	Application for Registration	188
„	Additional Representation of Trade Mark	189
„	Appeal to Board of Trade	190
„	Transmission of Registration Fee	191
„	Notice of Opposition	192
„	Assignment of Trade Mark	193
„	Request for Certificate of Refusal	194
„	Notice of Application for Alteration of Address	195
„	Notice of Application for Rectification of Register.	196
„	Application to Cancel Entry on Register	197
„	Declaration in Support of Application to Cancel Entry	198
„	Request to Comptroller for Correction of Clerical Error	199
„	Request for Certificate of Registration for Use in Obtaining Registration Abroad	200
„	Request for Certificate of Registration for Use in Legal Proceedings	201
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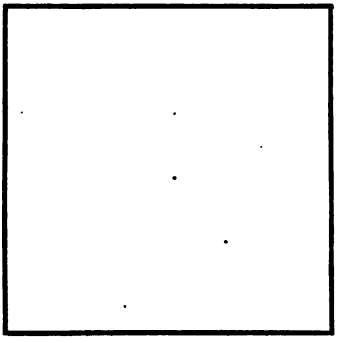
SCHED. 2.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

F.

TRADE MARKS.

APPLICATION FOR REGISTRATION OF TRADE MARK.



One representation to be fixed within this square, and two others to be sent on separate sheets of foolscap.

Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.

YOU are hereby requested to register the accompanying Trade Mark in Class , in respect of (*a*) in the name of (*b*) who claims to be the proprietor thereof (*c*)

(*a*) Only goods contained *in one and the same class* should be set out here. A separate application form is required *for each separate class.*

(*b*) Here insert legibly the full name, address, and business of the individual, firm, or company. In the case of an individual, add trading style (if any).

(*c*) Alter to "claim to be the proprietors thereof" in the case of a firm or company.

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings,
London.

(Signed) (*d*)

Dated this day of 1883.

(*d*) To be signed by the applicant; or, in the case of a firm, by a partner, adding "A member of the firm," or, in the case of a company, by the secretary or other principal officer, adding, "For the company."

Or, *in any case*, an agent may sign, adding "Agent."

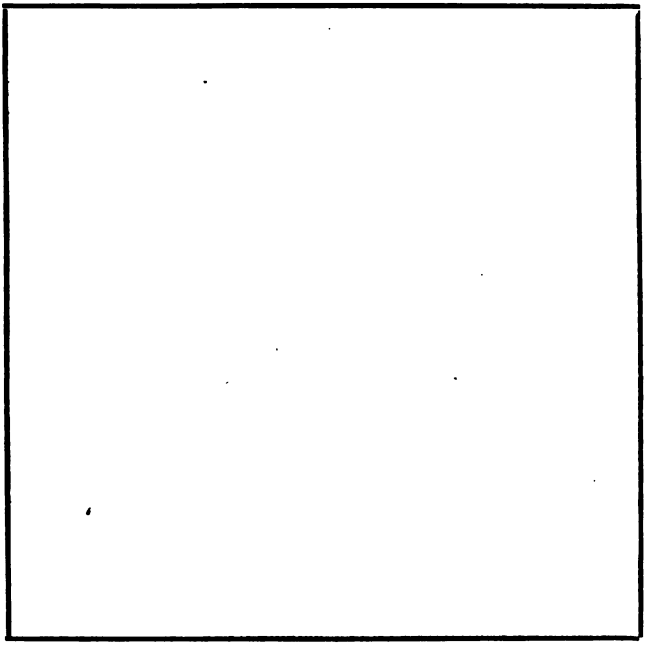
NOTE.—If the Trade Mark has been in use in respect of the goods since before August 13, 1875, state length of such user.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

G.

ADDITIONAL REPRESENTATION OF TRADE MARK, TO ACCOMPANY APPLICATION FOR REGISTRATION.

One representation of the Trade Mark to be affixed within this square.
It must correspond *exactly*, in all respects with the representation affixed to the Application Form.



Any representation of a larger size than foolscap may be folded, but must then be mounted upon linen and affixed hereto.

TWO of these ADDITIONAL REPRESENTATIONS of the Trade Mark must accompany *each* Form of Application.

In the case of a Trade Mark claimed in one of the CLASSES 23 to 35, THREE of these ADDITIONAL REPRESENTATIONS of the Mark must accompany the Form of Application.

TRADE MARKS.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

H.

FORM OF APPEAL TO BOARD OF TRADE ON REFUSAL OF COMPTROLLER TO REGISTER A TRADE MARK.

SIR,

I HEREBY give notice of my intention to appeal against your decision upon my application to register a Trade Mark No. in Class for

and I beg to submit my case * for the decision of the Board of Trade.

* The statement of the case to be written upon foolscap paper (on one side only), with a margin of two inches on the left-hand side thereof.

I am, sir,

Your obedient Servant,

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings,
London.

TRADE MARKS.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

I.

FEE FOR REGISTRATION OF A TRADE MARK.

SIR,

IN reply to your request I hereby transmit the prescribed fee for the registration of the Trade Mark No.
in Class

I am, sir,
Your obedient Servant,

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings,
London.

SCHED. 2.

TRADE MARKS.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

J.

NOTICE OF OPPOSITION TO APPLICATION FOR REGISTRATION.

[To be accompanied by an unstamped duplicate.]

In the matter of an Application, No. by of

SIR,

NOTICE is hereby given that I of oppose the Registration of the Trade Mark advertised under the above number for Class in the *Trade Marks Journal* of the day of 188 , No , page .

The grounds of opposition are as follows :—

To be dated and signed at the end by the opponent or his solicitor.

To the Comptroller,
Patent Office, Trade Marks Branch,
25 *Southampton Buildings,*
London.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

K.

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF TRADE MARK UPON THE REGISTER, WITH DECLARATION IN SUPPORT THEREOF.

I, (*a*)

hereby request that you will enter (*b*) name (*c*) in the Register of Trade Marks as proprietor of the Trade Mark No. in Class

(*d*) entitled to the said Trade Mark and to the goodwill of the business concerned in the goods with respect to which the said Trade Mark is registered.

(*e*)

And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said Trade Mark as above claimed.

(*f*) And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(*g*)

Declared at
this day of 188
Before me,
(*h*)

To the Comptroller,
Patent Office, Trade Marks Branch,
25 *Southampton Buildings,*
London.

(*a*) *Or* We. Here insert name, full address, and description.

(*b*) My *or* our.

(*c*) *Or* names.

(*d*) I am, *or* We are.

(*e*) Here state whether Trade Mark transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof, as, *e.g.*, "by deed dated the day of 188 , made between So-and-So of the one part."

(*f*) This paragraph is not required when the declaration is made out of the United Kingdom.

(*g*) To be signed here by the person making the declaration.

(*h*) Signature and title of the authority before whom the declaration is made.

SCHED. 2.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

L.

REQUEST FOR CERTIFICATE OF REFUSAL TO REGISTER A TRADE MARK IN USE BEFORE AUGUST 13, 1875.

In the matter of an Application for Registration of an old Trade Mark, No.
in Class

SIR,

I,

of

the Applicant in the above matter, hereby request you to furnish me with your Certificate of Refusal to register the said Trade Mark.

* Signature of Applicant.

Dated this day of 188 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

M.

NOTICE OF APPLICATION FOR ALTERATION OF ADDRESS ON REGISTER OF TRADE MARKS.

In the matter of the Trade Mark
No. registered
in Class

SIR,

NOTICE is hereby given that I,

of

the registered proprietor of the Trade Mark numbered as above, desire that my address on the Register of Trade Marks be altered to

Dated this day of 188 .

* Signature of Proprietor. *

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings,
London.

SCHED. 2.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

N.

TRADE MARKS.

NOTICE OF APPLICATION FOR ALTERATION OR RECTIFICATION OF REGISTER OF TRADE MARKS.

In the matter of the Trade Mark No. , registered in Class in the name of

SIR,

NOTICE is hereby given that by an Order of the Court made on the day of 188 , it was directed that the entry on the Register of Trade Marks in respect of the Trade Mark numbered as above should be rectified in the manner therein specified.

An Office Copy of the Order of the Court is enclosed herewith.

Dated this day of 188 .

*

* To be signed by the person interested or his agent.

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

O.

FORM OF APPLICATION BY PROPRIETOR OF REGISTERED TRADE MARK TO CANCEL ENTRY ON REGISTER.

Trade Mark No. Class advertised in *Trade Marks Journal*, No. page .

Name of Registered Proprietor or Firm

Place of Business

I, the undersigned,

of

[*or* I, the undersigned,

a member of the firm of

of

on behalf of my said Firm]

apply that the entry upon the Register of the Trade Marks in Class of the Trade Mark No. may be cancelled

The day of 188

(*Signed*)

This is the statement marked "O" referred to in the Declaration of made before me the of 188 .

SCHED. 2.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

P.

FORM OF DECLARATION IN SUPPORT OF APPLICATION FOR CANCELLATION OF TRADE MARK BY OWNER.

I, of ; [*or*
I, a member of the Firm of
of]
do hereby solemnly and sincerely declare, to the best of my knowledge and belief, as follows :—

(1.) The Application signed by me, and dated the day of 188 , and marked with the letter "O," and shown to me at the time of making this Declaration, is true.

(2.) I am the person whose name appears on the Register of Trade Marks as the Proprietor of the Trade Mark referred to in the said Application marked with the letter "O."

[*Or* My said Firm is the Firm whose name appears on the Register of Trade Marks as the Proprietor of the Trade Mark referred to in the said Application marked with the letter "O."]

And I make this solemn Declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(*Signed*)

Declared at
this day of
188 ,
Before me,

If the declaration be made before a Commissioner to administer oaths it will require to be stamped with a 2s. 6d. impressed Inland Revenue stamp.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

Q.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR IN REGARD TO A TRADE MARK.

SIR,

I HEREBY request that

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings,
London.

SCHED. 2.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

R.

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE MARK FOR USE IN OBTAINING REGISTRATION ABROAD.

In the matter of the Trade Mark
No. registered in
Class in the name of

SIR,

I,

of

the registered proprietor of the above Trade Mark, hereby request you to furnish me with your Certificate of Registration for use in obtaining registration of the same in *

* Here state name of country in which registration is to be sought.
† Signature.

†

Dated this day of 188 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

S.

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE MARK FOR USE IN LEGAL PROCEEDINGS.

In the matter of the Trade Mark
No. , registered in
Class in the name of

SIR,

I,

of

the registered proprietor of the above Trade Mark, hereby request you to furnish me with your Certificate of Registration for use in the following Legal Proceedings *

* Here state exact title of legal proceedings.

† Signature.

†

Dated this day of 188 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings,
London.

SCHED. 2.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

T.

TRADE MARKS.

APPLICATION FOR SETTLEMENT OF A SPECIAL CASE ON APPLICATION TO REGISTER A TRADE MARK.

In the matter of the Application of and of the Application of

SIR,

NOTICE is hereby given that I,

of

and I,

are unable to agree upon the facts on which the opinion of the Court is to be taken, and that we request you to fix a day on which we may attend before you and obtain your finding on the matters of fact to be submitted to the Court as settled.

Dated this day of 188 .

*

*

* To be signed by both parties.

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

T[1].

TRADE MARKS.

REQUEST FOR CERTIFICATE OF COMPTROLLER AS TO APPLICATION FOR REGISTRATION OF A TRADE MARK.

In the matter of the Trade Mark,
No. in Class

SIR,

I,

of

hereby request you to furnish me with your certificate that*

* Here set out the particulars which the Comptroller is requested to certify.
† Signature.

†

Dated this day of , 188 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings,
London.

SCHED. 2.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

V.

REQUEST FOR COPY OF OFFICIAL NOTIFICATION OF REGISTRATION OF TRADE MARK.

In the Matter of the Trade Mark,
No. registered
in Class

SIR,

I,

of

the registered proprietor of the Trade Mark above named, hereby request that you will furnish me with a copy of the official notification of the registration of the same.

* Signature.

*

Dated this day of 188 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25 *Southampton Buildings,*
London.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

W.

FORM OF APPEAL FROM CUTLERS' COMPANY AT SHEFFIELD TO COMPTROLLER.

[To be accompanied by an unstamped duplicate.]

SIR,

I HEREBY give notice of appeal against the decision of the Cutlers' Company of Sheffield in regard to my application for registration of a Trade Mark No. in Class for

and I beg to submit my case * for your decision accordingly.

†

Dated this day of 188 .

* The statement of the case to be written upon foolscap paper (on one side only), with a margin of two inches on the left-hand side thereof.

† Signature.

To the Comptroller,
Patent Office, Trade Marks Branch,
25 *Southampton Buildings,*
London.

THIRD SCHEDULE.

GENERAL NOTE.

Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the registrar may desire.

CLASSIFICATION OF GOODS.

	Illustrations.
	Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.
CLASS 1.	
Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives.	Such as— Acids, including vegetable acids. Alkalies. Artists' colours. Pigments. Mineral dyes.
CLASS 2.	
Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.	Such as— Artificial manure. Cattle medicines. Deodorisers. Vermin destroyers.
CLASS 3.	
Chemical substances prepared for use in medicine and pharmacy.	Such as— Cod-liver oil. Medicated articles. Patent medicines. Plasters. Rhubarb.

CLASSIFICATION OF GOODS—*continued.* SCHED. 3.

CLASS 4.	
Raw or partly prepared vegetable, animal, and mineral substances used in manufactures, not included in other classes.	Such as— Resins. Oils used in manufactures and not included in other classes. Dyes, other than mineral. Tanning substances. Fibrous substances (*e.g.*, cotton, hemp, flax, jute). Wool. Silk. Bristles. Hair. Feathers. Cork. Seeds. Coal. Coke. Bone. Sponge.
CLASS 5.	
Unwrought and partly wrought metals used in manufacture.	Such as— Iron and steel, pig or cast. Iron, rough. „ bar and rail, including rails for railways. „ bolt and rod. „ sheet, and boiler and armour plates. „ hoop. Lead, pig. „ rolled. „ sheet. Wire. Copper. Zinc. Gold, in ingots.
CLASS 6.	
Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in Class 7.	Such as— Steam engines. Boilers. Pneumatic machines. Hydraulic machines. Locomotives.

SCHED. 3. CLASSIFICATION OF GOODS—*continued.*

	Sewing machines. Weighing machines. Machine tools. Mining machinery. Fire engines.

CLASS 7.

Agricultural and horticultural machinery, and parts of such machinery.	Such as— Ploughs. Drilling machines. Reaping machines. Thrashing machines. Churns. Cyder presses. Chaff cutters.

CLASS 8.

Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching.	Such as— Mathematical instruments. Gauges. Logs. Spectacles. Educational appliances.

CLASS 9.

Musical instruments.

CLASS 10.

Horological instruments.

CLASS 11.

Instruments, apparatus, and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals.	Such as— Bandages. Friction gloves. Lancets. Fleams. Enemas.

CLASSIFICATION OF GOODS—*continued.* SCHED. 3.

CLASS 12.	
Cutlery and edge-tools.	Such as— Knives. Forks. Scissors. Shears. Files. Saws.
CLASS 13.	
Metal goods not included in other classes.	Such as— Anvils. Keys. Basins (metal). Needles. Hoes. Shovels. Corkscrews.
CLASS 14.	
Goods of precious metals (including aluminium, nickel, Britannia metal, &c.) and jewellery, and imitations of such goods and jewellery.	Such as— Plate. Clock cases and pencil cases of such metals. Sheffield and other plated goods. Gilt and ormolu work.
CLASS 15.	
Glass.	Such as— Window and plate glass. Painted glass. Glass mosaic. Glass beads.
CLASS 16.	
Porcelain and earthenware.	Such as— China. Stoneware. Terra cotta. Statuary porcelain. Tiles. Bricks.
CLASS 17.	
Manufactures from mineral and other substances for building or decoration.	Such as— Cement. Plaster. Imitation marble. Asphalt.

SCHED. 3. CLASSIFICATION OF GOODS—*continued.*

CLASS 18.	
Engineering, architectural, and building contrivances.	Such as— Diving apparatus. Warming apparatus. Ventilating apparatus. Filtering apparatus. Lighting contrivances. Drainage contrivances. Electric and pneumatic bells.
CLASS 19.	
Arms, ammunition, and stores not included in Class 20.	Such as— Cannon. Small-arms. Fowling-pieces. Swords. Shot and other projectiles. Camp equipage. Equipments.
CLASS 20.	
Explosive substances.	Such as— Gunpowder. Gun-cotton. Dynamite. Fog-signals. Percussion caps. Fireworks. Cartridges.
CLASS 21.	
Naval architectural contrivances and naval equipments not included in Classes 19 and 20.	Such as— Boats. Anchors. Chain cables. Rigging.
CLASS 22.	
Carriages.	Such as— Railway carriages Waggons. Railway trucks. Bicycles. Bath chairs.

CLASSIFICATION OF GOODS—*continued.* SCHED. 3.

CLASS 23.	
Cotton yarn and thread.	Such as— Sewing cotton on spools or reels. Sewing cotton not on spools or reels. Dyed cotton yarns.
CLASS 24.	
Cotton piece goods of all kinds.	Such as— Cotton shirtings. Long cloth.
CLASS 25.	
Cotton goods not included in Classes 23, 24, or 38.	Such as— Cotton lace. Cotton braids. Cotton tapes.
CLASS 26.	
Linen and hemp yarn and thread.	
CLASS 27.	
Linen and hemp piece goods.	
CLASS 28.	
Linen and hemp goods not included in Classes 26, 27, and 50.	
CLASS 29.	
Jute yarns and tissues, and other articles made of jute not included in Class 50.	
CLASS 30.	
Silk, spun, thrown, or sewing.	
CLASS 31.	
Silk piece goods.	

SCHED. 3. CLASSIFICATION OF GOODS—*continued.*

CLASS 32.	
Other silk goods not included in Classes 30 and 31.	
CLASS 33.	
Yarns of wool, worsted, or hair.	
CLASS 34.	
Cloths and stuffs of wool, worsted, or hair.	
CLASS 35.	
Woollen and worsted and hair goods not included in Classes 33 and 34.	
CLASS 36.	
Carpets, floor-cloth, and oil-cloth.	Such as— Drugget. Mats and matting. Rugs.
CLASS 37.	
Leather, skins unwrought and wrought, and articles made of leather not included in other classes.	Such as— Saddlery. Harness. Whips. Portmanteaus. Furs.
CLASS 38.	
Articles of clothing.	Such as— Hats of all kinds. Caps and bonnets. Hosiery. Gloves. Boots and shoes. Other ready-made clothing.

CLASSIFICATION OF GOODS—*continued.* SCHED. 3.

CLASS 39.

Paper (except paperhangings), stationery, and bookbinding.	Such as— Envelopes. Sealing-wax. Pens (except gold pens). Ink. Playing cards. Blotting cases. Copying presses.

CLASS 40.

Goods manufactured from india-rubber and gutta-percha not included in other classes.	

CLASS 41.

Furniture and upholstery.	Such as— Paperhangings. Papier-mâché. Mirrors. Mattresses.

CLASS 42.

Substances used as food, or as ingredients in food.	Such as— Cereals. Pulses. Olive oil. Hops. Malt. Dried fruits. Tea. Sago. Salt. Sugar. Preserved meats. Confectionery. Oil cakes. Pickles. Vinegar. Beer clarifiers.

SCHED. 3. CLASSIFICATION OF GOODS—*continued.*

CLASS 43.	
Fermented liquors and spirits.	Such as— Beer. Cider. Wine. Whisky. Liqueurs.
CLASS 44.	
Mineral and aerated waters, natural and artificial, including ginger-beer.	
CLASS 45.	
Tobacco, whether manufactured or unmanufactured.	
CLASS 46.	
Seeds for agricultural and horticultural purposes.	
CLASS 47.	
Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches; and starch, blue, and other preparations for laundry purposes.	Such as— Washing powders. Benzine collas.
CLASS 48.	
Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).	
CLASS 49.	
Games of all kinds and sporting articles not included in other classes.	Such as— Billiard tables. Roller skates. Fishing nets and lines. Toys.

CLASSIFICATION OF GOODS—*continued.* SCHED. 3.

CLASS 50.

Miscellaneous, including— (1.) Goods manufactured from ivory, bone, or wood, not included in other classes. (2.) Goods manufactured from straw or grass, not included in other classes. (3.) Goods manufactured from animal and vegetable substances, not included in other classes. (4.) Tobacco pipes. (5.) Umbrellas, walking-sticks, brushes, and combs. (6.) Furniture cream, plate powder. (7.) Tarpaulins, tents, rick-cloths, rope, twine. (8.) Buttons of all kinds, other than of precious metal or imitations thereof. (9.) Packing and hose of all kinds. (10.) Goods not included in the foregoing classes.	Such as— Coopers' wares.

J. CHAMBERLAIN,

President of the Board of Trade.

21*st December* 1883.

INSTRUCTIONS TO PERSONS WHO WISH TO REGISTER TRADE MARKS.

Preliminary.

1. All communications relating to trade marks, not being Sheffield marks, should be addressed to the Comptroller, Patent Office, Trade Marks Branch. All applications should be in the English language.

They may be made by post, or left at the Patent Office, Trade Marks Branch, 25 Southampton Buildings, Chancery Lane, London, W.C.

2. The fees in relation to trade marks registration cannot be received at the Patent Office. They should be paid in exchange for the *stamped forms* required, which may be obtained at the following places:—

List of Places at which Stamped Forms under the Patents, Designs, and Trade Marks Act, 1883, may be obtained.

(*a.*) At the Inland Revenue Office, Royal Courts of Justice, London.

(*b.*) At the following Post Offices in London:—

The General Post Office, London, E.C.
District Post Office, Lombard Street, E.C.
" " 226 Commercial Road, E.
" " 9 Blackman Street, Borough, S.E.
" " Charing Cross, W.C.
" " 28 Eversholt Street, Camden Town, N.W.
Post Office, 12 Parliament Street, S.W.

(*c.*) At the chief Post Office of—

ENGLAND AND WALES.

Accrington.
Altrincham.
Ashton - under - Lyne.
Barnsley.
Barrow-in-Furness.
Bath.
Bedford.
Beverley.
Birkenhead.
Birmingham.
Blackburn.
Bolton.
Bradford.
Brighton.
Bristol.
Bromsgrove.
Burnley.
Burslem.
Burton-on-Trent.
Bury.
Cambridge.
Cardiff.
Carlisle.
Chatham.
Chester.
Clitheroe.
Congleton.
Coventry.
Crewe.
Croydon.
Darlaston.
Derby.
Dewsbury.
Doncaster.
Dorchester.
Driffield.
Droitwich.
Dudley.
Durham.
Exeter.
Gateshead.
Goole.
Greenwich.
Guildford.
Halifax.
Hartlepool.
Huddersfield.
Hull.
Ipswich.
Keighley.
Kendal.
Kidderminster.
Knaresbro'
Knutsford.
Lancaster.
Leamington.
Leeds.
Leicester.
Lichfield.
Lincoln.
Liverpool.
Macclesfield.
Manchester.
Middlesborough.
Nantwich.
Newcastle.
Newport (Mon.)
Northallerton.
Northampton.
Nottingham.
Nuneaton.
Oldbury.
Oldham.
Patrington.
Plymouth.
Pontefract.
Portsmouth.
Prescot.
Preston.
Reading.
Redditch.
Richmond (Yorks.)
Ripon.
Rochdale.
Rotherham.
Rugby.
Salford.
St. Helen's.
Scarborough.
Sedgley.
Sheffield.
Southampton.
Stafford.
Stalybridge.
Stockport.
Stoke-on-Trent.
Stourbridge.
Stourport.
Sunderland.
Swansea.
Tamworth.
Truro.
Tunstall.
Wakefield.
Walsall.
Warrington.
Wednesbury.
West Bromwich.
Whitby.
Widnes.
Wigan.
Wolverhampton.
Wolverton.
Woolwich.
York.

SCOTLAND.

Aberdeen.
Dumbarton.
Dundee.
Edinburgh.
Glasgow.
Greenock.
Inverness.
Lanark.
Leith.
Paisley.
Perth.
Renfrew.

IRELAND.

Belfast.
Cork.
Dublin.
Dundalk.
Galway.
Limerick.
Londonderry.
Waterford.
Wexford.

NOTE.—*Arrangements have also been made by which any of the forms required may be ordered of the Postmaster at any Money Order Office in the United Kingdom not included in the above List.*

3. The following is a list of the stamped forms under the Patents, Designs, and Trade Marks Act, 1883, which relate to trade marks, and which may be obtained at the places mentioned above:—

TRADE MARKS.

Letter.	Title of Form.	Fee.
		£. s. d.
F	Application for Registration of Trade Mark.	0 5 0
G	Additional Representation Form	No stamp.
H	Appeal to Board of Trade on Refusal of Comptroller to Register a Trade Mark	1 0 0
I	Registration Fee	1 0 0
J	Notice of Opposition to Application for Registration	1 0 0
K	Request to enter Name of subsequent Proprietor, with Declaration in support thereof	1 0 0
L	Request for Certificate of Refusal to Register a Trade Mark	1 0 0
M	Notice of Application for Alteration of Address	0 5 0
N	Notice of Application for Alteration or Rectification of Register	0 10 0
O	Application to Cancel Entry of Mark on Register	0 5 0
Q	Request for Correction of Clerical Error	0 5 0
R	Request for Certificate of Registration for use abroad	0 5 0
S	Request for Certificate of Registration for use in Legal Proceedings	0 10 0
T	Application for Settlement of a Special Case	2 0 0
T1	Request for General Certificate of Comptroller	0 5 0
V	Request for Copy of Official Notification	0 2 0
W	Appeal from Cutlers' Company at Sheffield to Comptroller	1 0 0

Of the above forms those bearing the letters "F," "G," and "I" are kept in stock at the various offices named in paragraph 2. Any of the others when required must be bespoken.

Sale of Official Publications.

4. The Patents, Designs, and Trade Marks Act, 1883, and the Rules thereunder in relation to the registration of trade marks, should be carefully studied. Copies of the Act and of the Trade Marks Rules can be had on payment of 2s. 2d. for each copy, at the Sale Branch of the Patent Office, 38 Cursitor Street, Chancery Lane, London, E.C.

5. Post Office orders, sent in payment for the Act and Rules, should be for the sum of 2s. 2d., made payable to H. Reader Lack, at the Chancery Lane Post Office, London, W.C.

6. Copies of the *Trade Marks Journal* may be obtained at the price of 1s. a number from the Sale Branch of the Patent Office, 38 Cursitor Street, Chancery Lane, London, E.C.

Definition of a Trade Mark.

7. The definition of a trade mark (not used prior to the 13th August 1875) is given in the 64th section of the Patents, Designs, and Trade Marks Act, 1883, as follows:—

"For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

"A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

"A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or

> "A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use."

All new marks, therefore, which it is desired to register, *must include one or more of the above essential particulars.*

The 64th section goes on—"There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words, or figures, or any of them."

In addition to the above—

> "Any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade mark under this part of this Act."

A person wishing to adopt a trade mark should, before engraving a block and circulating impressions of the mark among his customers, make a search or a formal application at the Trade Marks Branch of the Patent Office, with the view of ascertaining whether his proposed mark is already registered, or whether, from its being calculated to deceive by a resemblance to other marks already on record, it would be refused registration under the 72d section of the Patents, Designs, and Trade Marks Act, 1883.

The fee for making a search amongst the classified representations of trade marks is 1s. for each quarter of an hour. The fee for a formal application is 5s.

The Comptroller does not undertake to make searches amongst the trade marks recorded at his

office, *except in connection with formal applications for registration.*

Application for Registration.

8. Applications sent by post should be addressed to

The Comptroller,
Patent Office,
Trade Marks Branch,
25 Southampton Buildings,
London, W.C.

Agents and other persons who may be interested in more than one application are particularly requested to make communications relating to different applications in *separate* letters.

9. An application for the registration of a trade mark consists of—

(*a.*) An application form (Form F in the second schedule to the Trade Marks Rules, 1883) giving certain particulars (specified in the form) and bearing an impressed stamp of 5s.

(The applicant should, before filling up the form, carefully read the marginal notes.)

(*b.*) Certain additional representations of the trade mark, mounted on forms (Form G).

10. A *separate* application form is required for *each* class in cases where the same trade mark is claimed in more than one class of goods.

11. If the mark be the property of a firm, the Form F should be signed by a member of the firm, who should add, after his signature, "A member of the firm;" if of a company, by the secretary or other principal

officer, who should add, after his signature and designation, "for the company."

12. Applications may be made by agents in the names of and on behalf of the owners of trade marks. The agent must be duly authorised by the owner or owners; the necessary authority should be signed by the owner or owners.

Applications made by agents should have after the name of the agent the description "agent."

13. A representation of the trade mark should be placed in the centre of the Form F.

14. When an application is made for a trade mark used on any metal goods other than cutlery, edge-tools, and raw steel, it should be stated in the application form of what metal or metals the goods are made. See section 81 of the Act as to Sheffield marks.

15. When the mark consists of or includes words printed in other than Roman characters, there should be given at the back of or at the foot of the application form and of each of the additional representations a translation of such words, signed by the applicant or his agent.

In the case of marks claimed in classes 23, 24, or 25, the applicant should state by what name the particular mark claimed would be referred to in the invoices of his house.

Additional Representations of Mark.

16. Each of the additional representations should be placed in the centre of a separate Form G.

In the case of a trade mark which is not claimed in classes 23 to 35, *two* additional representations are required for *each* class claimed.

In the case of a trade mark claimed in any one or more of the classes 23 to 35, *three* additional representations should be sent for *each* of such classes.

The representations of the mark on the Forms G must agree *in every respect* with each other, and with that on the Form F.

17. Representations of a mark of a large size may be folded. In that case they must, however, be backed with linen and firmly affixed to the forms. Representations must in no case be executed *in pencil*. They should be not only of a durable nature, but of such a kind as will admit of their being preserved and bound together in volumes as records of the property of the owners.

Series of Trade Marks.

18. By section 66 of the Patents, Designs, and Trade Marks Act, 1883, the Comptroller is empowered to register under one registration a series of trade marks which, whilst they resemble each other in the material particulars, differ from each other in respect of the statements of the goods for which they are used, of the statements of numbers, of the statements of price, of the statements of quality, or of the statements of names of places. When an application is made for such a series, a representation of *each* of the marks included in the series must be affixed to the Form F and also to each of the Forms G.

Common or Open Marks.

19. In the case of a trade mark used before the 13th August 1875, common or open marks of any kind may be registered in connection with it; but in the case of a trade mark not so used, common or open marks consist-

ing of *a word or combination of words only* can be registered as a part of the mark.

In each case, the applicant for entry of such common particular or particulars must disclaim the right to the exclusive use of the same in a note at the back of or at the foot of the application form and of each of the additional representations; such note to be signed by the applicant or his agent.

See section 74 of the Act, sub-section 3, for definition of common marks.

Classification of Goods.

20. A Guide to the Classification of Goods under the Trade Marks Rules can be obtained on application at the Patent Office, Trade Marks Branch, and should be asked for if the applicant feels any difficulty in determining to which of the classes set out in the third schedule to the rules the goods for which he uses his mark belong.

Advertisement in the "Trade Marks Journal."

21. A trade mark cannot in any case be entered upon the register until two months after its advertisement in the official paper.

22. A wood block or electrotype must be furnished for each mark in each class claimed (except in the case of classes 23, 24, and 25, for which no blocks or electrotypes are required), but no block or electrotype should be forwarded until a formal demand for it is sent by the Comptroller.

23. In the case of a series of trade marks differing only in respect of the particulars mentioned in section 66 of the Patents, Designs, and Trade Marks Act, 1883, a

wood block or electrotype must be furnished for each mark in the series, for each class claimed.

24. The wood blocks or electrotypes furnished must correspond *exactly* with the representations, must afford *perfectly distinct* impressions of the marks, and must be upon a scale sufficiently large to reproduce the marks faithfully. Worn or mutilated blocks or electrotypes cannot be accepted.

25. The largest space available for the insertion of any single block or electrotype is eight and a half inches broad by ten inches deep.

When a block or electrotype *exceeds two inches in depth*, a charge for additional space is made, at the rate of two shillings for every inch or part of an inch beyond the two inches.

26. The number given by the Comptroller should *not* be cut on the face of the block or electrotype, but should be *marked upon the side* in such a manner as to secure its identification.

27. All blocks or electrotypes should be sent to the Patent Office, Trade Marks Branch, together with the papers marked "Form 2," and with the representation of the mark sent for the guidance of the applicant in preparing the blocks or electrotypes.

28. The blocks or electrotypes supplied for the advertisement of trade marks cannot in any case be returned to applicants.

Restrictions on Registration.

29. Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a mark unless such groundwork be included within the mark by some border or lines.

30. The royal arms, or arms so nearly resembling them as to be calculated to deceive (except in the case of old marks), and the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To Counterfeit this is Forgery," will not be registered under the Patents, Designs, and Trade Marks Act, 1883, and should not, therefore, appear upon the representations of trade marks forming part of an application.

31. The following will not be registered as trade marks, or as prominent parts of trade marks, unless the marks have been used before 13th August 1875:—

Representations of her Majesty the Queen, or of any member of the royal family.

Representations of the royal crown.

The national arms or flags of Great Britain.

32. When there appears on the face of a trade mark an indication of the goods to which the mark is applied, the claim for its registration must be in respect of *those goods only.*

OPPOSITIONS.

Forms of Counter-Statement and Bond.

33. The following is a form of counter-statement:—

Patents, Designs, and Trade Marks Act, 1883.

Trade Marks.

In the matter of an application No.
and of the opposition thereto No.

In reply to the notice of opposition in this matter by
of , I give notice by way of

counter-statement that I rely for my application on the following grounds:—

(To be dated and signed by the applicant or his solicitor.)

To the Comptroller,
Patent Office,
Trade Marks Branch,
25 Southampton Buildings,
London.

The following is a form of bond which the Comptroller is able to accept from persons opposing applications, and who have been required to give security for costs:—

Patents, Designs, and Trade Marks Act, 1883.
Trade Marks.
In the matter of an application No.
and of the opposition thereto No.

Know all men by these presents that we of and of are jointly and severally held and firmly bound to Henry Reader Lack, the Comptroller-General of Patents, Designs, and Trade Marks, in the penal sum of pounds of good and lawful money of Great Britain, to be paid to the said Henry Reader Lack or to other the Comptroller-General of Patents, Designs, and Trade Marks for the time being, for which payment to be well and faithfully made we bind ourselves and each of us, our and each of our heirs, executors, and administrators firmly by these presents sealed with our seals.

Dated this day of 188 .

Whereas, pursuant to the provisions of the Patents, Designs, and Trade Marks Act, 1883, and of the Trade Marks Rules, 1883, an application (No.) has been made by of to the Comptroller-General of Patents, Designs, and Trade Marks for the registration of a certain trade mark: and whereas the above-bounden
have delivered a notice of opposition to such registration, and the said have sent to the said Comptroller-General a counter-statement of the grounds on which they rely for their application: and whereas the said Comptroller-General, pursuant to the terms of the said Act, hath required the said
to enter into the above-written obligation (subject to the condition hereinafter contained) as security for such costs as may be awarded in respect of such opposition:

Now the condition of the above-written obligation is such that if the said or either of them, their or either of their heirs, executors, or administrators do and shall well and truly pay or cause to be paid to all such costs as the High Court of Justice shall think fit to award to the said
in respect of the said opposition, then the above-written obligation is to be void or else to remain in full force and virtue.

Signed, sealed, and delivered by the above-bounden
and in the presence of

34. Before he is required to bring an opposition matter before the court under Rule 29, the applicant is afforded an opportunity of objecting, if he think fit, to the solvency of the security for the costs which may be awarded in respect of the opposition.

Fees.

35. See the first schedule to the Trade Mark Rules, 1883, and the list of Forms in paragraph 3 of these Instructions.

36. *An application for the registration of a trade mark will not be entered by the Comptroller unless it be accompanied by the proper fees in impressed stamps.*

Cutlers' Company.

37. By section 81, sub-section 3, of the Patents, Designs, and Trade Marks Act, 1883, application for the registration of trade marks used on cutlery, edge-tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, shall, if made by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company.

See Rules 53 to 56 and paragraph 14 of these Instructions.

Applications made to the Cutlers' Company in pursuance of section 81 of the Patents, Designs, and Trade Marks Act, 1883, should be made on Form F, the address in the left-hand corner to be, "To the Cutlers' Company, Sheffield," instead of "To the Comptroller," and should be left at, or sent by post to, the Cutlers' Hall, Sheffield.

Each application should be accompanied by an unstamped copy on foolscap paper. *See* Rule 53.

Applications sent by post should be addressed—

CHAS. MACRO WILSON, Esq.,
The Law Clerk to the Cutlers' Company,
The Cutlers' Hall,
Sheffield.

Manchester Office.

38. For the convenience of merchants and manufacturers engaged in the cotton trade, and for the purpose of facilitating the recording of trade marks used in respect of cotton goods, an office has been opened at 48 Royal Exchange, Manchester, where searches can be made on payment of 1s. for each quarter of an hour for all marks in classes of textiles from class 23 to class 35.

Certificates.

39. The Comptroller's certificate in relation to a trade mark is of four kinds, viz.—

(i.) For use in legal proceedings.
(ii.) For use in applying for registration in foreign countries.
(iii.) Of any application made and of proceedings thereon.
(iv.) A certificate of refusal of a mark in use before 13th August 1875, and not registerable.

40. A person desirous of obtaining any of the above certificates should forward Form S, Form R, Form T[1], or Form L (see paragraph 3), as the case may be, to the Comptroller, giving the Comptroller's official number of the mark, and stating whether the certificate is required for use in legal proceedings, or for use in applying for the registration of the mark in a foreign country, or for what other purpose.

The form should be accompanied by two unmounted copies of each mark for which a certificate is required.

41. In every case where a certificate is required in respect of a cotton mark, or in respect of any trade mark

of which the representations or specimens forming part of the application for registration are *coloured*, two unmounted copies of the mark must be supplied, agreeing *in every respect* with the representations forming part of the application for registration. Special attention should be paid to this requirement, as the certificate cannot in any such case be prepared until these unmounted copies are received by the Comptroller.

Registration of subsequent Proprietors of Registered Trade Marks.

42. The request and declaration to be made by a subsequent proprietor on application for the registration in his name of a registered trade mark must be made on Form K (see paragraph 3).

H. READER LACK,
Comptroller.

PATENT OFFICE, TRADE MARKS BRANCH,
London, May 1884.

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N.B.—In this index the following abbreviations are used:—M. M. Act for the Merchandise Marks Act, 1862, and T. M. Act for the Patents, Designs, and Trade Marks Act, 1883.

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